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

Proceeding	92053712
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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. 3,448,481  
For the mark EAST-WEST BUSINESS BRIDGE  
Date Registered: June 17, 2008

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EAST WEST BANK,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92053712
	)	
THE PLUBELL FIRM, LLC	)	
	)	
Respondent.	)	
	)	

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**PETITIONER EAST WEST BANK’S COMBINED REPLY AND TRIAL BRIEF ON  
RESPONDENT THE PLUBELL FIRM, LLC’S COUNTERCLAIMS AND UNCLEAN HANDS  
DEFENSE**

Petitioner East West Bank (“Petitioner”), by and through its attorneys, submits this Combined Reply and Trial Brief in support of its Amended Petition to Cancel Respondent’s “EAST-WEST BUSINESS BRIDGE” Mark (“Respondent’s Mark”), Registration No. 3,448,481, and in opposition to Respondent The Plubell Firm, LLC’s (“Respondent”) Counterclaims and Unclean Hands Defense for cancellation of Petitioner’s “EAST WEST BANK” and “EAST WEST BANK [and Design]” Marks, Registration Nos. 2,025,824 and 3,430,148, respectively.

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## I. PRELIMINARY STATEMENT

Respondent's Preliminary Statement of its Trial Brief is merely an attempt to distort the record and to divert the Board's attention from the overwhelming evidence on the merits of the case against Respondent to believe that Respondent is an under-resourced and weak entity that is being "bullied and harassed" by Petitioner, a multi-billion-dollar company. *See* Respondent The Plubell Firm, LLC's Trial Brief dated June 16, 2015 ("Resp. Tr. Brief" herein), at 5-9 (Dkt. No. 113). The reverse is true: Even though Respondent is a single employee company, it is entirely owned by a seasoned lawyer, and despite [REDACTED] whatsoever from its non-used trademark, Respondent retained a much larger legal team and a huge national firm<sup>1</sup> to mount a super aggressive, no-holds bar, scorched earth attack, on Petitioner to extract a [REDACTED] from Petitioner, as further evidenced by Respondent's overreaching discovery and numerous motions and conferences (*see* Dkt. Nos. 8, 11-15, 20, 24, 26, 29-33, 39, 41, 45, 49, 51 and 59) throughout this nearly five-year ordeal, including Respondent's (1) failed and persistent attempts to obtain Petitioner's corporate minutes and take depositions of Petitioner's Chief Executive Officer and other officers, (2) ignoring the Board's admonitions in its May 9, 2011 (Dkt. No. 7) and December 22, 2011 (Dkt. No. 15) Orders regarding Respondent's inappropriate communications to Petitioner's high-ranking officers, (3) service of deposition notices for three of Petitioner's high-ranking officers in violation of the Board's December 22, 2011 Order (Dkt. No. 15) granting Petitioner's Motion to Quash Respondent's Deposition Notices of Petitioner's high-ranking officers, and (4) filing of two separate unrelated opposition proceedings against Petitioner's now abandoned service mark applications

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<sup>1</sup> Respondent accused Petitioner of using a national firm to "bully" Respondent when ironically, Petitioner's initial firm only had a handful of lawyers, and the much larger firm it merged into is still merely two-thirds the size of the firm (Dkt. No. 10) which Respondent hired to terrorize and harass Petitioner. Petitioner's legal team has comprised of primarily two attorneys throughout the case, while Respondent retained twice the number of lawyers. Instead, it is Respondent who appears to have endless resources in pursuing Petitioner for [REDACTED]. Interestingly, Respondent's Associated Counsel of Lewis Brisbois Bisgaard & Smith LLP (Dkt. No. 10), who have actively participated in this proceeding, are conspicuously absent from Respondent's Trial Brief, but remain on the e-service distribution list of the parties with access to confidential portions of the records.

to terrorize Petitioner into [REDACTED].<sup>2</sup> In Respondent's final salvo, Respondent chooses to again defy the Board's Order, this time the November 14, 2013 Order (Dkt. No. 51) to produce information on its revenue - by producing its [REDACTED], but with all its [REDACTED] redacted. Such troll-like behavior and abuse of the public's resources invested in this venue and the legal process should *not* be condoned.

Respondent's claim that somehow as a "state-chartered bank", Petitioner can only provide a "very narrow scope of banking related services" formed the basis of Respondent's counterclaims and the entry of judgment in two other proceedings (Opposition Nos. 91203410 and 91215389) is a red-herring. Resp. Tr. Brief at 8. Respondent failed to provide any legal basis for such outlandish imagination. *Id.* As to the entry of judgment in those two other Opposition proceedings (*see supra*, Section I, n.2, herein), Petitioner decided for business reasons not to further pursue its "EAST WEST BRIDGE FORUM" and "EAST WEST INVESTMENT SERVICES [and Design]" applications to avoid being forced to spend another five years of its limited resources in defending itself against Respondent.

As previously shown in Petitioner's Main Trial Brief (Section IV.B) and reaffirmed below in reply to Respondent's Trial Brief, each and every relevant "likelihood of confusion" factor strongly weighs in Petitioner's favor. Contrary to Respondent's specious arguments, Petitioner timely brought abandonment and non-use claims after Petitioner had become aware of the basis for such claims in discovery, as affirmed by the Board, which granted Petitioner's Motion to Amend to file an Amended Petition to Cancel (Dkt. No. 63). Respondent's statement that the "arrogantly labeling" of Respondent's use as "token" does not make it so totally missed Petitioner's non-use ground. Petitioner does not argue

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<sup>2</sup> On January 18, 2012, Respondent filed a Notice of Opposition against Petitioner's "EAST WEST BRIDGE FORUM" application (now abandoned). Dkt. No. 1 (Opposition No. 91203410). The opposition proceeding terminated as of August 21, 2012 as Petitioner decided it does not have sufficient resources to defend this application against Respondent. Dkt. Nos. 17-18, 23 (Opposition No. 91203410). On March 12, 2014, Respondent filed a Notice of Opposition against Petitioner's "EAST WEST INVESTMENT SERVICES [and Design]" application (now abandoned). Dkt. No. 1 (Opposition No. 91215389). The opposition proceeding terminated as of April 24, 2015. Dkt. Nos. 9-10 (Opposition No. 91215389).

that Respondent's use is "token", but rather Respondent simply does *not* have any use at all within the meaning of the term "use in commerce" as defined for services in 15 U.S.C. § 1127.

Respondent falsely claims that Petitioner's Main Trial Brief ("Pet. Tr. Brief" herein) "willfully ignores, misconstrues, and hides Respondent's evidence of record, and also misunderstands and misrepresents the law". Respondent's mischaracterization of the so-called "low-points" of Petitioner's Main Trial Brief (*see* Resp. Tr. Brief at 8) cannot withstand simple fact checking.

As for Respondent's frivolous counterclaims, subsequent to Petitioner's July 1995 conversion to a State commercial bank, Petitioner succeeded to all rights and property of East-West Federal Bank, f.s.b. by operation of law, and any reference to East-West Federal Bank, f.s.b. in any writing, whether executed before or *after* the conversion, is deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. *See* 12 U.S.C. § 214b; Cal. Fin. Code § 4950(e); Dkt. No. 66.

Accordingly, the signing on behalf of East-West Federal Bank, f.s.b. is the equivalent of signing for East West Bank by operation of law, which cannot constitute a fraud on the USPTO.

## **II. THIRD PARTY REGISTRATIONS DO SHOW BUSINESS CONSULTING AND BANKING AND FINANCIAL SERVICES ORIGINATE FROM A SINGLE SOURCE**

### **A. Petitioner's Evidence**

Petitioner submitted third-party registrations (Petitioner's Exhibit 27) to show that business consulting services in Class 35 and banking and financial services in Class 36 originate from a single source. Respondent's assertion that the registrations are for different services than Respondent's has no merit as such registrations encompass "business consulting" in Class 35. Petitioner respectfully requests the Board to consider the use-based registration, namely, Registration No. 3,695,269, of Petitioner's Exhibit 27 and give appropriate evidentiary weight as to the relatedness of the parties' services.

### **B. Petitioner's Evidentiary Objections**

Petitioner's reply to Respondent's response to Petitioner's evidentiary objections is set forth in the Appendix.

**III. STATEMENT OF THE ISSUES**

In addition to the issues already set forth in Petitioner’s Main Trial Brief at 11-12, the issues to be decided by the Board in this cancellation proceeding on Respondent’s counterclaims and unclean hands defense include as follows:

1. Whether Petitioner’s filing of its Section 8 declaration for the “EAST WEST BANK” Mark under its pre-conversion name, East-West Federal Bank, f.s.b., renders the registration invalid.
2. Whether Petitioner’s Combined Declaration of Use and Incontestability for the “EAST WEST BANK” Mark filed under its pre-conversion name, East-West Federal Bank, f.s.b., is void *ab initio* by fraud.
3. Whether Respondent has met its heavy burden by conclusively proving that Petitioner fraudulently secured the Renewal of the “EAST WEST BANK” Mark in 2007.
4. Whether Respondent has met its heavy burden by conclusively proving that Petitioner fraudulently procured the “EAST WEST BANK [and Design]” Mark through alleged false statements concerning the scope of services rendered under its mark.
5. Whether Respondent has met its burden by conclusively showing that Petitioner is barred by the doctrine of unclean hands from relying on the “EAST WEST BANK” or “EAST WEST BANK [and Design]” registrations, or from pursuing non-use and abandonment claims, notwithstanding the fact that Petitioner has not committed any fraud before the USPTO.

**IV. ARGUMENT**

**A. Petitioner Does Not Lack Standing and Priority**

Respondent concedes that the filing dates of Petitioner’s pleaded registrations, namely, “EAST WEST BANK”, “EAST WEST BANK [and Design]” and “BUSINESS BRIDGE”, predate the September 27, 2007 filing date of Respondent’s “EAST-WEST BUSINESS BRIDGE” registration. Resp. Tr. Brief at 11. Although Respondent may have purportedly first used its mark on January 4, 2003

before Petitioner filed its second “BUSINESS BRIDGE” application<sup>3</sup> on May 23, 2006 or its “EAST WEST BANK [and Design]” application on August 28, 2007, Petitioner’s “EAST WEST BANK”, “EAST WEST BANK [and Design]” and “BUSINESS BRIDGE” Marks were first used in interstate commerce no later than July 31, 1995, July 1996, and May 15, 1997, respectively, which dates were never questioned by Respondent. *See* Emily Wang Testimony Deposition of September 22, 2014 (“Wang Testimony Depo.”) at 35:9-36:19, 38:7-13, 50:17-53:14, 53:21-55:24, and Exhibits 1, 4 and 5 thereto; Petitioner’s Exhibit 26. Therefore, Petitioner’s pleaded registrations have priority over Respondent’s “EAST-WEST BUSINESS BRIDGE” registration.

Respondent argues “East West Bank’s own evidence and testimony is that East West Bancorp, not East West Bank, owns the pleaded registrations.” Resp. Tr. Brief at 11. The Trademark Manual of Examining Procedure states:

Either a parent corporation or a subsidiary corporation may be the proper Applicant, depending on the facts concerning ownership of the mark. The USPTO will consider the *filing of the application in the name of either the parent or the subsidiary to be the expression of the intention of the parties as ownership* in accord with the arrangements between them.

TMEP § 1201.03(b) (emphasis added).

As Douglas P. Krause, East West Bank’s Executive Vice President, General Counsel, Chief Risk Officer, and Corporate Secretary, testifies East West Bancorp is the holding company of Petitioner East West Bank, and East West Bancorp indirectly owns the assets, including the trademarks of Petitioner; therefore, it is not inconsistent that East West Bancorp claims it owns the trademarks, albeit indirectly. However, the titles in the trademarks vest in the Petitioner as shown in the registrations and the use of the mark is made by the Petitioner as shown by the specimen, the evidence of use submitted, and the testimony of the witnesses.

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<sup>3</sup> Petitioner’s first “BUSINESS BRIDGE” application filed on August 12, 1997 and registered on June 23, 1998 was cancelled on March 26, 2005 as Petitioner had not timely filed its Section 8 declaration.

Here, as Petitioner has properly made its pleaded registrations of record, Petitioner's use and registration of its marks establish its standing. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Therefore, Petitioner has not made any misrepresentation to the USPTO; hence no basis for the defense of unclean hands.

**B. Petitioner Has Demonstrated That The Relevant Du Pont Factors Strongly Weigh In Favor Of A Likelihood Of Confusion Between Respondent's "EAST-WEST BUSINESS BRIDGE" Mark And Petitioner's "EAST WEST BANK", "EAST WEST BANK [and Design]", And "BUSINESS BRIDGE" Marks**

Contrary to Respondent's assertions in its Trial Brief, each of the relevant Du Pont factors *strongly* weigh in favor of a finding of likelihood of confusion for the reasons previously set forth in Petitioner's Main Trial Brief and reaffirmed below. *See* Resp. Tr. Brief at 12-27; Pet. Tr. Brief at 24-37.

Although the party seeking to oppose or cancel another party's application or registration bears the burden of coming forward with sufficient evidence to support the conclusion that confusion is likely, the newcomer has the opportunity and obligation to avoid confusion with established marks. Bridgestone Americas Tire Operations LLC v. Fed. Corp., 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012). Here, Respondent had *actual* notice of Petitioner's Registered Marks before it adopted the "EAST-WEST BUSINESS BRIDGE" Mark or filed its application for the mark, which notice Respondent ignores in its Trial Brief. Accordingly, as the newcomer, Respondent had the opportunity and obligation to avoid confusion with Petitioner's Registered Marks before it adopted its mark or filed its application for the "EAST-WEST BUSINESS BRIDGE" Mark, but undisputedly failed to do so.

**1. The Parties' Marks Are Highly Similar**

Respondent's "EAST-WEST BUSINESS BRIDGE" Mark is highly similar in appearance to Petitioner's "EAST WEST BANK" and "BUSINESS BRIDGE" Marks. Respondent mistakenly asserts that Petitioner is "tacking" its "BUSINESS BRIDGE" Mark to its "EAST WEST BANK" Marks. Resp. Tr. Brief at 13. Petitioner does not dispute that each of its marks are separate and individually pleaded registrations. That said, Petitioner's advertising and promotion of its "BUSINESS BRIDGE" Mark

always contains its “EAST WEST BANK” Marks (Emily Wang Testimony Deposition of September 22, 2014 (“Wang Testimony Depo.” herein) at 161:7-11 and Exhibits 3, 5, 6 (Trade Secret/Commercially Sensitive), 9, 11-12, 18, and 23 thereto), in which consumers would associate Petitioner with “BUSINESS BRIDGE” (i.e., EAST WEST BANK and BUSINESS BRIDGE), which is very similar to Respondent’s “EAST-WEST BUSINESS BRIDGE” Mark.

