

This Opinion is Not a
Precedent of the TTAB

Mailed: September 8, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
—

East West Bank Co.

v.

The Plubell Firm LLC

—
Cancellation No. 92053712¹
against Registration No. 3448481
—

Alan C. Chen of Zuber Lawler & Del Duca LLP²
for East West Bank Co.

H. David Starr and Howard W. Kline of Nath, Goldberg & Meyer
for The Plubell Firm LLC.

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Before Quinn, Lykos and Hightower,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

¹ On May 7, 2012, the instant cancellation proceeding was consolidated with Opposition No. 91203410, *The Plubell Firm, LLC v. East West Bank*, against Petitioner's application Serial No. 85319594 for the mark **EAST WEST BRIDGE FORUM** (standard characters) on the Principal Register for "providing an on-line forum for international relations" in International Class 38. After the opposition was instituted, Petitioner filed an express abandonment of its application without Respondent's written consent. In accordance with Trademark Rule 2.135, 37 C.F.R. § 2.135, judgment was entered against Petitioner and the opposition was sustained in Respondent's favor.

² After this case was fully briefed, on July 8, 2016, Petitioner filed a notice of appearance for new counsel and revoked its previous authorization for Fox Rothschild LLP to represent Petitioner in this matter.

On March 4, 2011, East West Bank Co. (“Petitioner”) filed a petition to cancel The Plubell Firm LLC’s (“Respondent”) registration on the Principal Register for the mark **EAST-WEST BUSINESS BRIDGE** (standard characters) for “[p]roviding business information and business consultation to others about requirements for doing business between China and other countries and facilitating the conducting of business transactions between China and other countries” in International Class 35.³ As set forth in the amended petition to cancel,⁴ Petitioner alleges that Respondent’s mark so resembles Petitioner’s previously used and registered marks listed below that it is likely to cause confusion, mistake, or deception of prospective consumers under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d):

Registration No. 2025824 for the mark **EAST WEST BANK** (standard characters) on the Principal Register for “banking services; [administration of investment trusts for others; brokerage services rendered in the fields of shares and property;] issuance of travelers checks and letters of credit” in International Class 36, alleging July

³ Registration No. 3448481, registered on June 17, 2008, based on an application filed September 28, 2007, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 4, 2003 as the date of first use anywhere and in commerce, with a disclaimer of the word BUSINESS apart from the mark as shown. During the course of the instant proceeding, Respondent filed a Trademark Act Section 8 declaration of continued use which was accepted on December 3, 2014.

⁴ The operative complaint in this proceeding is Petitioner’s amended complaint (56 TTABVUE 27-32) filed December 31, 2013 with Petitioner’s motion for leave to amend filed under Fed. R. Civ. P. 15(a) and approved by the Board on June 10, 2014. 63 TTABVUE 3.

Citations to the record throughout the decision include references to publicly available documents on TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. No TTABVUE citation is provided for portions of the record designated confidential.

31, 1995 as the date of first use anywhere and in commerce with a disclaimer of “BANK.”⁵

Registration No. 3430148 for the mark displayed below on the Principal Register:



for “Automated teller machine services; Banking; Cash management; Checking account services; Debit card services; Electronic funds transfer; Electronic payment, namely, electronic processing and transmission of bill payment data; Currency exchange and advice; Financial services in the field of money lending; Home equity loans; Financial management; On-line banking services; Installment loans; Insurance brokerage; Insurance consultation; Issuing credit cards; Issue of traveller’s cheques; Issuance of bank checks; Issuing of checks and letters of credit; Money order services; Mortgage banking; Providing temporary loans; Safe deposit box services; Savings account services; Security brokerage; Tax payment processing services; Trust services, namely, investment and trust company services” in International Class 36, alleging January 1996 as the date of first use anywhere and in commerce, with a disclaimer of “BANK.”⁶

Registration No. 3623050 for the mark **BUSINESS BRIDGE** (standard characters) on the Principal Register for “Banking; Cash management” in International Class 36, alleging May 15, 1997 as the

⁵ Issued December 24, 1996, based on an application filed December 17, 1993. A combined Section 8 and 15 declaration of continued use and incontestability was filed August 7, 2002. A combined Section 8 affidavit and Section 9 renewal submitted January 15, 2007 was rejected by the USPTO’s Post Registration division on March 7, 2009 on the ground that the Office records failed to show a clear chain of title in the name of the filing party. After a response was submitted and name change was filed with the Assignment Division, the combined Section 8 and 9 was accepted on August 28, 2007. Subsequently, on November 12, 2010, a request to amend the services under Section 7 was filed deleting “administration of investment trusts for others; brokerage services rendered in the fields of shares and property.”