Respondent’s statement that “East West” is a “relatively weak element” in the overall likelihood of confusion analysis because the words are frequently used together and registered is groundless. Resp. Tr. Brief at 13. Respondent cites no legal authority in support of its position. Further, Respondent’s cited third-party registrations of “East West” lack any similarity to Petitioner’s “EAST WEST BANK” Marks for similar services in Classes 35 or 36 and should *not* be entitled to any probative value. Finally, Respondent’s reference to various exhibits of “East West” United States trademark registrations, “East West” and “East West and Business” Google search results, and California Secretary of State business search results for California corporations and LLC’s that begin with “East West”, “East-West”, and “East/West” (Resp. Tr. Brief at 13) are entitled to little weight in this context, if any at all, as the third-party registrations, in particular, do *not* show *actual use* of Petitioner’s Registered Marks by third-parties and resulting impact upon the purchasing public. Stanadyne, Inc. v. Lins, 490 F.2d 1396, 1397, 180 USPQ 649 (CCPA 1974).

While Petitioner’s witness testified that there is another bank named East West Bank, such bank is located outside the United States in the Philippines, not in the United States marketplace as Respondent had conveniently omitted to mention (Resp. Tr. Brief at 13). Wang Testimony Depo. at 134:19-135:7.

The Federal Circuit has provided the following guidance for evaluating parties’ marks:

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is *nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties*. Indeed, this type of analysis appears to be unavoidable.



In re Nat'l Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (footnotes omitted) (citations omitted) (emphasis added). As previously indicated, the respective marks contain “EAST WEST” (except for the hyphen between the terms in Respondent’s Mark). Here, Respondent’s “EAST-WEST BUSINESS BRIDGE” Mark entirely subsumes Petitioner’s prominent portion of the mark, i.e., “EAST WEST” and are the first words appearing in Respondent’s “EAST-WEST BUSINESS BRIDGE” Mark. As Respondent points out, the “BANK” part of the “EAST WEST BANK” Mark is disclaimed (Resp. Tr. Brief at 14), leaving EAST WEST being the prominent feature of the mark. Since banks do provide business consulting services, the consuming public will likely be confused that “EAST-WEST BUSINESS BRIDGE” has the same source as “EAST WEST BANK”.

Similarly, the respective marks contain “BUSINESS BRIDGE”. Respondent’s “EAST-WEST BUSINESS BRIDGE MARK” entirely subsumes Petitioner’s prominent portion of the mark, i.e., BUSINESS BRIDGE. As Respondent points out, the “BUSINESS” part of the “BUSINESS BRIDGE” Mark is disclaimed. Id. at 16. As with Petitioner’s “EAST WEST BANK” Mark above, because banks provide business consulting services, the consuming public will likely be confused that “EAST-WEST BUSINESS BRIDGE” originates from the same source as “BUSINESS BRIDGE”.

Likelihood of confusion is often found where, as here, the entirety of one mark (BUSINESS BRIDGE) is incorporated within another *or* where there are similar terms or phrases or similar parts of terms or phrases (EAST WEST) appearing in the parties’ respective marks. *See* Petitioner’s Tr. Brief at 28 and cases cited therein.

Accordingly, the terms “EAST WEST” and “BUSINESS BRIDGE” in the respective marks are essentially identical in both appearance and sound.

Respondent’s reliance on Parfums de Coeur, Ltd. v. Lazarus is inapposite to the instant proceeding as the Parfums Board noted: “[I]t must be remembered that applicant’s [BODYMAN] mark includes a prominent design element, and it is intended to be used for an animated television series . . . because of the *differences* between men’s fragrances [associated with Opposer’s BOD and BOD MAN marks] and an animated cartoon series . . . [consumers] would have no basis to associate the fragrance

products with the television series.” Parfums de Coeur, Ltd. v. Lazarus, 83 USPQ2d 1012, 1016 (TTAB 2007) (emphasis added). As previously discussed in Petitioner’s Main Trial Brief in Section IV.B.2 and reaffirmed below, the parties’ respective services are *closely related*, unlike the goods and services in the Parfums de Coeur, Ltd. case.

Although Respondent’s Mark does not use the term “bank”, such mark includes the common terms “business bridge” and “east west” of Petitioner’s “BUSINESS BRIDGE” and “EAST WEST BANK” Marks. Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting a house mark, other distinctive matter, or a term that is descriptive or suggestive of the named goods or services – if the *dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences*. TMEP § 1207.01(b)(iii); *see, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157 (Fed. Cir. 2014) (affirming the Board’s finding that applicant’s mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties’ marks).

Contrary to Respondent’s assertions, because Respondent’s “EAST-WEST BUSINESS BRIDGE” Mark shares with Petitioner’s “BUSINESS BRIDGE” and “EAST WEST BANK” Marks those elements responsible for creating its overall commercial impression and connotation, the marks are confusingly similar. *See In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). In particular, the suggestion of the parties’ respective marks is essentially the same because the parties make business connections and serve their clients as a bridge between the East and West in meeting their business objectives. Resp. Tr. Brief at 16; Respondent’s Exhibit 14; Wang Testimony Depo. at 36:20-24, 37:2-6.

The third-party registrations of “Bridge” cited by Respondent (Resp. Tr. Brief at 16) lack any similarity to Petitioner’s “BUSINESS BRIDGE” Mark for similar services in Classes 35 or 36 and should not be entitled to any probative value. As previously noted, third-party registrations, by themselves, are entitled to minimal weight in this context, if any at all, because they do not show actual use of Petitioner’s

Registered Marks by third-parties and resulting impact upon the purchasing public. Stanadyne, Inc., 490 F.2d at 1397, 180 USPQ at 649.

To the extent that the Board finds the parties' respective marks to be dissimilar, where the goods or services are identical or virtually identical (as is the case here), the *degree of similarity* between the marks necessary to support a determination that confusion is likely *declines*. See Bridgestone Americas Tire Operations, LLC, 673 F.3d at 1337, 102 USPQ2d at 1064 (Fed. Cir. 2012); In re Viterra Inc., 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); In re Mighty Leaf Tea, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); In re Max Capital Grp. Ltd., 93 USPQ2d 1243, 1248 (TTAB 2010); In re Ginc UK Ltd., 90 USPQ2d 1472, 1477 (TTAB 2007).

Lastly, Respondent attempts to confuse the Board by comparing the connotation and commercial impression of its "EAST-WEST BUSINESS BRIDGE" Mark in English with the Chinese translations of Petitioner's "EAST WEST BANK" and "BUSINESS BRIDGE" Marks by erroneously applying the "doctrine of foreign equivalents". Under the doctrine of foreign equivalents, a foreign word and the English equivalent may be held to be confusingly similar. See TMEP § 1207.01(b)(vi). Here, however, both parties' respective marks are in English, therefore, the doctrine of foreign equivalents is inapplicable.<sup>4</sup>

In view of the above and as previously set forth in Section IV.B of Petitioner's Main Trial Brief, the first du Pont factor thus strongly favors Petitioner.

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<sup>4</sup> Petitioner seeks to exclude the January 30, 2012 discovery deposition testimony of Emily Wang referenced in footnote 6 of Respondent's Trial Brief at 15. See Appendix A of Petitioner's Evidentiary Objections (Pet. Tr. Brief at 45) and reply herein. Notwithstanding the above, Petitioner's 30(b)(6) witness, Emily Wang, noted in her discovery deposition that Petitioner's Chinese website was created to help its immigrant customers, who already understand English or are comfortable with English, understand what is available on Petitioner's website and what the products are all about and serve as a reference. See Respondent's Exhibit 38 at 183:4-14 and 185:7-13. Most of Petitioner's immigrant customers log in from the English website. Id. at 183:4-14.

**2. Respondent Conveniently Ignored Respondent’s Services Are Closely Related To Petitioner’s Services**

Respondent goes to extensive lengths to ignore the indisputable fact that Petitioner has continuously provided its customers with *business consulting* services, in addition to the rendering of Petitioner’s banking services in association with Petitioner’s “EAST WEST BANK” and “BUSINESS BRIDGE” Marks. Resp. Tr. Brief at 16-19; Petitioner’s Exhibit 26; Wang Testimony Depo. at 48:12-49:1, 60:6-13, 83:8-90:18, 90:20-103:23, 122:1-5, 123:23-128:16, 183:10-183:25, 197:15-17, and 199:13-201:7; Respondent’s Exhibit 38 at 209:3-214:1; Respondent’s Exhibit 39 at 256:19-262:5, 413:14-21; Petitioner’s Exhibit 141 at 65:7-66:4, 72:12-25, 109:3-110:8, and 206:18-208:24; Petitioner’s Exhibit 142 at 264:17-24, 271:25-274:9, 277:2-280:4, and 286:11-290:4.

**a. Petitioner Is Not Tacking Its “BUSINESS BRIDGE” Mark To Its “EAST WEST BANK” Marks To Demonstrate The Relatedness Of The Services**

Respondent’s assertion that Petitioner’s “novel attempt” to tack its “BUSINESS BRIDGE” Mark to its “EAST WEST BANK” Marks demonstrates its bad faith is simply not true. To the contrary, Petitioner does *not* dispute that each of its marks are separate and individually pleaded registrations. Notwithstanding the above, Petitioner’s advertising and promotion of its “BUSINESS BRIDGE” Mark always appears with its “EAST WEST BANK” Marks . Wang Testimony Depo. at 161:7-11 and Exhibits 3, 5, 6 (Trade Secret/Commercially Sensitive), 9, 11-12, 18, and 23 thereto. As discussed above, because such marks appear together, consumers associate Petitioner with “BUSINESS BRIDGE” (i.e., EAST WEST BANK and BUSINESS BRIDGE), which indeed is very similar to Respondent’s “EAST-WEST BUSINESS BRIDGE” Mark.

**b. Banks Provide Business Consulting Services**

While Respondent may not provide banking services, Respondent does provide business consulting services and purposefully associated its services with clients and/or potential clients seeking business opportunities between the United States and China and specifically marketed its services to clients and/or potential clients in both the United States and China. Plubell Testimony Depo. of Oct. 3,

2014 at 176:6-198:13 and Exhibits 46 and 48-53 thereto; Plubell Testimony Depo. of Dec. 2, 2014 at 124:5-125:10, and Exhibits 59, 61-64, 67, 69-70, 72-75, 77, 79-80, and 58, 60, 65-66, 71, 76, 78, 81-85, 87-89, 91, 93-97 (Highly Confidential/Commercially Sensitive/Attorney's Eyes Only) thereto.

Further, it is well established that the contemporaneous use of identical marks can lead to the assumption that there is a common source “even when [the] goods or services are not competitive or intrinsically related.” In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). To support a finding of likelihood of confusion, it is sufficient the respective goods or services are related in some manner, *or* the conditions and activities surrounding the marketing of the goods or services are such that they could be encountered by the same persons under circumstances which could give rise to the mistaken belief they originate from the same source as is the case here because of the similarity of the marks. Hilson Research, Inc. v. Soc’y for Human Res. Mgmt., 27 USPQ2d 1423 (TTAB 1993); In re Int’l Tel. & Tel. Corp., 197 USPQ 910, 911 (TTAB 1978).

**c. Respondent’s Identification Is Unrestricted**

Respondent argues that Petitioner mischaracterizes Respondent’s identification of its Registered Mark as being “unrestricted”. Resp. Tr. Brief at 18. To the contrary, Respondent’s services are *unrestricted* as to geographic location, channels of trade, classes of customers, and conditions of marketing. Respondent’s identification clearly identifies the provision of business information and business consultation about requirements for doing business between China and other countries and facilitating the conducting of business transactions between China and other countries is *to “others”*. The use of “others” without any conditional clause whatsoever leaves “others” to include the *entire consuming public in the United States and abroad*. Pet. Tr. Brief at 17-18.

**d. Respondent Ignores The Record That Petitioner Has Long Provided Business Consulting Services In Association With Petitioner’s “BUSINESS BRIDGE”, “EAST WEST BANK”, And “EAST WEST BANK [and Design]” Marks**

Respondent’s conclusory statement that Petitioner is a bank and, therefore, does not engage in business consulting services blatantly ignores the unimpeachable evidence of record in this proceeding in

which Petitioner amply established that it has continuously provided business consulting services to its customers in association with its “EAST WEST BANK” and “BUSINESS BRIDGE” Marks since Petitioner first began using such marks in the mid-1990s, nearly a decade prior to Respondent’s first use of its “EAST-WEST BUSINESS BRIDGE” Mark. Resp. Tr. Brief at 18; Petitioner’s Exhibit 26; Wang Testimony Depo. at 48:12-49:1, 60:6-13, 83:8-90:18, 90:20-103:23, 122:1-5, 123:23-128:16, 183:10-183:25, 197:15-17, and 199:13-201:7; Respondent’s Exhibit 38 at 209:3-214:1; Respondent’s Exhibit 39 at 256:19-262:5, 413:14-21; Petitioner’s Exhibit 141 at 65:7-66:4, 72:12-25, 109:3-110:8, and 206:18-208:24; Petitioner’s Exhibit 142 at 264:17-24, 271:25-274:9, 277:2-280:4, and 286:11-290:4.

Respondent erroneously asserts that Petitioner’s services are restricted to those set forth in its Registered Marks and banks cannot engage in business consulting services. Resp. Tr. Brief at 18-19. The issue here is whether Respondent’s Registration lists services that are similar to the services offered by Petitioner, the senior user, under Petitioner’s Registered Marks regardless of whether or not such services are listed in the pleaded registrations. The business consulting services continuously provided by Petitioner in association with its Registered Marks are rightfully considered in the likelihood of confusion determination. In addition, business consulting services in Class 35 and banking and financial services in Class 36 can originate from a single source. *See* Petitioner’s Exhibit 27 (U.S. Registration No. 3,695,269).

Respondent’s characterization of Petitioner’s business consulting services as merely “incidental customer service in the delivery of banking services” is without merit. Resp. Tr. Brief at 19. The term “consulting” means “employed or involved in giving professional advice to the public”. *See* Petitioner’s Exhibit 139. The provision of business consulting services to its customers is indeed what Petitioner engages in when an employee of Petitioner professionally consults with a client or potential client of the bank—the employee’s time and the costs associated with the consultation are recouped when the client *purchases* or *subscribes* to a particular product or service and hence the consulting is “fee-based”. *See* Respondent’s Exhibit 25 at Response No. 13 (emphasis added). Thus, to say that Petitioner’s revenues are only derived from banking activities is simply not true. Resp. Tr. Brief at 19.

### 3. The Established, Likely-To-Continue Channels Of Trade Are Similar

In the instant proceeding, because there are *no* restrictions as to trade channels or classes of customers in Respondent's Registration, it is presumed that Respondent's services will travel in the same channels of trade to the same class of purchasers. CBS Inc. v. Morrow, 708 F.2d 1579, 1581, 218 USPQ 198 (Fed. Cir. 1983).

#### a. Respondent's Identification Of Services In Its "EAST-WEST BUSINESS BRIDGE" Registration Is Not Expressly Limited As To Channels Of Trade And Classes Of Purchasers

Respondent argues through both sides of its mouth. It alleges its "normal and usual channels of trade are by 'word of mouth, by direct introduction, by trusted introduction from one individual to another, very sophisticated individuals.'" Resp. Tr. Brief at 20. Yet in the next page, Respondent turns around and insists it markets its services through its "website", "emails", and even "phone calls". Id. at 21. The reason why Respondent finds it convenient to argue out of both sides of its mouth is because Respondent's own identification of services does not impose any limitation to remind Respondent what it has asserted a page ago.

Respondent's assertion that its recitation of services is "unique", identified with Respondent, and the provision of business information is personal and hence expressly limits the class of purchasers is misguided. Id. at 20. An express limitation by definition cannot be grafted on, but must be expressly stated in the description of services, which is conspicuously absent. Respondent's analogy of the provision of business information and consultation by professionals such as attorneys, accountants and doctors is wrong because attorneys, accountants and doctors are professionals as they are licensed, while consultations can be provided by anyone. Further, attorneys, accountants and doctors do advertise on the internet, buses, and billboards, all media and provide their service directly, through middle persons such as insurers, so can Respondent, if it chooses to since it is not limited by its own identification of services. While Respondent's principal may believe that she is *the* "EAST-WEST BUSINESS BRIDGE" and her services are "unique" for specific individuals, such belief, no matter how strong, is not reflected in its identification of services. Therefore, such belief does not change the fact that Respondent's services are

*unrestricted* as to geographic location, channels of trade, classes of customers, and conditions of marketing. Respondent's identification of services identifies that the *provision of business information and business consultation* about requirements for doing business between China and other countries and facilitating the conducting of business transactions between China and other countries is "*to others*", without any conditional clause limiting the scope of "others", which includes the *entire consuming public in the United States and abroad*. Pet. Tr. Brief at 17-18.

**b. Respondent's Channels Of Trade And Classes Of Purchasers Are Similar To Petitioner's**

Regardless of the lack of restriction as to trade channels, Respondent's comparison of the parties' respective trade channels (Resp. Tr. Brief at 21) ignores the fact that the evidence of record establishes that the parties' respective services are or could be marketed in legally identical trade channels and that Respondent has no use at all. Pet. Tr. Brief at 31 and 37-43. Specifically, not only are the trade channels and classes of customers for the parties' respective services *presumed to be the same*, the evidence shows that some of them are *actually the same* and others are *similar*. See Pet. Tr. Brief at 31-32; Resp. Tr. Brief at 21.

As previously stated, Petitioner has continuously served a business clientele with business consulting services in association with Petitioner's Registered Marks. Petitioner's Exhibit 26; Wang Testimony Depo. at 48:12-49:1, 60:6-13, 83:8-90:18, 90:20-103:23, 122:1-5, 123:23-128:16, 183:10-183:25, 197:15-17, and 199:13-201:7; Respondent's Exhibit 38 at 209:3-214:1; Respondent's Exhibit 39 at 256:19-262:5, 413:14-21; Petitioner's Exhibit 141 at 65:7-66:4, 72:12-25, 109:3-110:8, and 206:18-208:24; Petitioner's Exhibit 142 at 264:17-24, 271:25-274:9, 277:2-280:4, and 286:11-290:4. Respondent's services are similarly delivered through business-to-business channels in the nature of personal services. Plubell Testimony Depo. of Oct. 3, 2014 and Exhibit 54 (Response to Interrogatory No. 4(b)) thereto.



Petitioner testified about how it does advertising through mass-market channels. However, Petitioner never testified that this is the sole channel. Besides, even Respondent stated that it markets through mass-market channels such as “its website” and “emails” just the same. Resp. Tr. Brief at 21.

Further, even though Respondent pointed out TV advertising is only carried out in California, Petitioner does advertise in other media outside California. Further, Petitioner has a strong presence on the East Coast, namely, in Massachusetts, New York, and Georgia, which are in close proximity to Respondent’s current location in the Mid-Atlantic region (i.e., District of Columbia), where TV advertising does not play any role at all, instead word of mouth referral is still one of the customary channels. *See* Pet. Tr. Brief at 31-32.

**4. The Parties’ Sophisticated Customers Can Be Confused As To The Source Of The Services Under Respondent’s Confusingly Similar “EAST-WEST BUSINESS BRIDGE” Mark**

Respondent fails to address the well settled authority cited by Petitioner that even sophisticated purchasers are *not* immune from source confusion, particularly in cases such as the instant one involving highly similar marks and closely related services. *See* Pet. Tr. Brief at 32-33; Resp. Tr. Brief at 21-22; *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), *citing* *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers . . . are not infallible.”); *see also* *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Respondent’s reliance on *First Nat’l Bank v. First Nat’l Bank* is completely inapposite as the Eighth Circuit in that case affirmed the district court’s finding that the *graphic use of the banks’ full legal names with their respective logos* reduces the similarity between the marks and hence any likelihood of confusion. *First Nat’l Bank v. First Nat’l Bank*, 153 F.3d 885, 889, 47 USPQ2d 1847 (8th Cir. 1998).

Respondent’s claim of [REDACTED]

[REDACTED] for the identified service. Worse, any

[REDACTED] has been deliberately

redacted, in direct defiance of the Board's Order to provide such revenue information. Therefore, Respondent's allegation of sophisticated customers, when no such customers exist, should be rejected.

### 5. Petitioner's Marks Have Extensive Public Recognition And Renown

Petitioner did not state that its "BUSINESS BRIDGE" Mark was incontestable "well before" Respondent's "EAST-WEST BUSINESS BRIDGE" Mark registered on June 17, 2008. Pet. Tr. Brief at 22-24. However, Petitioner did state that its Registered Marks are famous pursuant to 15 U.S.C. § 1125 and were famous "well before" Respondent's September 28, 2007 filing date and there is certainly no bad faith in asserting same. *Id.* at 24.

Respondent should indeed be "shocked" with the inclusion of this fifth du Pont factor in Petitioner's Main Trial Brief (see Resp. Tr. Brief at 23) because of its ignorance that Petitioner is a well-known and recognized bank across most of the major United States markets (i.e., California, Georgia, Massachusetts, New York, Nevada, Texas and Washington). *See* Petitioner's Exhibits 40-41. Indeed, East West Bancorp, a publicly owned company traded on the Nasdaq Global Select Market under the symbol "EWBC", was selected to be among Forbes Global 2000 companies, due to the success and renown of its East West Bank subsidiary. *See* Respondent's Exhibits 14-15; Petitioner's Exhibits 40-41. Even though East West Bank is primarily a regional bank, its footprint and renown are not just nationwide, but worldwide. *See* Respondent's Exhibits 14-15; Petitioner's Exhibits 40-41.

Respondent's reliance on the Board's precedential decision in Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC, is misplaced. *See* Resp. Tr. Brief at 23. In Leading Jewelers Guild, Inc., the parties' respective marks were "collective membership marks"<sup>5</sup> in which the analysis under Section 2(d) with respect to collective membership marks is *different* from that with respect to trademarks or service marks. Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC, 82 USPQ2d 1901 (TTAB 2007). A collective membership mark does *not* involve purchasers of goods or services as its sole purpose is to

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<sup>5</sup> In addition to its collective membership marks, Defendant had one registered service mark that was likewise subject to Plaintiff's Petition to Cancel.

indicate *membership* in an *organization*. Id. citing Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc., 77 USPQ2d 1492, 1512 (TTAB 2005) (emphasis added). Plaintiff's evidence consisted of 27 *members* (among 150 retail stores) that belong to Plaintiff and figures relating to advertising and catalog circulation for the year 2003 only. Id. Such figures for a *single* year were not particularly meaningful to the Board. Id. The Board ultimately concluded that the evidence submitted by Plaintiff to demonstrate that its mark was famous fell short of establishing that Plaintiff's collective membership mark was famous and concluded that this du Pont factor was *neutral*. Id.

While Petitioner may be based in Southern California, Petitioner advertises its services under its Registered Marks in all major markets, namely, California, Georgia, Massachusetts, Nevada, New York, Texas and Washington, with a strong presence in the strategic locations across the country. Wang Testimony Depo. at Exhibits 5, 15, 18, and 20-21; Dkt. No. 104 at Exhibit I. Petitioner finds it hard to believe that Respondent's principal, who formerly served as Vice President, Associate General Counsel and Corporate Secretary of the largest government sponsored enterprise and financial intermediary in the education credit market in the United States (i.e., Sallie Mae), has never heard of Petitioner prior to receiving a cease and desist letter in December 2010. *See* Resp. Tr. Brief at 23-24; Respondent's Exhibit 6. Further, both "EAST WEST BANK" and "BUSINESS BRIDGE" showed up in Respondent's 2003 Thomson & Thomson Trademark Search Report (and even an opinion of counsel was issued, but not produced) which Respondent choose to ignore and wish to forget.

Lastly, Respondent's assertions regarding the questionable veracity of Petitioner's Trial Brief as to Petitioner's advertising, marketing and promotion expenses for its "BUSINESS BRIDGE" Mark are completely meritless. Resp. Tr. Brief at 24. As previously stated (Pet. Tr. Brief at 33), Petitioner had a net income of around **\$1.5 billion** of products and services sold under and in association with Petitioner's Registered Marks from 2002 to 2013 alone, and that it spent around [REDACTED] in advertising its products and services per year. Wang Testimony Depo. at 44:15-47:18, 76:19-79:12 and Exhibits 14 (Trade Secret/Commercially Sensitive) and 25 thereto. Petitioner spent on average approximately nearly a [REDACTED] [REDACTED] per year in advertising, public relations and promotion expenses from 2003 to 2013 for the

“BUSINESS BRIDGE” Mark,<sup>6</sup> which is nearly 30% of its advertising expenditures each year as previously set forth in Petitioner’s discovery responses. *Id.* at 75:1-76:18 and Exhibit 13 (Trade Secret/Commercially Sensitive) thereto; Respondent’s Exhibit 36 at Response No. 25.

As Petitioner’s Registered Marks have extensive public recognition and renown, this du Pont factor weighs in Petitioner’s favor.

#### **6. The Record Lacks Evidence Of Any Third-Party Use Of Similar Marks In Connection With Similar Services**

Respondent’s statement that Petitioner misinterprets the sixth du Pont factor as requiring third-party use or registration of identical terms to be relevant is baseless. *See* Pet. Tr. Brief at 34; Resp. Tr. Brief at 24-25. Petitioner understands that the sixth du Pont factor considers the number and nature of *similar* marks in use on *similar* goods. Pet. Tr. Brief at 34.

Contrary to Respondent’s assertions, the terms “East West” and “Bridge” are *not* weak components of Petitioner’s Registered Marks. Resp. Tr. Brief. at 25. Respondent’s cited third-party registrations of “East West” lack any similarity to Petitioner’s “EAST WEST BANK” Marks for similar services in Classes 35 or 36 and should *not* be entitled to any probative value. As discussed above, Respondent’s reference to various exhibits of “East West” United States trademark registrations, “East West” and “East West and Business” Google search results, and California Secretary of State business search results for California corporations and LLC’s that begin with “East West”, “East-West”, and “East/West” (Resp. Tr. Brief at 13) are entitled to little weight in this context, if any at all, as the third-party registrations, in particular, do *not* show *actual use* of Petitioner’s Registered Marks by third-parties and resulting impact upon the purchasing public. Stanadyne, Inc., 490 F.2d at 1397, 180 USPQ 649.

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<sup>6</sup> To clarify, while advertising and promotion of Petitioner’s “BUSINESS BRIDGE” Mark always includes its “EAST WEST BANK” Marks, when Petitioner advertises its “BUSINESS BRIDGE” Mark the highlight and key component of the advertising piece is about business and hence it is from these advertising pieces in which it was determined how much Petitioner spent on advertising for its “BUSINESS BRIDGE” Mark. *See* Wang Testimony Depo. at 162:11-23.

In addition, Respondent's cited third-party registrations of "Bridge" (Resp. Tr. Brief at 25) lack any similarity to Petitioner's "BUSINESS BRIDGE" Mark for similar services in Classes 35 or 36 and should *not* be entitled to any probative value. As noted above, third-party registrations, by themselves, are entitled to minimal weight in this context, if any at all, because they do not show actual use of Petitioner's Registered Marks by third-parties and resulting impact upon the purchasing public. Stanadyne, Inc., 490 F.2d at 1397, 180 USPQ at 649.

As for Respondent's reference to its October 2003 Thomson & Thomson Trademark Search Report that shows a so-called "crowded field" of "East West" marks, a careful examination of the Report reveals that there are only *five* marks shown with "East West" out of a total of 41 marks in Group Two (i.e., "*Near-identical* marks such as verb tenses, reversals of terms and other variants of key terms for subject goods and *related* goods") with Petitioner's "BUSINESS BRIDGE" registration appearing within the Group. Plubell Testimony Depo. of Dec. 2, 2014 at Exhibit 104. As for Group Five (i.e., Includes identical and near-identical marks for unrelated goods, and the meaning of acronyms"), there are only *nine* marks shown with "East West" of out of a total of 16 marks with Petitioner's "EAST WEST BANK" registration appearing within the Group. Id. As such, it can hardly be said that there was a crowded field of "East West" marks.

Further, although Petitioner's witness testified that there is another bank named East West Bank, such bank is located outside the United States in *The Philippines*, *not* in the United States as Respondent had speciously implied (Resp. Tr. Brief at 25). Wang Testimony Depo. at 134:19-135:7.

Accordingly, this sixth du Pont factor weighs strongly in Petitioner's favor.

**7. While There Has Been No Actual Confusion As Of Yet, Respondent's Continued Use Of Its Mark Has Great Potential To Generate Actual Confusion**

No actual confusion has yet to occur because Respondent has not used its mark in commerce. But when it does, "EAST-WEST BUSINESS BRIDGE" Mark has *great potential* to general actual confusion as the public is likely to believe that Respondent's services may originate with Petitioner. Here, the extent of potential confusion is *substantial* for the reasons previously set forth in Petitioner's

Main Trial Brief. Pet. Tr. Brief at 35. Accordingly, this Du Pont factor certainly does *not* weigh in Respondent's favor.

### **8. Respondent Has Not Acted In Good Faith Throughout This Proceeding**

Respondent's incredible statement that its "good faith has been manifest throughout this proceeding" could not be any further from the truth. Resp. Tr. Brief at 26. To the contrary, the record speaks for itself in this proceeding as to the *aggressive* and *harassing* nature of Respondent's conduct towards Petitioner through (1) the filing of numerous motions and frivolous counterclaims and necessary conferences with the Board (*see* Dkt. Nos. 8, 11-15, 20, 24, 26, 29-33, 39, 41, 45, 49, 51 and 59), (2) the filing of two separate opposition proceedings against Petitioner's now abandoned service mark applications, (3) forcing Petitioner to file a Motion to Quash the deposition notices of Petitioner's high ranking corporate officers (Dkt. No. 8) and a Motion for Sanctions (Dkt. No. 29) as a result of Respondent's flagrant disregard of the Board's Order (Dkt. 15) granting Petitioner's Motion to Quash, ignoring the Board's admonitions on overreaching discovery, and Respondent's principal's inappropriate communications to Petitioner's high-ranking officers, and (4) open defiance of the Board's Order (Dkt. No. 51) to produce Respondent's revenue information by redacting the [REDACTED] [REDACTED]. As earlier stated, such super aggressive, no-holds bar, scorched earth attack on Petitioner and disobedience of the Board's Order should *not* be condoned.