⁶ Issued May 20, 2008, based on an application filed August 28, 2007; Section 8 affidavit filed May 19, 2014 and accepted May 28, 2014. The description of the mark is as follows: The mark consists of compass logo and “EAST WEST BANK.” Color is not claimed as a feature of the mark.

date of first use anywhere and in commerce, with a disclaimer of “BUSINESS.”⁷

Petitioner also asserts claims of non-use and abandonment: that Respondent failed to make bona fide use of its mark in commerce prior to September 28, 2007, the filing date of its use-based application which matured into the involved registration (Amended Petition to Cancel ¶¶ 16-17); and that prior to the filing date of the instant petition to cancel on March 4, 2011, Respondent failed to make bona fide use of its mark in the ordinary course of trade for three consecutive years with no intent to resume use. *Id.* at ¶¶ 18-21.

Respondent in its answer to the amended petition to cancel denied the salient allegations and asserted various putative and affirmative defenses, including unclean hands which was pursued at trial.⁸ Respondent’s Answer to Petitioner’s Amended Petition to Cancel, 64 TTABVUE. In addition, Respondent filed multiple counterclaims to cancel two of Petitioner’s pleaded registrations: Registration No. 2025824 on the ground that the combined Section 8 declaration of use and Section 15 affidavit of incontestability filed in 2002 in the name of East-West Federal Bank was void, or alternatively, on two

⁷ Issued May 19, 2009, based on an application filed May 23, 2006; Section 8 affidavit filed May 19, 2014 and accepted June 6, 2014.

⁸ Respondent also asserted the affirmative defense of failure to state a claim upon which relief may be granted in its pleading. Respondent filed neither a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief. Accordingly, this affirmative defense is deemed waived. *See Alcatraz Media v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014). In addition, the remaining affirmative defenses asserted but not pursued at trial have been deemed waived. *Id.*

counts of fraud in connection with the filing of post-registration maintenance documents; and Registration No. 3430148 on the grounds of fraud and unlawful use in commerce on the theory that Petitioner, as a commercial bank, cannot legally provide insurance or security brokerage services. Respondent's Answer to Petitioner's Amended Petition to Cancel and Counterclaims; 64 TTABVue 6-14. Respondent's first counterclaim to cancel Registration No. 2025824 centers on the following allegations:

1. On or about December 17, 1993, East-West Bank, F.S.B., a United States Corporation (Federal Savings Bank), filed Application Serial No. 74471889 to register the word mark EAST WEST BANK.
2. Upon information or belief, on or about July 17, 1995, Petitioner incorporated as a California Corporation.
3. On or about July 31, 1995, East-West Federal Bank, F.S.B. assigned its co-pending Trademark Application 74/472,088 for "miscellaneous design" to Petitioner, East West Bank. In the assignment document recorded at the U.S. Patent and Trademark Office, the East-West Bank F.S.B. represented Petitioner to be the "successor in interest to the entire business of Assignor." ...
4. Upon information and belief, subsequent to July 31, 1995, Petitioner operated the banking business previously operated by East-West Bank, F.S.B., and owned all relevant trademarks for the banking business. All trademark applications subsequent to July 31, 1995 were filed in the name of Petitioner. ...
5. On or about December 24, 1996, the EAST WEST BANK word mark registered on the Principal Register under Registration No. 2025824 in the name of East-West Federal Bank F.S.B. This registration is pleaded in the Amended Petition to Cancel.
6. On or about June 16, 2000, East-West Federal Bank, F.S.B. executed a *nunc pro tunc* assignment assigning its rights to the EW & Design (the prior logo used by Petitioner) and its