Contrary to Respondent's assertion, Respondent's October 2003 Thomson & Thomson Trademark Search Report did *not* uncover over 100 active records that contained "East West" as an element. Plubell Testimony Depo. of Dec. 2, 2014 at Exhibit 104. Instead, there were a total of *14* marks with "East West" as an element for the federal registrations, *nine* marks for the state registrations, and *four* marks for the common law registrations. *Id.* Respondent's bold statement that Petitioner's conduct was reckless for not referring to the single entry privilege log from over three years ago in this record-heavy proceeding, should be given no consideration by the Board. Resp. Tr. Brief at 26. Petitioner has since located the single entry Privilege Log produced by Respondent in early 2012 that sets forth the

privileged Trademark Search Opinion Letter dated November 18, 2003. In view of Respondent's representation set forth in its Privilege Log, Petitioner respectfully withdraws its statement at 36 of its Main Trial Brief that Respondent failed to obtain any opinion of counsel. Instead, Petitioner would like to draw the attention of the Board to Respondent's failure to produce any opinion of counsel, which cleared the trademark in dispute without any qualification.

As for Respondent's comment that Petitioner failed to mention that the "Business Bridge" registration cited in the October 2003 Trademark Search Report was allowed to lapse and was subsequently cancelled in 2005 is without merit. Resp. Tr. Brief at 27. Since the registration was valid on record as at the time of the October 2003 Trademark Search Report Respondent had *actual* notice of Petitioner and its Registered Marks. Plubell Testimony Depo. at Exhibit 104. Respondent cannot deny this significant fact and should have refrained from filing its trademark application when Respondent did not receive any unqualified clearance from its counsel. As discussed above, Petitioner re-filed its "BUSINESS BRIDGE" application (with the same May 15, 1997 first use date) shortly after it discovered the first application inadvertently lapsed in 2005.

#### **9. All Relevant Du Pont Factors Strongly Weigh In Petitioner's Favor**

Each of the relevant du Pont factors *strongly* weighs in favor of a finding of likelihood of confusion between Respondent's "EAST-WEST BUSINESS BRIDGE" Mark and Petitioner's "EAST WEST BANK" and "BUSINESS BRIDGE" Marks. To the extent any doubt may exist, it must be resolved against Respondent, the junior user in the United States.

#### **C. Petitioner's Reply To Respondent's Opposition To Petitioner's "Non-Use" And "Abandonment By Non-Use" Claims**

Contrary to Respondent's contentions, Petitioner's "Non-Use" and "Abandonment by Non-Use" claims have rebutted the presumption of validity that attaches to Respondent's Registered Mark for the reasons previously set forth in Petitioner's Main Trial Brief and reaffirmed below. *See* Resp. Tr. Brief at 27; Pet. Tr. Brief at 37-43. Respondent's bold statement that Petitioner seeks to exclude Respondent's evidence of use to avoid a ruling on the merits is completely baseless. Resp. Tr. Brief at 28. As

demonstrated earlier (*see* Pet. Tr. Brief at 37-43) and below, Respondent’s purported evidence of use, objected to by Petitioner, does *not* satisfy the requirement of “use in commerce” for services under 15 U.S.C. § 1127. Moreover, any use of a trademark on the Internet is not necessarily a use in connection with goods or services under the Lanham Act. Utah Lighthouse Ministry v. Foundation for Apologetic Information and Research, 527 F.3d 1045, 86 USPQ2d 1865 (10th Cir. 2008). Respondent’s purported “use” of its Registered Mark is limited to solely its website and nothing else as Respondent has no use at all within the meaning of 15 U.S.C. § 1127.

**1. Respondent’s Purported Evidence To Demonstrate That It Has Continuously Used Or Displayed Its “EAST-WEST BUSINESS BRIDGE” Mark In The Sale Or Advertising Of Its Services Fails To Satisfy The “Use In Commerce” Requirement For Services**

Respondent claims to have continuously used its mark in the sale, advertising, and promotion of its services through various channels since at least 2003 (Resp. Tr. Brief at 28), but such purported “use” does *not* meet the statutory requirement of “use in commerce” for services as Respondent has not rendered its services in commerce for a significant period of time, particularly before the September 28, 2007 filing date of its use-based application. *See* Pet. Tr. Brief at 37-43. Moreover, Petitioner objects to a number of the cited evidence relied upon by Respondent in its demonstration that it continuously used or displayed its “EAST-WEST BUSINESS BRIDGE” Mark in the sale or advertising of its services. *See* Pet. Tr. Brief at Appendix D; Resp. Tr. Brief at 28-32. Specifically, Petitioner objects to the cited evidence under the following headings in Respondent’s Trial Brief: “Respondent’s Letterhead” (Plubell Testimony Depo. of Dec. 2, 2014 at Exhibit 57), “Respondent’s Website” (Plubell Testimony Depo. of Dec. 2, 2014 at 117:4-7, 12-13, 15-18, and 118:8-9, 13-16), “Respondent’s Presentations” (Plubell Testimony Depo. of Dec. 2, 2014 at 190:14-192:4 and Exhibits 78, 96), “Respondent’s Articles” (Plubell Testimony Depo. of Dec. 2, 2014 at 184:15-188:18), and “Respondent’s Electronic Letterhead” (all cited testimony and exhibits except Exhibits 73 and 106 from Plubell Testimony Depo. of Dec. 2, 2014). *See* Pet. Tr. Brief at Appendix D; Resp. Tr. Brief at 28-32. For the reasons set forth in Petitioner’s Appendix D at 50-55 of its Main Trial Brief, such evidence should be excluded from the record.



Respondent's contention that Petitioner "bullies and harasses" Respondent over its so-called "token" amount of advertising expenses is without merit. Resp. Tr. Brief at 32. Petitioner's Motion for Leave to Amend Its Petition to Cancel (Dkt. No. 56 at 5), referenced in Respondent's Trial Brief (*see* Resp. Tr. Brief at 32), includes an argument on Respondent's refusal to produce evidence of its actual performance of services or its sales revenue or advertising or promotion, but there is certainly *no* bullying and harassing of Respondent as shown by the record. Indeed, the Board granted Petitioner's Motion for Leave to Amend Its Petition to Cancel, which demonstrates Petitioner's good faith. Dkt. No. 63 at 3-4.

Further, Respondent's suggestion that all of Petitioner's advertising and promotion efforts consists of "mass-market[ing]" via print, television, and radio ads unlike Respondent's marketing of its services through business-to-business channels in the nature of personal services is baseless. Resp. Tr. Brief at 32. Petitioner's marketing of its services is similarly delivered through business-to-business channels through in person via branch, courier, the Internet, presentations/seminars, and telephone. *See* Pet. Tr. Brief at 31-32; Wang Testimony Depo. at Exhibit 15. In addition, because Respondent's identification of services in its registration is *unrestricted*, the parties' respective services are presumed to travel in the same trade channels and are or could be marketed in legally identical trade channels, as discussed above in Section IV.B.3.

**2. Respondent Failed To Continuously Render Its Services In Commerce Used In Connection With Its "EAST-WEST BUSINESS BRIDGE" Mark**

Contrary to Respondent's assertions, Petitioner's objections to Respondent's evidence as to Respondent's purported rendering of services under the "EAST-WEST BUSINESS BRIDGE" Mark are *not* frivolous. Resp. Tr. Brief at 33; Pet. Tr. Brief at 45-57 (Appendices A-F). Certain of Respondent's evidence should be excluded from the record for the detailed reasons set forth in Petitioner's Appendix to its Main Trial Brief. *See* Pet. Tr. Brief at 45-57 (Appendices A-F).

Respondent's arguments that over the course of this proceeding Petitioner's top executives refused to be deposed, Respondent's principal gave exhaustive deposition testimony, including

testimonial depositions as is typically required during the parties' trial testimony periods, and that Petitioner's counsel refused to reciprocate in the courtesy of giving consent, are simply inaccurate. Resp. Tr. Brief at 33. First, Respondent appeared to have forgotten that the Board granted Petitioner's Motion to Quash the deposition notices of Petitioner's high-ranking officers, which was brought in good faith in response to Respondent's overreaching discovery. Dkt. No. 15. Indeed, Petitioner was forced to file a Motion for Sanctions (Dkt. No. 29) as Respondent had violated the Board's Order granting Petitioner's Motion to Quash (Dkt. No. 15) and ignored the Board's admonitions set forth in its earlier Orders (Dkt. Nos. 7, 15). Second, Petitioner's witness, Emily Wang, provided extensive deposition testimony on three occasions,<sup>7</sup> in discovery (nearly 14 hours of testimony) in January and March 2012 and her later trial testimony deposition during Petitioner's trial testimony period (about 7 hours of testimony) in September 2014. Dkt. Nos. 97, 99. Third, any suggestion that Respondent routinely granted courtesy extensions to Petitioner that were not reciprocated is entirely untrue.<sup>8</sup>

Respondent's further assertion that Petitioner has invented a new legal standard for "token use" reflects a misunderstanding of Petitioner's argument in its Main Trial Brief (*see* Pet. Tr. Brief at 37-43) that Respondent has **no use** at all because it has *not* rendered its services in commerce within the meaning of 15 U.S.C. § 1127. Resp. Tr. Brief at 33-34. Moreover, Petitioner objects to a number of the cited evidence relied upon by Respondent in its demonstration that Respondent has continuously rendered services in commerce. *See* Pet. Tr. Brief at Appendix D; Resp. Tr. Brief at 35-39. Specifically, Petitioner objects to the cited evidence under the following headings in Respondent's Trial Brief: "Respondent's Emails" (all cited testimony and exhibits from Plubell Testimony Depo. of Dec. 2, 2014), "Respondent Charges For Its Services" (cited testimony objected to in part at 74:10-12, 75:15-76:9 from Plubell

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<sup>7</sup> Respondent chose not to depose Ms. Wang or any other adverse witnesses of Petitioner during its respective testimony period late last year.

<sup>8</sup> As for Respondent's request for extension to extend its time to file a motion to withdraw its admissions deemed admitted, Petitioner opposed the motion on the grounds that the initial request was for thirty days instead of two weeks, and because Petitioner's counsel had not had time to consult Petitioner regarding Respondent's second reason for extension. Dkt. No. 38.

Testimony Depo. of Dec. 2, 2014), “Respondent’s [REDACTED]” (nearly all cited testimony and exhibits from Plubell Testimony Depo. of Dec. 2, 2014), and “Respondent’s [REDACTED]” (Plubell Testimony Depo. of Dec. 2, 2014 at 227:7-242:14, 229:2-7, and 235:16-236:1). *See* Pet. Tr. Brief at Appendix D; Resp. Tr. Brief at 35-39. For the reasons set forth in Petitioner’s Appendix D at 50-55 of its Main Trial Brief, such evidence should be excluded from the record.

Lastly, for the reasons previously set forth in Petitioner’s Main Trial Brief (Pet. Tr. Brief at 37-43), the record is clear that Respondent’s evidence as to its purported rendering of services under the “EAST-WEST BUSINESS BRIDGE” Mark is *questionable*, *vague*, and *unsubstantiated* at best. Accordingly, because of the *absence* of any solid documentation or other credible evidence corroborating Respondent’s purported “sales” in the rendering of Respondent’s services in association with the “EAST-WEST BUSINESS BRIDGE” Mark since 2002 to the March 4, 2011 filing date of Petitioner’s Petition to Cancel, the Board should sustain Petitioner’s grounds of cancellation based on abandonment and non-use.

**D. The Conversion Statutes Do Not Change The Legal Entity Of Petitioner Under The Pre-Conversion Name East West Federal Bank, f.s.b. And Post-Conversion Name East West Bank**

As discussed below, Respondent’s counterclaims and unclean hands defense must fail because Respondent cannot demonstrate the following: (1) Petitioner’s filing of its Section 8 declaration for the “EAST WEST BANK” Mark under its pre-conversion name, East-West Federal Bank, f.s.b., renders the registration invalid, (2) Petitioner’s Combined Declaration of Use and Incontestability for the “EAST WEST BANK” Mark filed under its pre-conversion name, East-West Federal Bank, f.s.b., is void *ab initio* by fraud, (3) Petitioner fraudulently secured the Renewal of the “EAST WEST BANK” Mark in 2007, (4) Petitioner fraudulently procured the “EAST WEST BANK [and Design]” Mark through alleged false statements concerning the scope of services rendered under its mark, and (5) Petitioner is barred by the doctrine of unclean hands from relying on the “EAST WEST BANK” or “EAST WEST BANK [and Design]” registrations, or from pursuing non-use and abandonment claims. Resp. Tr. Brief. at 39-50.

Petitioner was founded in 1972 with a limited charter to conduct only a savings and loans business. *See* Wang Testimony Depo. at 22:24-25; Respondent’s Exhibit 46. Petitioner expanded its

authority to that of a full-fledged commercial bank in 1995 by converting to a California state commercial bank. At the same time Petitioner changed its name to East-West Bank to reflect its expanded authority. *See* Wang Testimony Depo. at 13:2-19. Petitioner was finally changed to the present East West Bank in 2005. *See* Woo Testimony Depo. at Exhibit 137 thereto. The conversion was effected when the Articles of Incorporation of East-West Bank was approved by the Superintendent of Banks of the State of California as shown by the Endorsed and Approved stamp dated July 20, 1995 and signed by Peter J. Moren, Counsel, attached to the Articles of Incorporation of East-West Bank. *Id.* at Exhibit 134 thereto. Further, throughout discovery, Petitioner produced extensive records of its conversion and related corporate documents, some of which were made of record during Petitioner's rebuttal testimony period earlier this year. *Id.* at Exhibits 132-138 thereto; Respondent's Exhibit 40 at 132:14-21. In addition, Petitioner's corporate officer, Douglas P. Krause, provided extensive deposition testimony regarding Petitioner's conversion. *See* Petitioner's Exhibit 140. These facts of the conversion and the successive name changes are further confirmed by Institution History for East West Bank of the National Information Center of the Federal Reserve System. Respondent's Exhibit 7. Thus, the records amply show Petitioner did convert from East-West Federal Bank, f.s.b. to East-West Bank in July 1995 along with a change in name (and remains the same legal entity as under the former name).

Petitioner currently has over \$29 billion in assets and a net income of around \$1.5 billion of products and services sold under and in association with Petitioner's Registered Marks from 2002 to 2013. Wang Testimony Depo. at Exhibit 25 thereto. To avoid the herculean task of having to assign and convey numerous contracts, including deposit and checking account agreements, and properties, whether real, personal or intellectual, in a conversion, federal law expressly provides in any conversion from a national bank association to a state bank:

the resulting State bank shall be considered the *same* business and corporate entity as the national banking association, although as to rights, powers, and duties the resulting bank is a State bank. *Any reference to such national banking association in any contract, will, or document shall be considered a reference to the State bank* [ . . . ]

*See* 12 U.S.C. § 214b (emphasis added). Moreover, pursuant to Title 12 of the United States Code and the California Financial Code, which supports Petitioner’s position, as a result of the July 1995 conversion, Petitioner succeeded to all rights and property of East-West Federal Bank, f.s.b. by operation of law, and any reference to East-West Federal Bank, f.s.b. in any writing, whether executed before or *after* the conversion, is deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. *See* 12 U.S.C. § 214b; Cal. Fin. Code § 4950(e); Dkt. No. 66.