- registration no. 1,791,861 therefor to Petitioner. Therein, it represented that there was an oral assignment between East-West Federal Bank, F.S.B. and Petitioner concerning the old EW Logo and reciting an effective date of July 1995. ... The Nunc Pro Tunc Assignment was signed on behalf of East-West Federal Bank, F.S.B. by Douglas P. Krause as Senior Vice President, General Counsel and Corporate Secretary.
7. On or about July 15, 2002, East-West Federal Bank, F.S.B. filed a sworn Declaration of Use for Registration No. 2025824 in the United States Patent and Trademark Office. The Declaration was signed by Douglas P. Krause.
 8. Upon information and belief, as of July 15, 2002, East-West Federal Bank, F.S.B. was not the owner of the East-West Bank mark and the registration therefor.
 9. Upon information and belief, as of July 15, 2002, East-West Federal Bank, F.S.B. was not using the East-West Bank mark.
 10. Upon information and belief, Petitioner did not timely file a Declaration of Use for Registration No. 2025824.
 11. On or about December 19, 2006, East-West Federal Bank F.S.B. filed a combined Declaration of Use and Renewal for Registration No. 2025824 in the United States Patent and Trademark Office. The Declaration was signed by Executive Vice President Douglas P. Krause.
 12. Upon information and belief, as of December 19, 2006, East-West Federal Bank F.S.B. was not the owner of the East-West Bank mark and the registration therefor.
 13. Upon information and belief, as of December 19, 2006, East-West Federal Bank, F.S.B. was not using the East-West Bank mark.
 14. On or about January 15, 2007, a second combined Declaration of Use and Renewal for Registration No. 2025824 was filed by Petitioner purporting to change the name of the record from East-West Federal Bank F.S.B. to East West Bank. This second declaration was also signed by Douglas P. Krause, as General Counsel.

15. On or about March 7, 2007, the U.S. Patent and Trademark Office issued a Post Registration Office Action for EAST WEST BANK noting the discrepancy between the owner of record East-West Federal Bank F.S.B. and East West Bank, the filer of the Renewal.
16. On or about May 7, 2007, Executive Vice President and General Counsel Douglas P. Krause executed a sworn declaration on behalf of Petitioner attesting that, notwithstanding East-West Federal Bank F.S.B's existence prior to the incorporation of East West Bank and the previous Assignment filings indicating that Petitioner and East-West Federal Bank F.S.B are separate legal entities, Petitioner "had been doing business under the name 'East-West Federal Bank F.S.B'" and that the Petitioner's name "has been changed and is now called East West Bank." ...

Respondent's Answer to Amended Petition to Cancel and Counterclaims, 64 TTABVUE 6-9. Petitioner in its answer admitted allegation nos. 1, 3-14, and 15 to the extent that "pursuant to Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank by operation of law, and any reference to East-West Bank in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing."⁹ Petitioner's Answer to Respondent's Counterclaims, 66 TTABVUE. Otherwise, Petitioner denied each allegation noted above except to the extent that it admitted the allegation in Paragraph No. 2 that pursuant to the conversion from East West Federal Bank to East

⁹ These statutory provisions also served as the basis for some of Petitioner's affirmative defenses.

West Bank, on or about July 1995, it filed articles of incorporation with the State of California. *Id.*

The two counts of fraud against Registration No. 2025824 are based on the following allegations which Petitioner denies: that “the Combined Declaration of Use and Incontestability filed by East-West Federal Bank, FSB on or about July 15, 2002 contained false statements ... that East-West Federal Bank, FSB was the owner of the mark and was using the mark with the relevant services,” and “in an attempt to cover up” fabrications made in connection with the filing of its combined Section 8 and 9 declaration of use and renewal in 2007 that East-West Federal Bank was the owner of the registration, Petitioner falsely stated in response to a Post Registration Office action that “it had been doing business under the name ‘East-West Federal Bank F.S.B.’ and that Petitioner changed its name from East-West Federal Bank FSB (a U.S. federal savings bank) to East West Bank.” Respondent’s Answer to Petitioner’s Amended Petition to Cancel and Counterclaims, ¶¶ 33, 36, and 37.