Thus, following Petitioner’s July 1995 conversion, Petitioner succeeded to all rights and property of East-West Federal Bank, f.s.b. by operation of law, without the requirement of conveying or changing the name and title of any assets and documents, including trademarks, and any reference to East-West Federal Bank, f.s.b. in any writing, whether executed before or *after* the conversion, is deemed a reference to Petitioner. Therefore, there are no inconsistencies with the provisions of Petitioner’s filings with the USPTO for its “EAST WEST BANK” and “EAST WEST BANK [and Design]” Marks. *See* 12 U.S.C. § 214b; Cal. Fin. Code § 4950(e).

As in any merger or acquisition, until the transaction is consummated, no conveyance or assignment can be signed or recorded pre-merger, which necessitated the acquired entity to file documents conveying properties after it has been acquired even though the acquired entity is no longer around. As Douglas P. Krause testified, it is customary practice to file real estate conveyance documents to clear title: “In real estate it’s not uncommon to do a deed or assignment to yourself . . . and it doesn’t really affect ownership or anything.” *See* Respondent’s Exhibit 40 at 73:3-74:3. The conversion statutes expressly dispensed with all these filings.

**1. Petitioner’s Section 8 Declaration Filed For U.S. Registration No. 2025824 Does Not Render The Registration Invalid**

Respondent contends that Petitioner’s Section 8 declaration dated July 25, 2002 for its “EAST WEST BANK” Mark (Registration No. 2,025,824) was not filed by the owner of the registration, East West Bank, as it was submitted under Petitioner’s pre-conversion name “East-West Federal Bank, f.s.b.”. Resp. Tr. Brief at 39-42. As such, Respondent concludes that Petitioner failed to timely file a Declaration

of Use and hence its alleged invalid registration must be cancelled under Section 8 of the Lanham Act.

Id. Here, Petitioner's Section 8 declaration was executed by East West Bank's Executive Vice President, Chief Risk Officer, General Counsel, and Corporate Secretary, Douglas P. Krause, a long-time employee and corporate officer of East West Bank since 1996, subsequent to the conversion of East-West Federal Bank, f.s.b. to East West Bank (the *same legal entity*) in July 1995.<sup>9</sup> *See* 37 C.F.R. § 2.161(b); Petitioner's Exhibit 140 at 108:17-109:2; Respondent's Exhibits 7, 21.

Since any reference to the pre-conversion East-West Federal Bank, f.s.b. in any writing, whether executed before or after conversion, is deemed a reference to the post-conversion Petitioner East West Bank, the signing by Douglas Krause for East-West Federal Bank, f.s.b. is deemed a signature for East West Bank.

Further, contrary to Respondent's assertions (Resp. Tr. Brief at 39-42) and as shown above, the post-conversion Petitioner East West Bank is the *same legal entity* as the pre-conversion East-West Federal Bank, f.s.b. under federal conversion law because there was *no* change of legal entity when East-West Federal Bank, f.s.b. converted to East-West Bank in July 1995. *See* Petitioner's Exhibit 140 at 66:20-67:7, 103:5-20, 108:17-109:1, 120:8-127:5; Respondent's Exhibit 40 at 40:11-41:25, 42:1-18, 43:1-25, 44:1-46:11, 66:20-67:7, 71:16-74:3, 76:5-7, 81:1-6, 100:12-19, 101:7-22, 102:21-103:20, 107:13-108:25, 114:7-20, 117:2-118:25. Accordingly, Petitioner is the owner of the "EAST WEST BANK" Mark (Registration No. 2025824) in which the Section 8 declaration was filed under its former name, East-West Federal Bank, f.s.b. Thus, as East-West Federal Bank, f.s.b. and East West Bank are considered the *same legal entity*, there is *no* inconsistency with the provisions of the Section 8 declaration and hence the registration is valid.

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<sup>9</sup> Any suggestion by Respondent that Petitioner did not convert from East-West Federal Bank, f.s.b. to East-West Bank in July 1995 because Petitioner had never produced a Certificate of Conversion should be given no consideration by the Board. Resp. Tr. Brief at 40. A conversion certificate is issued only upon application therefor, but it is not required for the conversion to be effective. *See* Cal. Fin. Code § 4952.

Indeed, Petitioner's "Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9" of January 15, 2007 was ultimately accepted by the USPTO on August 28, 2007 after Petitioner responded to a Post Registration Office Action to establish its present ownership in the registration.

Respondent's attempts to characterize Petitioner as making numerous misrepresentations to the USPTO with respect to its other filings with the USPTO with "deliberate and intentional action" are entirely without merit. Resp. Tr. Brief at 40-42. Petitioner's outside counsel at the time prepared the subject formal documents at issue in accordance with the application of the law as they understood it in which some documents were signed by Petitioner's corporate officer, *a non-intellectual property attorney*, even assuming arguendo a mistake was made by putting East-West Federal Bank, f.s.b. instead of East West Bank, it was merely an inadvertent mistake. Petitioner's Exhibit 140 at 194:2-195:2; Respondent's Exhibit 40 at 85:6-12, 91:4-13, 100:12-101:22, 137:19-21.

Respondent's reliance on the Huang and In re ACE III Commc'ns, Inc. cases for the propositions that filing in the name of another entity is not a deficiency that can be corrected after expiration of the grace period, and the owner cannot cure a declaration filed by wrong party if statutory period under Section 8 has expired, is inapposite to the facts in the instant proceeding. Resp. Tr. Brief at 40. However, neither formal assignment nor recordation of assignment in the USPTO is necessary to pass title or ownership to common law or statutory trademark rights to the surviving corporation. Huang v. Tzu Wei Chen Food Co., 849 F.2d 1458, 1460, 7 USPQ2d 1335 (Fed. Cir. 1988) citing American Manufacturing Co. v. Phase Industries, Inc., 192 USPQ 498, 500 (TTAB 1976). Here, the title of the "EAST WEST BANK" Mark passes to the surviving corporation East West Bank. Further, if the party who filed the affidavit or declaration was the owner at the registration at the time of filing, the owner may file evidence to establish ownership even if the filing period set forth in Section 8 of the Trademark Act has expired. In re ACE III Commc'ns, Inc., 62 USPQ2d 1049, 1051-52 (Dir USPTO 2001). If the party who files the affidavit or declaration is in fact the owner of the mark, but there is a mistake in the manner in which the name of the owner is set out in the application, the mistake may be corrected. Id. However, the affidavit

or declaration may not be amended to substitute another separate legal entity as the owner. Id. Here, Petitioner is the owner of the “EAST WEST BANK” Mark by operation of the statutory conversion law as discussed above, therefore, even if the filing period for any declaration of affidavit has expired or there is a mistake in the name of the owner, the mistake may be corrected.

Respondent’s reliance on the In re Precious Diamonds case (Resp. Tr. Brief at 40-41) is likewise inapposite as in that case the appeals court affirmed the Commissioner’s conclusion that because the timely-filed declaration was submitted by an individual and not by the corporation, a *separate legal entity*, the declaration was not filed by “the registrant,” and amendment of the declaration after the statutory deadline would be impermissible. In re Precious Diamonds, Inc., 635 F.2d 845, 847, 208 USPQ 410 (CCPA 1980) (emphasis added).

Respondent’s further contended that Petitioner failed to file a single document assigning or conveying all trademarks in the name of East-West Federal Bank, f.s.b. to East West Bank when it could have easily done so. Resp. Tr. Brief at 41. Yes, Petitioner did not file any assignment or conveying documents, not because of any negligence, but because the federal conversion law expressly dispensed with that formality. Besides, East-West Federal Bank, f.s.b. and East West Bank are the same legal entity, requiring no assignment of any assets, including real estate or intellectual property, such as trademarks. Finally, such assignment is not required under the trademark law when title to trademark passes to the surviving corporation as discussed above. *See Huang*, 849 F.2d at 1460, 7 USPQ2d at 1335.

For the above reasons, Petitioner’s “EAST WEST BANK” registration is indeed valid and should not be cancelled.

**2. The Combined Declaration Of Use And Incontestability For U.S. Registration No. 2,025,824 Filed By Petitioner Is Not Void Ab Initio Because Conversion Law Expressly Blessed Petitioner’s Conduct**

Respondent’s alternative contention that the Combined Declaration of Use and Incontestability for Petitioner’s “EAST WEST BANK” Mark (Registration No. 2,025,824), filed under Petitioner’s pre-conversion name, East-West Federal Bank, f.s.b. is void *ab initio* by fraud since as of 2002 the mark was



being used by East West Bank and not by East-West Federal Bank, f.s.b. is completely without merit.

Resp. Tr. Brief at 42-43.

A party seeking cancellation of a trademark registration for fraudulent procurement bears a *heavy burden of proof*. In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (emphasis added).

The very nature of the charge of fraud requires that it be proven “to the hilt” with clear and convincing evidence, and there is no room for speculation, inference or surmise and, any doubt must be resolved against the charging party. Id. A trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant *knowingly* makes a *false, material representation* with the *intent to deceive* the USPTO. Id. (emphasis added).

Here, Petitioner’s Combined Declaration of Use and Incontestability filed under its pre-conversion name, East-West Federal Bank, f.s.b. on or about July 25, 2002 did *not* contain false statements that East-West Federal Bank, f.s.b. was using the mark in connection with the relevant services. As discussed in detail above in Section IV.D.1, Petitioner is the *same legal entity* as its pre-conversion East-West Federal Bank, f.s.b. as there was *no change of legal entity* when East-West Federal Bank, f.s.b. converted to East-West Bank in July 1995. *See* Petitioner’s Exhibit 140 at 66:20-67:7, 103:5-20, 108:17-109:1, 120:8-127:5 (Dkt. No. 96); Respondent’s Exhibit 40 at 40:11-41:25, 42:1-18, 43:1-25, 44:1-46:11, 66:20-67:7, 71:16-74:3, 76:5-7, 81:1-6, 100:12-19, 101:7-22, 102:21-103:20, 107:13-108:25, 114:7-20, 117:2-118:25. As such, the fact that the timely submitted Combined Declaration of Use and Incontestability was filed under Petitioner’s pre-conversion (same legal entity) name after the conversion certainly does not render it void *ab initio* by fraud.

As set forth above, as a result of the July 1995 conversion, Petitioner succeeded to all rights and property of East-West Federal Bank, f.s.b. by operation of law, and any reference to East-West Federal Bank, f.s.b. in any writing, whether executed before or *after* the conversion, is deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. *See* 12 U.S.C. § 214b; Cal. Fin. Code § 4950(e); Dkt. No. 66. Therefore, the signing on behalf of East-West Federal Bank, f.s.b. is the equivalent of signing for East West Bank by the operation of law, which cannot be made a fraud.

Even assuming *arguendo*, the conversion law was invalidated, Petitioner's corporate officer is not an intellectual property attorney, but he reviews the formal documents prepared by Petitioner's outside counsel to make sure they make sense to him before signing, which he did. Petitioner's Exhibit 140 at 194:11-195:2. Even if the entity was mistaken, it was at most negligent, and Petitioner's corporate officer certainly does not possess the requisite subjective intent to deceive in making statements to the USPTO with a reckless disregard for the truth. Resp. Tr. Brief at 42-43.

Finally, there is absolutely *no* motivation for Petitioner to make any false, material representation with intent to deceive the USPTO by submitting its Combined Declaration of Use and Incontestability and any formal document for that matter to the USPTO under its pre-conversion name, East-West Federal Bank, f.s.b. as at the time of Petitioner's conversion in July 1995, it began to "change all areas that was East West Federal Bank to East West Bank." Wang Testimony Depo. at 38:20-23. Petitioner even accompanied its filing with an "East West Bank" brochure as its specimen. Notwithstanding the above, Petitioner still had documents with the pre-conversion name, East-West Federal Bank, f.s.b. and continued to use such name as the new name, East West Bank, was being phased in as the respective same legal entity names are so close. Petitioner's Exhibit 140 at 119:5- 122:3; Respondent's Exhibit 40 at 117:11-118:25.

Thus, as Petitioner has not *knowingly* made a *false, material representation* with the *intent to deceive* the USPTO, Petitioner's Combined Declaration of Use and Incontestability for its "EAST WEST BANK" registration is not void *ab initio* by fraud.

**3. Petitioner Did Not Fraudulently Secure The Renewal Of U.S. Registration No. 2,025,824**

Respondent's further contention that Petitioner fraudulently secured the renewal of its "EAST WEST BANK" Mark (Registration No. 2,025,824) with its submission of its Combined Declaration of Use and Renewal of Registration of December 19, 2006 filed under Petitioner's pre-conversion name, East-West Federal Bank, f.s.b. is entirely without merit. Resp. Tr. Brief at 43-45. Respondent takes issue

with the fact that Petitioner's corporate officer signed the Declaration as "EVP" of East-West Federal Bank, f.s.b. not East West Bank. Id. at 43.

Petitioner subsequently filed a second Combined Declaration of Use and Renewal of Registration on January 15, 2007 in which Petitioner's corporate officer signed under East West Bank. Id. In response to a Post-Registration Office Action that issued on March 7, 2007, Petitioner recorded a Change of Name on May 9, 2007, supported by a Declaration, which contained true statements.<sup>10</sup> Respondent's Exhibit 16; Respondent's Exhibit 40 at 111:25-115:1, 117:2-119:10, Exhibit F.

Respondent's assertion that the characterization in Petitioner's Declaration dated May 7, 2007 that East West Bank is merely a change of name from East-West Federal Bank, f.s.b. is a "false and misleading statement" is entirely baseless. Resp. Tr. Brief. at 44. As testified by Petitioner's corporate officer, "a conversion is a change from one charter to another. A name change is a name change. *They may happen at the same time, they may not.*" Respondent's Exhibit 40 at 107:13-20 (emphasis added). "[T]he conversion is just a change of charter. It's the same entity." Id. at 108:20-22. "It's the *same entity* whether you change your name or you don't change your name[.]" Id. at 108:24-25 (emphasis added). Here, there was a change of name in conjunction with Petitioner's July 1995 conversion in which the name East-West Federal Bank, f.s.b. was changed to East West Bank. Respondent's Exhibit 40 at 111:25-115:1, 117:2-119:10, Exhibit F; Woo Testimony Depo. at Exhibit 134. The name change was stated on the National Information Center's website. Respondent's Exhibit 7. On August 28, 2007, the USPTO ultimately accepted Petitioner's Combined Declaration of Use and Renewal of Registration of its "EAST WEST BANK" Mark after Petitioner responded to a Post Registration Office Action to establish its present ownership in the registration.

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<sup>10</sup> At the time of Petitioner's Change of Name conveyance submitted for recordation with the USPTO on May 7, 2007 for its "EAST WEST BANK" registration, the nature of conveyance entitled "Entity Conversion" on the current USPTO online assignment form was *not available* as a selection to Petitioner. See Petitioner's Exhibit 39 (and item 5 in Notice of Reliance) thereto. A printout from the USPTO's current Electronic Trademark Assignment System (ETAS) shows that the nature of conveyance entitled "Entity Conversion" is now available as a selection. Id.

Respondent appears to take further issue that because Petitioner did not submit a “Conversion” conveyance for recordation with the USPTO and instead submitted a “Change of Name” conveyance for recordation with the USPTO, the characterization in Petitioner’s May 7, 2007 declaration that East West Bank is merely a change of name from East-West Federal Bank, f.s.b. is a “false and misleading statement”. Resp. Tr. Brief at 44. As noted in footnote 10 herein, at the time of Petitioner’s Change of Name conveyance submitted for recordation with the USPTO on May 7, 2007 for its “EAST WEST BANK” registration, the nature of conveyance entitled “Entity Conversion” on the current USPTO online assignment form was *not available* as a selection to Petitioner. See Petitioner’s Exhibit 39 (and item 5 in Notice of Reliance) thereto. Nevertheless, the evidence demonstrates that there indeed was a change of name in conjunction with Petitioner’s July 1995 conversion in which there was *no change in legal entity*. See Respondent’s Exhibit 40 at 111:25-115:1, 117:2-119:10, Exhibit F; Woo Testimony Depo. at Exhibit 134. Further, any conversion “conveyance” is not required to show ownership under the federal conversion law. See 12 U.S.C. § 214b.

Respondent’s bold contentions that Petitioner’s corporate officer, an experienced and sophisticated corporate attorney, *knowingly* made the statements in his signed May 7, 2007 declaration on behalf of Petitioner with the requisite subjective *intent to deceive* are completely untrue. Resp. Tr. Brief at 44 (emphasis added). Despite Petitioner’s corporate officer’s extensive deposition testimony on the topics of “conversion” and “name change” under oath, Respondent still arrogantly insists that there is a significant difference between a mere name change, where the legal entity remains the same, and a legal conversion of an entity in which Respondent ignores the fact that there is *no change in legal entity*. *Id.*

Respondent’s reliance on the Nationstar case is inapposite as in that case the Board found that applicant’s averments as to his use of the NATIONSTAR mark for the services identified in the application were fraudulent. Nationstar Mortg. LLC v. Ahmad, 112 USPQ2d 1361 (TTAB 2014); Resp. Tr. Brief at 44. In stark contrast, Petitioner has not committed any fraud on the USPTO for the reasons already discussed above. Further, Petitioner’s corporate officer is not an intellectual property attorney, but he reviews, and did review, the formal documents prepared by Petitioner’s outside counsel to make

sure they make sense to him before signing. Petitioner’s Exhibit 140 at 194:11-195:2. Therefore, even assuming *arguendo*, a mistake was made, there was no intent to deceive.

As for Respondent’s ascertainment of Petitioner’s alleged deceptive intent (Resp. Tr. Brief at 44-45), because Petitioner and East-West Federal Bank, f.s.b. are the *exact same legal entities* and any reference to East-West Federal Bank, f.s.b. in any writing, whether executed before or *after* the conversion, is deemed a reference to Petitioner, it cannot be demonstrated or otherwise inferred that Petitioner’s corporate officer possessed the requisite subjective intent to deceive in making false statements to the USPTO. Resp. Tr. Brief at 44-45. Accordingly, Respondent’s contention that Petitioner’s sworn May 7, 2007 declaration was made for the sole purpose of responding to the USPTO Post-Registration Office Action in order to justify the alleged “wrongful” previous filing, is entirely without merit. *Id.* As shown by the evidence of Petitioner’s corporate records and subject USPTO filings and the testimony of Douglas P. Krause and East West Bank’s Assistant Secretary (custodian of corporate records) Mary Woo, Petitioner’s May 7, 2007 declaration truthfully established its present ownership in the “EAST WEST BANK” registration. *See* Petitioner’s Exhibit 39 (and item 5 in Notice of Reliance) thereto; Petitioner’s Exhibit 140 at 119:5- 122:3; Respondent’s Exhibit 40 at 107:13-20, 108:20-22, 24-25, 111:25-115:1, 117:2-119:10, Exhibit F; Woo Testimony Depo. at 9:10-11:19, 14:1-10, 18:24-46:18 and Exhibits 132-138 thereto.

**4. Petitioner Did Not Fraudulently File And Maintain U.S. Registration No. 3,430,148 Because Respondent Failed To Meet Its Heavy Burden of Proof**

Contrary to Respondent’s contentions, and as symbolic of Respondent’s aggressive and overreaching action in asserting its frivolous counterclaims in the instant proceeding, Petitioner denies it fraudulently procured the “EAST WEST BANK [and Design]” Mark (Registration No. 3,430,148) through false statements concerning the scope of services rendered under its mark. Resp. Tr. Brief at 45.

It bears repeating here in view of Respondent’s meritless counterclaims: A party seeking cancellation of a trademark registration for fraudulent procurement bears a *heavy burden of proof*. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (emphasis added). The very nature of the

charge of fraud requires that it be proven “to the hilt” with clear and convincing evidence, and there is no room for speculation, inference or surmise and, any doubt must be resolved against the charging party.

Id. A trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant *knowingly* makes a *false, material representation* with the *intent to deceive* the USPTO. Id. (emphasis added).

**a. Petitioner Did Not Make False, Material Representations Of Fact In Connection With Its Application To Register “EAST WEST BANK [and Design]” With Intent To Deceive The USPTO Since Petitioner Employs “Dual Employees” Who Are Licensed**

Respondent’s contention that Petitioner cannot legally render insurance brokerage or security brokerage services, because it is not licensed as an insurance or securities broker is entirely without merit. Resp. Tr. Brief at 46-50. As demonstrated by the evidence and below, Petitioner employs “dual employees” who are legally licensed through its related affiliate, East West Insurance Services, or a third party broker/dealer to provide insurance brokerage or security brokerage services, respectively, to Petitioner’s customers in association with Petitioner’s marks, including the “EAST WEST BANK [and Design]” Mark. *See* Petitioner’s Exhibit 140 at 146:22-147:5, 151:11-155:23; Respondent’s Exhibit 40 at 57:15-64:17, 65:8-25, 160:1-162:2, 164:11-168:23 (Confidential-Attorneys Eyes Only).

Notwithstanding Petitioner’s evidentiary objections to Exhibits 43-45 of Respondent’s Second Supplemental Notice of Reliance of March 18, 2005 (Pet. Tr. Brief at Appendix F) from Opposition No. 91215389, Respondent’s cited excerpt in its Trial Brief (Resp. Tr. Brief at 46) is consistent with Petitioner’s position with respect to the rendering of certain aspects of Petitioner’s services by Petitioner through its *licensed dual employees* albeit the *mark* and *issues* involved in such opposition *are different*. Respondent’s Exhibit 45 at Response Nos. 2 and 11.

**i. Petitioner Employs “Dual Employees” Who Are Legally Licensed To Provide Insurance Brokerage Services**

Respondent’s assertion that Petitioner merely markets insurance services that are rendered by its sister company, East West Insurance Services,<sup>11</sup> is simply not true. Resp. Tr. Brief at 46. Petitioner employs “dual employees” who are legally licensed through its affiliate, East West Insurance Services, to provide insurance brokerage services to Petitioner’s customers in association with the “EAST WEST BANK [and Design]” Mark. *See* Petitioner’s Exhibit 140 at 146:22-147:5, 151:11-155:23; Respondent’s Exhibit 40 at 57:15-64:17; Wang Testimony Depo. at 105:7-109:7 and Exhibit 16 (Photos of East West Insurance Services taken at Petitioner’s former San Marino, California, branch office; East West Insurance Services has since relocated to Petitioner’s corporate offices on the ground floor in Pasadena, California) thereto. Petitioner’s licensed dual employees act within the scope of their employment with East West Bank and their license in the provision of insurance brokerage services to Petitioner’s customers under the “EAST WEST BANK [and Design]” Mark. Respondent’s Exhibit 40 at 153:7-9. Moreover, use of a mark by a related company of the Owner can be attributed to use by the Owner. *See* 15 U.S.C. §§ 1055 and 1127; *see also Cent. Fid. Banks, Inc. v. First Bankers Corp. of Fla.*, 225 USPQ 438, 440 (TTAB 1984) (holding that use of the mark by petitioner’s affiliated banks considered to inure to the benefit of petitioner bank holding company, even though the bank holding company could not legally render banking services and, thus, could not use the mark). Further, Petitioner retains control or oversight over East West Insurance Services<sup>12</sup> in the rendering of insurance brokerage services through Petitioner’s

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<sup>11</sup> Petitioner’s corporate officer testified that East West Insurance Services, an insurance brokerage firm, is a “related affiliate company” to East West Bank. Respondent’s Exhibit 40 at 64:22-23.

<sup>12</sup> Respondent’s heavy reliance on select excerpts from Emily Wang’s previous discovery and testimony depositions (Resp. Tr. Brief at 46-47) that it is East West Insurance Services that provides insurance services are “high-level” responses to very technical questions that were clarified by Petitioner’s corporate officer, Douglas P. Krause, that Petitioner indeed provides insurance brokerage services in association with its “EAST WEST BANK and [Design]” Mark through its legally licensed “dual employees” who are employees of both East West Bank and East West Insurance Services, but are paid by East West Bank. *See* Petitioner’s Exhibit 140 at 146:22-147:5, 151:11-155:23; Respondent’s Exhibit 40 at 57:15-64:17; Wang Testimony Depo. at 105:7-109:7 and Exhibit 16 thereto. Notwithstanding the above, Emily Wang did testify that some of Petitioner’s employees are licensed to sell insurance brokerage services to Petitioner’s customers. *See* Wang Testimony Depo. at 108:22-109:7. Further, the president of East West Insurance is an employee of East West Bank. Respondent’s Exhibit 40 at 158:1-3.

licensed dual employees under its “EAST WEST BANK [and Design]” Mark. Respondent’s Exhibit 40 at 157:8-158:7.

Respondent’s reliance on the Multifamily Captive Group, LLC case is inapposite as here Petitioner’s dual employees are legally licensed through its affiliate insurance brokerage firm, East West Insurance Services, as discussed above. Resp. Tr. Brief at 47. Respondent’s conclusion that because Petitioner was not a licensed insurance broker, it could not have been legally using its “EAST WEST BANK [and Design]” Mark for “insurance brokerage” services as of the filing date or at any time subsequent to the filing of its application, blatantly ignores the complete evidence of record in which it has been shown that Petitioner’s licensed dual employees provide insurance brokerage services to Petitioner’s customers in association with its mark. Id.; see Petitioner’s Exhibit 140 at 146:22-147:5, 151:11-155:23; Respondent’s Exhibit 40 at 57:15-64:17; Wang Testimony Depo. at Exhibit 16 (Photos of East West Insurance Services taken at Petitioner’s former San Marino, California, branch office) thereto. Petitioner can legally provide such services through its licensed dual employees under the “EAST WEST BANK [and Design]” Mark because it is the owner of the registration. The proper forum for Respondent’s complaint is the appropriate insurance regulatory agencies. To the extent that Respondent seeks to use this forum to challenge Petitioner’s compliance with the state insurance code and any other regulation, this effort is improper and the Board should give no consideration to same. Resp. Tr. Brief at 47.

As for Petitioner’s “insurance consultation” services, Respondent’s contention that Petitioner does not provide “expert knowledge to a third party for a fee” is meritless. Id. at 47-48. Petitioner’s insurance consultation services are not a so-called “document checklist review” or “incidental customer service in the delivery of banking services” as dismissingly characterized by Respondent. Id. at 48. Rather, the term “consulting” means “employed or involved in giving professional advice to the public”. See Petitioner’s Exhibit 139. The provision of consulting services to its customers is indeed what Petitioner engages in when an employee of Petitioner professionally consults with a client or potential client of the bank—the employee’s time and the costs associated with the consultation are recouped when



the client *purchases* or *subscribes* to a particular product or service and hence the consulting is “fee-based”. See Respondent’s Exhibit 25 at Response No. 13 (emphasis added). Thus, to suggest that Petitioner’s revenues are only derived from banking activities is simply not true.

**ii. Petitioner Employs “Dual Employees” Who Are Legally Licensed To Provide Security Brokerage Services**

Respondent’s further contentions that Petitioner’s security brokerage services are not marketed under the name “EAST WEST BANK [and Design]” and the services are rendered by a third-party-dealer partner of Petitioner<sup>13</sup> are without merit. Resp. Tr. Brief at 48. Petitioner employs “dual employees” of its (same legal entity) division, East West Investment Services,<sup>14</sup> who are legally licensed through Petitioner’s broker-dealer, [REDACTED], to provide security brokerage services to Petitioner’s customers in association with Petitioner’s marks. See Respondent’s Exhibit 40 at 65:8-25, 159:1-25, 160:17-161:24, 164:11-168:23 (Confidential-Attorneys Eyes Only). The rendering of Petitioner’s security brokerage services through its dual employees is performed at Petitioner’s bank branches under Petitioner’s operational rules. *Id.* at 160:17- 161:22, 168:2-11 (Confidential-Attorneys Eyes Only).

The reason the Board entered judgment against Petitioner in Opposition No. 91215389 was because Petitioner had decided to withdraw its application for the “EAST WEST INVESTMENT SERVICES [and Design]” Mark as noted in footnote 2 herein this Combined Reply and Trial Brief to avoid spending another five years of its legal resources in battling Respondent. Any suggestion or

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<sup>13</sup> Regarding Respondent’s reference to Exhibits 43-44 in footnote 22 of its Trial Brief (Resp. Tr. Brief at 48), Petitioner’s objects to Exhibits 43-45 of Respondent’s Second Supplemental Notice of Reliance of March 18, 2005 (Pet. Tr. Brief at Appendix F) from Opposition No. 91215389, which involved a completely different mark and issues.

<sup>14</sup> Petitioner’s East West Investment Services division is marketed on Petitioner’s website in which Petitioner’s “EAST WEST BANK [and Design]” Mark is displayed thereon. See Respondent’s Exhibit 39 at 374:17-22, 375:1-16. Petitioner’s “EAST WEST BANK [and Design]” Mark is displayed on each webpage of Petitioner’s website. See Respondent’s Exhibit 11.

inference that judgment was entered against Petitioner for other reasons is speculative.<sup>15</sup> Resp. Tr. Brief at 48.

Petitioner can legally provide security brokerage services through its licensed dual employees of its East West Investment Services division in association with the “EAST WEST BANK [and Design]” Mark because it is the owner of the registration. To the extent that Respondent seeks to use this forum to challenge Petitioner’s compliance with federal financial regulations, this effort is misplaced and the Board should give no consideration to same. *Id.* at 49.

Respondent’s conclusion that Petitioner could not have legally used its “EAST WEST BANK [and Design]” Mark for security brokerage services as of the filing date of the application (Resp. Tr. Brief at 49) ignores the complete evidence of record in which it has been shown that Petitioner’s licensed dual employees indeed provide security brokerage services to Petitioner’s customers in association with its mark. *See* Respondent’s Exhibit 40 at 65:8-25, 159:1-25, 160:17-161:24, 164:11-168:23 (Confidential-Attorneys Eyes Only).