With regard to Registration No. 3430148, Respondent’s fraud and unlawful use in commerce counterclaims are based on the following allegations:

20. Upon information and belief, at all relevant times, Petitioner did not and currently does not provide “Insurance brokerage; Insurance consultation” services under the “EAST WEST BANK and Design” mark.
21. Upon information and belief, “Insurance brokerage; Insurance consultation” services have been provided by East West Insurance Services, Inc., a wholly separate corporation and not Petitioner.

22. Furthermore, upon information and belief, East West Insurance Services, Inc. does not provide “Insurance brokerage; Insurance consultation” services under the “EAST WEST BANK and Design” mark. Instead, East West Insurance Services, Inc. provides such services under the mark “EAST WEST INSURANCE SERVICES.”
23. Upon information and belief, at all relevant times, Petitioner did not render “security brokerage services” under the “EAST WEST BANK and Design” mark.
24. Upon information and belief, “Security brokerage” services have been provided by East West Investment Services, Inc., and not Petitioner.
25. Furthermore, upon information and belief, East West Investment Services, Inc., renders “Security brokerage” services under the trademark “EAST WEST INSURANCE SERVICES.” It does not render services under the “EAST WEST BANK and Design” mark.
26. On or about November 12, 2010, Petitioner filed a Section 7 Request with respect to U.S. Registration No. 2025824 deleting “administration of trusts for others; brokerage services rendered in the fields of shares and property” from the existing recitation of services.
27. Petitioner has not filed a corresponding request for Registration No. 3430148, which contains the deleted services in its present recitation of services.

Petitioner denied the above allegations except to the extent that it admitted that its parent company’s subsidiary East West Insurance Services, Inc. provides certain insurance brokerage and consultation services (§ 21), and that East West Insurance Services, Inc. provides certain insurance brokerage and consultation services under the mark EAST WEST INSURANCE SERVICES (§ 22). The remaining allegations were denied.¹⁰

¹⁰ Petitioner also asserted various affirmative defenses, including the following: that Respondent’s non-fraud counterclaims are barred by the doctrines of laches and

The parties have fully briefed the case.¹¹

I. Respondent's Motion to Strike Petitioner's Combined Reply and Main Brief on the Counterclaims

We commence with Respondent's motion to strike Petitioner's combined reply and main brief on the counterclaims. Respondent argues that the reply portion of Petitioner's combined reply and main brief (filed July 16, 2015, 116 TTABVUE) exceeds the twenty-five page limitation and is not properly numbered. Respondent also contends that the fourteen page appendix addressing the evidentiary objections asserted in this proceeding represents an effort to circumvent the page limit and that the brief improperly redacts

acquiescence; and that Respondent's counterclaims are barred by the doctrines of equitable estoppel, unclean hands and waiver. Insofar as none of these affirmative defenses were pursued at trial, they have been deemed waived. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (claims pleaded but not pursued at trial or argued in briefs deemed waived).

¹¹ The interlocutory phase of this proceeding was highly contentious. *See, e.g.*, Board Interlocutory Order dated May 7, 2012, p. 8; 31 TTABVUE 8 and Board Interlocutory Order dated November 14, 2013, p. 2; 51 TTABVUE 2. The rancor continues with Respondent's request embedded in its main brief, to "set the record straight" that the Board rule on Petitioner's motion for sanctions (filed April 23, 2012) which Respondent characterizes as "entirely frivolous." Respondent's Brief, p. 6; 114 TTABVUE 8. Essentially, Respondent's request amounts to an attempt to revisit prior Board interlocutory orders regarding inappropriate communications by Respondent and noticed depositions of Petitioner's high-ranking officers. During the parties' discovery conference which was attended not only by the parties' respective legal counsel but also by Ms. Plubell herself, the Board admonished Ms. Plubell for attempting to contact Petitioner directly about the possibility of settling this case and warned Ms. Plubell that all future communications should be referred directly to Petitioner's legal counsel. Discovery Conference Order, p. 2, 7 TTABVUE 2. But even after being explicitly warned by the Board not to do so, Ms. Plubell again contacted Petitioner directly in an attempt to settle this case. This prompted Petitioner to file a motion for sanctions, which the Board declined to rule upon. The Board's reasoning for declining to rule on the motion for sanctions was sound and need not be revisited. The prior interlocutory orders addressing Respondent's inappropriate conduct speak for themselves.

publicly available, non-confidential information. As Respondent opines, Petitioner’s “errors” are “not merely harmless or sloppy mistakes, but become deeply corrosive to the confidence an ordinary citizen places in access to the trademark protections available to the United States.” Respondent’s Reply Brief in Support of its Counterclaims, p. 6, 119 TTABVUE 8. Respondent requests that the Board strike the reply portion Petitioner’s brief, and presumably the appendix.