**iii. Petitioner’s Section 7 Amendments Do Not Demonstrate An Intent To Deceive The USPTO**

Respondent’s assertion that Petitioner has utilized its “EAST WEST BANK” Marks interchangeably for identical services is untrue to the extent that Respondent implies that Petitioner’s use of the “EAST WEST BANK [and Design]” Mark is not also a use of the “EAST WEST BANK” (standard character) Mark. Resp. Tr. Brief at 49; Pet. Tr. Brief at Appendix B. The record shows that Petitioner has adopted and continuously used since July 1995 its registered “EAST WEST BANK” and “EAST WEST BANK [and Design]” Marks as previously addressed in Section III.B.1 of Petitioner’s Main Trial Brief.

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<sup>15</sup> Petitioner’s clarifying testimony that East West Investment Services is a division of East West Bank, not a separate entity, provided during Petitioner’s testimony period (Wang Testimony Depo. 172:1-174:1) and cited in Respondent’s Trial Brief (Resp. Tr. Brief at 48), confirms the earlier deposition testimony provided by Petitioner’s corporate officer in which Douglas P. Krause testified that East West Investment Services is a division (the same legal entity) of East West Bank. *See* Respondent’s Exhibit 40 at 159:1-11.

Respondent's bold contentions that Petitioner's alleged "inconsistent" Section 7 Request forms filed in July 2009 and November 2010 raise a "huge red flag" as to Petitioner's intent to deceive the USPTO are completely without merit. Resp. Tr. Brief at 49. Petitioner promptly and voluntarily filed a Section 7 Request form on November 12, 2010 to delete the services "administration of investment trusts for others; brokerage services rendered in the fields of shares and property" from its "EAST WEST BANK" Mark because such services were no longer being used in association with such mark. Respondent's Exhibit 20. Respondent's assertion that the services "insurance brokerage; insurance consultation; security brokerage" should have also been deleted from its "EAST WEST BANK [and Design]" Mark in July 2009 is baseless. Resp. Tr. Brief at 49. Such services are different from the services deleted from its "EAST WEST BANK" Mark in the November 2010 Section 7 Request form. Further, as Petitioner is using the services "insurance brokerage; insurance consultation; security brokerage" in association with its "EAST WEST BANK [and Design]" Mark as discussed above, there is certainly no reason to delete them from its registration.

Lastly, Respondent's incredible contention that Petitioner continued to perpetuate these alleged "false statements" through a Declaration of Use for "EAST WEST BANK [and Design]" filed on May 19, 2014 during the course of this proceeding, is entirely untrue. *Id.* at 50. In a desperate attempt to demonstrate that Petitioner possessed the requisite intent to deceive the USPTO, Respondent contends that Petitioner's trademark paralegal lacks the requisite knowledge to be a proper signatory, but failed to make any showing of such lack of knowledge. *Id.* This a red-herring and Respondent's reliance on the Space Base, Inc. case is inapposite as the real issue here is that there is *no misrepresentation* as Petitioner uses in commerce "insurance brokerage; insurance consultation; security brokerage" services in association with its "EAST WEST BANK [and Design]" Mark as discussed above.

**5. Petitioner Is Not Barred By The Doctrine Of Unclean Hands From Relying On Its Registrations Or From Pursuing Non-Use Claims As Petitioner Has Not Committed Any Fraud Before The USPTO**

The doctrine of "unclean hands" originates from the equitable maxim, "he who comes into equity must come with clean hands." Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha, 209

USPQ 1057, 1065-66 (TTAB 1981). The defense of “unclean hands” is a serious charge that should not be made without careful investigation and solid factual support.<sup>16</sup> As Petitioner has *not* secured and maintained the “EAST WEST BANK” and “EAST WEST BANK [and Design]” Marks fraudulently and without the use required as demonstrated above, Petitioner cannot be precluded from asserting non-use and abandonment claims against Respondent, and such claims are not barred on these grounds alone.

Moreover, where the ground for cancellation is abandonment (as is the case here), the Board has held that the equitable defense of unclean hands is *not* even available in view of the overriding public interest in removing abandoned registrations from the register. American Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1313, 1314 (TTAB 1992). Accordingly, Respondent cannot rely upon the defense of unclean hands as to Petitioner’s abandonment claim.

Contrary to Respondent’s contentions, Petitioner should *not* be precluded from relying upon its “EAST WEST BANK” and “EAST WEST BANK [and Design]” registrations in this proceeding as Petitioner has *not* engaged in any alleged “pattern and practice of making misrepresentation after misrepresentation to the USPTO” as previously discussed above. *See* Resp. Tr. Brief at 50; Dkt. No. 31 at 4-5.

Further, Respondent’s reliance on Duffy-Mott is inapposite as in that case the appeals court found that opposer’s predecessor-in-interest had filed a “patently false” combined affidavit under Sections 8 and 15 in order to maintain the registration in force, even though the mark had not been in use on most of the goods recited in the registration. Resp. Tr. Brief at 50; Duffy-Mott Co. v. Cumberland Packing Co., 424 F.2d 1095, 1098-99, 165 USPQ 422, 424 (CCPA 1970). This is certainly *not* the case in the instant proceeding concerning Petitioner’s maintenance of the “EAST WEST BANK” and “EAST WEST BANK [and Design]” registrations and the recited services used in association therewith.

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<sup>16</sup> The defense of unclean hands has been *rejected* in the following exemplary cases: Hornblower & Weeks Inc. v. Hornblower & Weeks Inc., 60 USPQ2d 1733, 1738-39 (TTAB 2001); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067, 1069 (TTAB 1987); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73, 76-77 (TTAB 1983); and Penn Dairies, Inc. v. Pennsylvania Agricultural Cooperative Marketing Ass’n, 200 USPQ 462, 464 (TTAB 1978).

Thus, Respondent's unclean hands defense must fail.

**E. Respondent's Request For Board Review Of Prior Interlocutory Decision Must Be Denied**

Respondent's request for Board review of the prior interlocutory decision against Respondent's principal's "improper" conduct in contacting Petitioner's two high-ranking officers (i.e., East West Bancorp, Inc. and East West Bank's Chairman and Chief Executive Officer, Dominic Ng and East West Bank's Executive Vice President, General Counsel, Chief Risk Officer, and Corporate Secretary, Douglas P. Krause) without going through Petitioner's counsel should emphatically be denied by the Board at final hearing. Resp. Tr. Brief at 6-7. The interlocutory decision was clear in that the Board did not intend to revisit the parties' past conduct. Dkt. Nos. 7, 33. Moreover, Petitioner's Motion for Sanctions (Dkt. No. 29) was fully warranted at the time as Respondent had violated the Board's December 22, 2011 Order (Dkt. No.15) granting Petitioner's Motion to Quash Respondent's Deposition Notices of Dominic Ng, Chairman of the Board and CEO, and Irene Oh, CFO, and ignored the Board's admonitions in its May 9, 2011 (Dkt. No. 7) and December 22, 2011 Orders regarding Respondent's inappropriate communications to Petitioner's high-ranking officers and Respondent's inappropriate service of deposition notices for three of Petitioner's high-ranking officers. As such, Respondent's characterization of Petitioner's Motion for Sanctions as "entirely frivolous" is completely misplaced. Resp. Tr. Brief at 6.

**V. SUMMARY**

Petitioner has demonstrated that there is a likelihood of confusion between Respondent's *unrestricted* "EAST-WEST BUSINESS BRIDGE" Mark and Petitioner's "EAST WEST BANK" and "BUSINESS BRIDGE" Marks. Petitioner has further demonstrated that Respondent failed to make a bona fide use in commerce of its Registered Mark prior to the September 2007 filing date of its use-based Application and Respondent failed to make a bona fide use of its Registered Mark in the ordinary course of trade for three consecutive years with intent not to resume such use prior to the March 2011 filing date of Petitioner's Petition to Cancel. Finally, Respondent committed sanctionable behavior by failing to comply with the Board's Order compelling the production of Respondent's revenue information. For

these reasons and based on all the evidence introduced at trial, Petitioner respectfully requests the Board to sustain Petitioner's Petition to Cancel on the grounds of priority/likelihood of confusion, non-use, and abandonment for the cancellation of Respondent's "EAST-WEST BUSINESS BRIDGE" Mark.

As for Respondent's counterclaims and unclean hands defense, because Respondent has failed to demonstrate that: (1) Petitioner's filing of its Section 8 declaration for the "EAST WEST BANK" Mark under its pre-conversion name, East-West Federal Bank, f.s.b. renders the registration invalid, (2) Petitioner's Combined Declaration of Use and Incontestability for the "EAST WEST BANK" Mark filed under its pre-conversion name, East-West Federal Bank, f.s.b. is void *ab initio* by fraud, (3) Petitioner fraudulently secured the Renewal of the "EAST WEST BANK" Mark in 2007, (4) Petitioner fraudulently procured the "EAST WEST BANK [and Design]" Mark through alleged false statements concerning the scope of services rendered under its mark, and (5) Petitioner is barred by the doctrine of unclean hands from relying on the "EAST WEST BANK" or "EAST WEST BANK [and Design]" registrations, or from pursuing non-use and abandonment claims, Petitioner respectfully requests the Board to dismiss the counterclaims for the cancellation of Petitioner's "EAST WEST BANK" and "EAST WEST BANK [and Design]" Marks.

Respectfully submitted,

Dated: July 16, 2015

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**PETITIONER’S REPLY TO RESPONDENT’S OPPOSITION TO PETITIONER’S  
EVIDENTIARY OBJECTIONS**

Pursuant to TBMP § 801.03, Petitioner, by and through its attorneys, submits its reply to Respondent’s responses to Petitioner’s evidentiary objections set forth in the Appendix of Respondent’s Trial Brief (Resp. Tr. Brief at 52-60). Respondent’s statement on the “sheer volume” of Petitioner’s evidentiary objections as “telling” in connection with Respondent’s improper evidence that should be excluded is without merit and should be given no consideration by the Board.

Contrary to Respondent’s assertions, Petitioner’s objections are *not* “frivolous or trivial at best” for the reasons set forth below. Resp. Tr. Brief at 52. The Board rules specifically allow for the inclusion of evidentiary objections that may be properly raised in a party’s brief on the case to be raised in an appendix to the party’s brief. TBMP § 801.03. Further, a party to a Board *inter partes* proceeding that believes that proffered evidence should be excluded from consideration may raise an objection. TBMP § 707.01; 37 CFR § 2.122(a).

To the extent that Respondent’s responses are primarily repetitive in nature and have been addressed in Petitioner’s Combined Reply and Trial Brief above, Petitioner incorporates by reference all arguments of fact and law in their entireties set forth in its Main Trial Brief and Combined Reply and Trial Brief as a reply to Respondent’s responses and all other responses set forth by Respondent.

## APPENDIX A

**PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S EVIDENTIARY OBJECTIONS TO THE DISCOVERY DEPOSITION TESTIMONY OF EMILY WANG TAKEN ON JANUARY 30, 2012 (VOL. 1) ELICITED BY CERTAIN QUESTIONS OF RESPONDENT'S COUNSEL****A. Testimony at 178:10-185:22 and Exhibit 7**

The subject testimony and exhibit are *outside the scope* of the issues to be decided by the Board in this cancellation proceeding regarding the parties' respective *English marks* as such testimony and exhibit concern the *Chinese* translation of Petitioner's home page of its corporate website at [www.eastwestbank.com](http://www.eastwestbank.com). Because the Chinese translation of Petitioner's home page of its corporate website has absolutely *no bearing on the issues* in this proceeding (i.e., Petitioner's priority/likelihood of confusion, non-use and abandonment grounds, and Respondent's invalidity and fraud counterclaims), the above testimony and exhibit are *irrelevant* and *inadmissible* under Federal Rule of Evidence 402.

As previously stated, even if the above testimony and exhibit are determined to have some minor relevance to this proceeding, they should still be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.



## APPENDIX B

**PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S EVIDENTIARY OBJECTIONS TO THE CROSS-EXAMINATION OF THE TESTIMONY DEPOSITION OF EMILY WANG TAKEN ON SEPTEMBER 22, 2014 ELICITED BY CERTAIN QUESTIONS OF RESPONDENT'S COUNSEL****A. Respondent's Cross-Examination Questions at 130:15-17, 24-25 and 131:3-4, 8**

Notwithstanding the fact that the witness should not have to repeatedly answer a question that was already asked and answered during her testimony, Petitioner agrees to withdraw its objection.

**B. Respondent's Cross-Examination Questions at 140:23-25 and 141:6-7, 15, 19-21, 25**

The subject cross-examination examination questions assume that Petitioner had knowledge of Respondent's "EAST-WEST BUSINESS BRIDGE" Mark in 2003, 2004, 2005, and 2006, as the witness testified that Petitioner did not object to Respondent's use of its mark during such time periods. Such line of questioning is improper as it assumes facts not in evidence regarding Petitioner's knowledge of Respondent's Registered Mark before the filing of Petitioner's Petition to Cancel in March 2011. Accordingly, the subject questions and Emily Wang's testimony in response thereto should be excluded from the record.

As previously stated, even if the above cross-examination questions and testimony in response thereto are determined to have some minor relevance to this proceeding, they should still be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**C. Respondent's Cross-Examination Question at 153:2-7**

Respondent's line of questioning at 153:2-7 was in connection with the *use* of Petitioner's "EAST WEST BANK" and "EAST WEST BANK [and Design]" Marks, not whether Petitioner's Section 7 filings for its "EAST WEST BANK" Mark were fraudulent. As such, Petitioner maintains its objection that such question at 153:2-7 is a misstatement of law to the extent that it implies that Petitioner's use of its Registered "EAST WEST BANK [and Design]" Mark is not also a use of Petitioner's Registered

(standard character) Mark, “EAST WEST BANK”. As earlier addressed in Petitioner’s Main Trial Brief in Section III.B.1, the record shows that Petitioner has adopted and continuously used since July 1995 its Registered “EAST WEST BANK” and “EAST WEST BANK [and Design]” Marks.

As previously stated, even if the above cross-examination question and testimony in response thereto are determined to have some minor relevance to this proceeding, they should still be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

## APPENDIX C

**PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S EVIDENTIARY OBJECTIONS TO THE CROSS-EXAMINATION OF THE TESTIMONY DEPOSITION OF ANN MARIE PLUBELL TAKEN ON OCTOBER 3, 2014 ELICITED BY CERTAIN QUESTIONS OF RESPONDENT'S COUNSEL**

**A. Testimony at 86:20-88:6**

A review of the testimony deposition transcript of Respondent's principal taken on October 3, 2014, demonstrates that there was no bullying and harassing of Ann Marie Plubell by Petitioner's counsel. Instead, the *self-serving* testimony of Respondent's principal regarding [REDACTED] is *improper* and *not responsive* to any pending question by Petitioner's counsel and is hence *irrelevant* and *inadmissible*. As such, the above testimony should be stricken from the record.