Trademark Rule 2.128(b), 37 C.F.R. § 2.128(b), provides that without prior leave of the Board, a party’s reply brief cannot exceed twenty-five pages. However, this same rule states that a main brief cannot exceed fifty-five pages and it is clear that Petitioner’s brief is a *combined* main brief addressing Respondent’s counterclaims *and* reply in support of Petitioner’s claims. Therefore, the fifty-five page rule limit, not the twenty-five page rule, applies. Furthermore, Section 801.03 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) (2016), citing the Board’s decision in *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998), sets forth in relevant part the following guidance in interpreting this rule with regard to evidentiary objections asserted in an appendix:

The parts of the brief that fall within the length limit include the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary. ... Exhibits or appendices to a brief, not being part of the brief itself, are not included within the page limit. *In addition, evidentiary objections that may properly be raised in a party’s brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate*

statement is not included within the page limit. Nevertheless, appendices to a brief may not be used to avoid the page limitation.

(emphasis added). Quoted with approval in *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750 (TTAB 2013), *aff'd mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014). *See also Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992). It is clear that the appendix is devoted solely to arguing evidentiary objections, not any of the substantive claims or counterclaims before us, and therefore does not count toward the page limitation. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d at 1754.

Respondent, however, is indeed correct that the initial pages of the brief are not numbered as required by Trademark Rule 2.126(a)(5), 37 C.F.R. § 2.126(a)(5). That being said, we do not view Petitioner's non-compliance with this rule as a reason to strike the brief in its entirety. Nor do we think this oversight undermines the public's confidence in Board proceedings.

In view of the foregoing, we deny Respondent's motion to strike.

II. Petitioner's Evidentiary Objections

Petitioner has interposed numerous evidentiary objections which are addressed in Appendix A.

III. The Record

At over 9000 non-duplicative pages of evidence, the trial record in this case is voluminous. The record includes the pleadings¹² and, by operation of

¹² Petitioner's submission of the pleadings in this case under notice of reliance was superfluous.

Trademark Rule 2.122, 37 C.F.R. § 2.122, the registration file for Respondent's mark and the registration files for those registrations against which Respondent has stated counterclaims for cancellation. The remainder of the record is summarized in Appendix B.

IV. Designation of Confidential Matter

Large portions of the record have been designated confidential pursuant to the Board's standard protective order,¹³ and for the most part have been treated as such. With a few exceptions, the majority of citations to the record refer to the redacted, publicly available versions of each submission. That being said, both parties improperly designated as confidential some portions of the record. For example, Petitioner improperly redacted the name of the third-party broker dealer with whom it has a relationship. Petitioner's Combined Reply and Trial Brief, p. 40, 116 TTABVue 49. This information is publicly available. Respondent in turn designated vast portions of Ms. Plubell's testimony deposition transcript discussing the purported rendering of services under Respondent's registered mark EAST WEST BUSINESS BRIDGE as confidential, hindering the Board's ability to issue an opinion in this case. This was improper. As explained in *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014):

¹³ Effective June 24, 2016, the Board instituted a revised standard protective order for currently pending *inter partes* cases. However, insofar as the parties had already designated materials as confidential pursuant to the tiers of confidentiality under the Board's former protective order, those designations remain in effect. As such, the former standard protective order applies for the remainder of this proceeding. Further information regarding the Board's new standard protective order is available at "Trademark Trial and Appeal Board News and Notices" at www.uspto.gov.