As previously stated, even if the above testimony is determined to have some minor relevance to this proceeding, it should still be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**B. Testimony at 130:2-19 and 131:3-7**

Petitioner maintains its objection to the subject testimony to the extent that the witness is now asserting that there *is* a specialized knowledge or particularized definition of any of the terms in Respondent's "EAST-WEST BUSINESS BRIDGE" Mark or the description of services under such mark when in fact the witness previously testified in July 2012 that there was *no* specialized knowledge needed to interpret any of the terms used in describing the recited services under such mark. Specifically, the witness testified that it takes a sophistication to understand the significance of the distinction between "facilitating" and "executing", which implies that a specialized knowledge is needed to interpret the terms used in the description of services of the "EAST-WEST BUSINESS BRIDGE" Mark. As such, the subject testimony should be stricken from the record as being previously undisclosed by the witness in her prior Discovery Deposition Testimony in July 2012.

As previously stated, the subject testimony should be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**C. Testimony at 207:18-208:7**

Contrary to Respondent's assertions, Petitioner's counsel's inquiry was *not* misleading as it is true that Petitioner's "BUSINESS BRIDGE" Mark was cited in Respondent's October 2003 Thomson & Thomson trademark search report. As noted above in footnote 3 of Petitioner's Combined Reply and Trial Brief, Petitioner's *first* "BUSINESS BRIDGE" application, filed on August 12, 1997 and registered on June 23, 1998, was cancelled on March 26, 2005 as Petitioner had not timely filed its Section 8 declaration. Shortly thereafter, Petitioner re-filed a *second* "BUSINESS BRIDGE" application on May 23, 2006, which registered on May 19, 2009. This does not change the fact that Respondent had knowledge of Petitioner's "BUSINESS BRIDGE" mark in October 2003 regardless of whether the first "BUSINESS BRIDGE" application was subsequently cancelled in 2005.

In view of the above, Petitioner maintains its objection to the introduction into evidence of the subject narrative testimony of the witness. Respondent's principal's narrative testimony on [REDACTED] is *not* responsive to Petitioner's counsel's question at 207:9-15 requiring a simple "yes" or "no" response. Accordingly, the subject testimony should be stricken from the record as it is non-responsive.

As previously stated, even if the above testimony is determined to have some minor relevance to this proceeding, it should still be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**APPENDIX D****PETITIONER'S REPLY TO RESPONDENT'S RESPONSE TO PETITIONER'S EVIDENTIARY OBJECTIONS TO THE TESTIMONY DEPOSITION OF ANN MARIE PLUBELL TAKEN ON DECEMBER 2, 2014 ELICITED BY CERTAIN QUESTIONS OF RESPONDENT'S COUNSEL****A. Exhibits 56-57**

Petitioner maintains its objection to Exhibit 57 as vague and ambiguous as it was not made clear by the witness as to the timing of the use of the particular letterhead on such exhibit purportedly dated October 29, 2013. The witness merely testified that the letterhead was used "periodically" and was being used up at this point (Testimony at 40:9-10).

In view thereof, Exhibit 57 should be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**B. Respondent's Counsel's Direct Examination Questions at 62:14-18, 64:1-5, 7, 65:14-16, 19-21**

Respondent's responses to Petitioner's "foundation" objections to Respondent's counsel's direct examination questions and Respondent's principal's (a non-trademark lawyer) testimony in response thereto regarding the prosecution of Respondent's mark are baseless. Petitioner maintains its objections to Respondent's direct examination questions and the testimony of the witness in response thereto, which should be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**C. Testimony at 65:3-10**

Respondent's response that its testimony is responsive because it directly addresses Respondent's counsel's direct examination question regarding the channels of trade involved in regular business consulting services is meritless. To the contrary, such narrative testimony by Respondent's witness is *not*

responsive to Respondent's question at 64:22-65:2 requiring a simple "yes" or "no" response. As such, the subject testimony should be stricken from the record as it is non-responsive.

As previously stated, even if the above testimony is determined to have some minor relevance to this proceeding, it should still be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**D. Testimony at 68:2-5**

Respondent's assertion that Petitioner has admitted that banking and cash management services are distinct from business consulting services is completely erroneous. In its Main Trial Brief at 30, Petitioner states that "[i]n addition to rendering the above banking related services, Petitioner has continuously provided its customers with business consulting services in association with Petitioner's Registered Marks." Petitioner did not state that banking and cash management services are distinct or otherwise unrelated to business consulting services. Petitioner maintains its objection to the subject testimony of Respondent's witness (a non-trademark lawyer) as lack of foundation regarding the class of purchasers for banking services to the extent that it is an attempt to rewrite or otherwise modify or disclaim certain services as described in Respondent's "EAST-WEST BUSINESS BRIDGE" Mark. Indeed, Respondent has gone to extensive lengths throughout this proceeding in asserting that it is not a bank. *See* Resp. Tr. Brief at 17-18; Plubell Testimony Depo. of Oct. 3, 2014 at 110:17-19, 111:8-11. As such, Respondent's witness lacks foundation regarding the class of purchasers for banking services.

As previously stated, even if the above testimony is determined to have some minor relevance to this proceeding, it should still be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**E. Testimony at 74:10-12, 75:15-76:9, 19, 77:8-13, 82:13-14, 87:6-7,9, and 88:18-19 and Exhibits 98-103**

Petitioner maintains its objection to the above testimony concerning Respondent's [REDACTED], per Petitioner's counsel's standing objection at 74:21-75:3. Contrary to Respondent's assertions, the above testimony is objectionable for not having been previously produced in discovery as specifically ordered by the Board on Petitioner's Motion to Compel (Dkt. No. 51 at 3-4) and in prior depositions. *See* Plubell Testimony Depo. of Dec. 2, 2014 at 254:1-295:1 and Exhibits 126-127, 129 (Interrogatory Response No. 4(c) – Highly Confidential/Trade Secret/Commercially Sensitive/Attorney's Eyes Only), and 130 thereto.

Respondent's mistakenly asserts that all of the above testimony relates to *how* Respondent [REDACTED] when in fact only the testimony at 74:10-12 and 75:15-76:9 relates to how Respondent [REDACTED]. Nevertheless, such characterization by Respondent is a distinction without a difference as *all* such testimony relates to Respondent's [REDACTED] and hence should be excluded from the record for not having been previously disclosed to Petitioner.

Although Exhibits 98-103 were previously produced in discovery albeit *heavily redacted*, the witness has since provided *additional information* on the redacted sections [REDACTED] in her December 2, 2014 testimony that was *not* previously disclosed to Petitioner's Counsel in discovery as specifically ordered by the Board on Petitioner's Motion to Compel (Dkt. No. 51 at 3-4) relating to Respondent's [REDACTED] under the "EAST-WEST BUSINESS BRIDGE" Mark, and in earlier depositions, discovery and testimony depositions.

As previously stated, the above testimony and Exhibits 98-103 must be stricken from the record for Respondent's failure to disclose such information when previously ordered to do so by the Board and in discovery and prior depositions.

**F. Testimony at 117:4-7, 12-13, 15-18, and 118:8-9, 13-16**

Respondent's response to Petitioner's objection to the testimony concerning the maintenance of Respondent's website is without merit. While Respondent may have produced records related to the maintenance of its websites, Respondent's Exhibits 50-52 of the testimony deposition of Ann Marie Plubell on December 2, 2014 relate to the "who-is records" for Respondent's various domain names, namely, annmarieplubell.com, plubellfirm.com, eastwestbusinessbridge.com, and eastwestbusinessbridge.net, but do *not* reference any payment or renewal information. Similarly, Respondent's Exhibits 6 and 13 of its Notice of Reliance refer to printouts from Respondent's website for various years up to 2012 and a printout of the "who-is" information for Respondent's domain name, plubellfirm.com, but again do *not* reference any payment or renewal information.

Accordingly, the subject testimony as well as Respondent's principal's testimony at **119:8-13** on Respondent's payment of renewals (encompassed within Petitioner's counsel's prior objection) must be stricken from the record for Respondent's failure to disclose such information previously sought in discovery and prior depositions.

**G. Testimony at 184:15-188:18 and Exhibit 77**

Petitioner's "translation" objection does not fail as Respondent only provided a two sentence English abstract of its January 2004 *Peking University Education Review* article on the "Press" page of its website. Respondent's Notice of Reliance, Exhibit 6. Respondent failed to previously disclose an English translation of the Chinese publication in its entirety in discovery. For this reason, Respondent's principal's subject testimony and Exhibit 77 must be stricken from the record.

As previously stated, such testimony and exhibit should be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.



**H. Testimony at 190:14-227:3 and Exhibits 78, and 80-97**

Respondent's response to Petitioner's objection to the testimony of Respondent's principal at 190:14-227:3 and Exhibits 78 and 80-97 is *not* "nonsensical" or otherwise "without merit". As evident from the record of Respondent's testimony deposition on December 2, 2014 during Respondent's testimony period, the *subject testimony is a clarification or explanation of material previously redacted from the subject exhibits*. Such clarification or explanation of the previously redacted material was *not* earlier disclosed to Petitioner until the day of Ann Marie Plubell's testimony deposition on December 2, 2014. As such, Petitioner's objection is proper. *See* TBMP § 707.01; 37 CFR § 2.122(a). As previously set forth, the testimony and exhibits (most of which are incomprehensible) concern Respondent's principal's apparent [REDACTED] in association with Respondent's "EAST-WEST BUSINESS BRIDGE" Mark.

As previously stated, the subject testimony and exhibits must be stricken from the record for Respondent's failure to disclose any clarification or explanation of material previously redacted from the exhibits in discovery and prior depositions.

**I. Testimony at 228:18-242:12**

Contrary to Respondent's bold and erroneous assertions, Petitioner's objection to the introduction into evidence the testimony of Respondent's principal in response to the questions of [REDACTED] [REDACTED] is objectionable as inconsistent with and not previously disclosed in response to Petitioner's discovery requests and the Board's Order on Petitioner's Motion to Compel as well as Respondent's principal's prior deposition testimony, including her discovery depositions and testimony deposition of October 3, 2014 for Petitioner's testimony period. *See* Plubell Testimony Depo. of Oct. 3, 2014 at 23:11-28:4; Plubell Testimony Depo. of Dec. 2, 2014 at 254:1-295:1 and Exhibits 126-127, 129 (Interrogatory Response No. 4(c) – Highly Confidential/Trade Secret/Commercially Sensitive/Attorney's Eyes Only), and 130 thereto; *see also* Dkt. No. 51 at 4.

Respondent's assertion the Petitioner's counsel asked for [REDACTED]

[REDACTED] (Testimony at 275:15-276:20), is entirely self-serving testimony from the witness and Respondent's counsel. The record speaks for itself in this proceeding as to Respondent's stonewalling of Petitioner as to Respondent's revenues and rendering of services.

As previously stated, the subject testimony must be stricken from the record for Respondent's failure to disclose such information when previously ordered to do so by the Board and in discovery and prior depositions.

**J. Respondent's Counsel's Direct Examination Question at 245:18-246:3**

Respondent's response to Petitioner's "legal conclusion" and "foundation" objections are meritless as Respondent's inquiry requires a legal conclusion and Respondent's witness is a non-trademark lawyer. Petitioner maintains its objections to Respondent's counsel's direct examination question regarding whether there is any relationship between the services described in the second page of the October 2003 Thomson & Thomson professional trademark search report (Exhibit 104) and the services described in Respondent's Registration.

As previously stated, Respondent's direct examination question and Respondent's testimony in response thereto should be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

## APPENDIX E

**PETITIONER’S REPLY TO RESPONDENT’S RESPONSE TO PETITIONER’S EVIDENTIARY OBJECTIONS TO THE NOTICE OF RELIANCE DATED DECEMBER 2, 2014 SUBMITTED BY RESPONDENT****A. Exhibit 3**

Petitioner maintains its objection to the introduction into evidence of Respondent’s Exhibit 3 (Respondent’s Foreign Registration) as such exhibit is *irrelevant* and *inadmissible* under Federal Rule of Evidence 402. Respondent erroneously asserts that its Chinese Trademark Registration, including an unofficial English translation, for “EAST WEST BUSINESS BRIDGE” is relevant and admissible as to the issue of abandonment. Respondent ignores Petitioner’s legal authority cited for the proposition that “[t]rademark activity outside the United States is ineffective to create rights in this country.” Fruit of the Loom, Inc. v. Fruit of the Earth, Inc., 3 USPQ2d 1531, 1534 (TTAB 1987); *see also* Lever Brothers Co. v. Shaklee Corp., 214 USPQ 654, 657 n.8 (TTAB 1982). More specifically, “[i]nformation concerning applicant’s foreign activities, including foreign trademark applications and/or registrations, is not relevant to the issues in an opposition proceeding.” Double J of Broward, Inc. v. Skalony Sports GmbH, 21 USPQ2d 1609, 1612 (TTAB 1991); *see also* Johnson & Jonson v. Salve S.A., 183 USPQ 375, 376 (TTAB 1974).

As previously stated, even if the above exhibit is determined to have some minor relevance to this proceeding, it should still be excluded from the record because whatever probative value it may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

## APPENDIX F

**PETITIONER’S REPLY TO RESPONDENT’S RESPONSE TO PETITIONER’S EVIDENTIARY  
OBJECTIONS TO THE SECOND SUPPLEMENTAL NOTICE OF RELIANCE DATED  
MARCH 18, 2015 SUBMITTED BY RESPONDENT****A. Section II and Exhibits 43-45**

Contrary to Respondent’s assertions, Opposition No. 91215389, brought solely to harass Petitioner, involved completely different issues from the marks and issues involved in the instant cancellation proceeding. In particular, Respondent’s counterclaim is based on *fraud* grounds in connection with Petitioner’s “EAST WEST BANK” and “EAST WEST BANK [and Design]” Marks. *See* Resp. Tr. Brief at 39-50. No such grounds were raised in Opposition No. 91215389 involving the completely different mark, “EAST WEST INVESTMENT SERVICES [and Design]”.

The Board sustained Opposition No. 91215389 and terminated the proceeding because Petitioner filed a withdrawal of its application for *business reasons* (Dkt. Nos. 9-10), *not* for the reason set forth in Respondent’s Trial Brief (Resp. Tr. Brief at 60).

For the reasons previously set forth in Petitioner’s Trial Brief at 57 and herein above, Section II and Exhibits 43-45 are irrelevant and inadmissible under Federal Rule of Evidence 402.

As previously stated, even if the subject exhibits are determined to have some minor relevance to this proceeding, they should still be excluded from the record because whatever probative value they may possess is outweighed by the danger of unfair prejudice and confusion of the issues and by considerations of undue delay, waste of time, or needless presentation of cumulative evidence, pursuant to Federal Rule of Evidence 403.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **PETITIONER EAST WEST BANK'S COMBINED REPLY AND TRIAL BRIEF ON RESPONDENT THE PLUBELL FIRM, LLC'S COUNTERCLAIMS AND UNCLEAR HANDS DEFENSE** has been served on Respondent's attorneys of record by electronic mail on July 16, 2015, addressed as follows:

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Dated: July 16, 2015