Board proceedings are designed to be transparent to the public and the contents of proceeding files publicly available. The improper designation of materials as confidential thwarts that intention. Moreover, it is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decision. Therefore, in rendering our decision, we will not be bound by petitioner's designations and in this opinion, we will treat only testimony and evidence that is clearly of a private nature or commercially sensitive as confidential.

See also General Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 USPQ2d 1179 (TTAB 2008); TBMP § 703.01(p) ("Confidential or Trade Secret Material"). We are compelled to follow the Board's practice noted above. That being said, we are mindful of the parties' concerns, and accordingly we have not disclosed any truly confidential information such as client names or financial data.

In addition, neither party followed the Board's well-established practice of enclosing confidential information in brackets in the confidential versions of the briefs and trial record. This practice facilitates the Board's comparison of confidential and public versions of the parties' submissions. *See* TBMP § 801.03 ("Form and Contents of Briefs – Confidential Information"). Compounding matters Petitioner filed inconsistent versions of its publicly available and confidential Combined Reply and Trial Brief. 115 TTABVUE 24-38; 116 TTABVUE 24-38. Suffice to say, in future cases with the Board, the parties are urged to adhere to the above guidelines.

V. The Parties

Petitioner, East West Bank, is a full service commercial bank headquartered in Pasadena, California, serving customers in the United States and “Greater China.” Respondent’s December 2, 2014 Notice of Reliance, Ex. 24 (“Petitioner’s Supplemental Responses and Objections to Respondent’s First Set of Interrogatories,” No. 28), 83 TTABVUE 7. It has approximately 400 employees and 130 branches worldwide. Wang Testimony Deposition (September 22, 2014) at 17:6-22, 23:8-9 and Ex. 3 (excerpts from East West Bank website), 98 TTABVUE 21, 28-29, 267-277. Consumers of Petitioner’s services include the general consuming public and businesses. *Id.* Petitioner’s parent holding company is East West Bancorp, and its affiliates include East West Insurance Services, a sister corporation. Wang Discovery Deposition (Respondent’s Ex. 38) at 39:17-25; 84 TTABVUE 27. Petitioner, in turn, has several wholly-owned subsidiaries or divisions, including East-West Investments Services. Krause Discovery Deposition (Petitioner’s Ex. 40) at 159:5-15, 90 TTABVUE 90; Respondent’s Notice of Reliance dated December 2, 2014, Ex. 15 (“East-West Bancorp, Inc. 2013 Annual Report on Form 10-K”¹⁴), 81 TTABVUE 176. Petitioner also has a relationship with Cetera

¹⁴ We construe this statement by Petitioner’s parent holding company as an admission, and as such, nonhearsay. *See Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1372 (TTAB 1998) (“The final document under question is applicant’s 10-K form filed with the Securities and Exchange Commission. We agree with opposer that applicant’s description of its own services therein would qualify as an admission of applicant, and thus would fall within the statements which are expressly excluded from the definition of hearsay in Fed. R. Evid. 801(d)(2).”).

Investment Services, LLC, a licensed and registered third-party broker dealer. Krause Discovery Deposition (Respondent's Ex. 40) at 65:8-25; 159:1-161:24, 90 TTABVUE 90-92.

Respondent, The Plubell Firm, was founded by Ann Marie Plubell and is a single employee owned firm operated out of her home in the Cleveland Park neighborhood of Washington, D.C. Plubell Testimony Deposition (December 2, 2014) at 11:4-15:14 and Ex. 53; 109 TTABVUE 16-20. It was originally organized as a sole proprietorship, but then subsequently in January 2004 as a limited liability company under the laws of the District of Columbia. Plubell Testimony Deposition (December 2, 2014) at 14:16-17-2, Ex. 53, 109 TTABVUE 20-22. As reflected in Petitioner's registration and confirmed by Ms. Plubell's testimony, the services provided focus on doing business in China and other countries. Plubell Testimony Deposition (December 2, 2014) at 11:13-18, 109 TTABVUE 16. Any services rendered are delivered personally by Ms. Plubell via personal meetings, telephone conferencing, video conferencing, conferencing over the web, and email. Plubell Testimony Deposition (December 2, 2014) at 12:7-19, 109 TTABVUE 17.

VI. Respondent's Counterclaims

Respondent's counterclaims to cancel Petitioner's pleaded Registration No. 2025824 calls into question Petitioner's standing to assert the claims in the Petition to Cancel. In the interests of efficiency, we turn first to resolution of Respondent's counterclaims to cancel both of Petitioner's pleaded registrations before we address claims in the Petition to Cancel.

A. Standing

By virtue of its position as defendant in the instant cancellation proceeding and Petitioner's alleged ownership of its pleaded registrations, Respondent possesses the requisite standing. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999) (“[A]pplicant’s standing to assert the counterclaim arises from applicant’s position as a defendant in the opposition and cancellation initiated by opposer”). *See also Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007).

B. Counterclaims to Cancel Registration No. 2025824

As noted earlier, Respondent has challenged the validity of Petitioner’s pleaded Registration No. 2025824 on the grounds that the combined declaration of use and incontestability under Trademark Act Sections 8 and 15 filed by East-West Federal Bank in 2002 is void because it was not filed by the owner of the registration; or alternatively, that Petitioner committed two counts of fraud in connection with statements made during the post registration filing and review of maintenance documents. Before considering the counterclaims, a brief summary of the post registration history is in order.

On December 24, 1996, the United States Patent and Trademark Office (“USPTO”) issued the above referenced registration to East-West Federal Bank. In order to maintain the registration, the owner is required to file an affidavit or declaration of continued use or excusable nonuse on or after the fifth anniversary and no later than the sixth anniversary after the date of registration, i.e. between December 24, 2002 and December 24, 2003,

augmented by a grace period of six months. *See* 15 U.S.C. § 1058 and Trademark Rule 2.160(a), 37 C.F.R. § 2.160(a). Filing by the current owner is a statutory requirement that must be met prior to the expiration of the six-month grace period established under 15 U.S.C. § 1058(c)(1). On August 7, 2002, a combined Declaration of Use and Affidavit of Incontestability under Trademark Act Sections 8 and 15 for the above-mentioned registration was timely filed with the USPTO. It states in relevant part:

East West Federal Bank, F.S.B., located and doing business at 415 Huntington Drive, San Marino, CA 91108, owns the above-identified registration as shown by the records in the Patent and Trademark Office; that the mark shown therein, in its original or amended form, has been in continuous use in commerce for five consecutive years from the date of registration to the present for all services specified in the Certification of Registration ...

The declaration was signed by Douglas P. Krause under the designation “East-West Bank, F.S.B.”

Thereafter, in order to comply with the renewal requirement, on December 19, 2006, Mr. Krause now designated as “EVP/General Counsel” filed a combined declaration of use under Section 8 and renewal under Section 9 again in the name of East-West Federal Bank stating:

The owner, East-West Federal Bank, F.S.B., having an address of 7th Floor, 135 North Los Robles Avenue, Pasadena, California US 91101, is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9.

For International Class 036, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, ... The specimen is a digital image of applicant's web site front page advertising the services.

The TEAS form lists East-West Federal Bank F.S.B. as the owner.

A few weeks later on January 15, 2007, a second combined Section 8 and 9 declaration/ renewal was filed and signed by Mr. Krause as "General Counsel" but this time stating that East West Bank was the owner of the registration:

The owner, East West Bank, having an address of 135 N. Los Robles Ave. 7th Fl., Pasadena, California US 91101, is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9.

For International Class 036, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) website screenshot.

The TEAS form shows the following:

Owner Section (current): East-West Federal Bank F.S.B.
415 Huntington Drive
San Marino, CA 91108

Owner Section (proposed): East West Bank
135 N. Los Robles Ave. 7th Fl.
Pasadena, CA 91101

On March 7, 2007, the Post Registration division rejected the combined Section 8 and 9 declaration/renewal and issued an ownership inquiry, noting that Office records showed a clear chain of title to East-West Federal Bank F.S.B., not East West Bank. The Office action stated that the party who filed

the combined declaration and renewal must establish ownership by recording documents in the Assignment Division of the USPTO or by submitting proof of transfer of title; and that the registration would be cancelled if the wrong party filed the declaration and there was no time remaining in the grace period for the current owner to file a new declaration. This prompted Petitioner to record a name change with the Assignment Division on May 7, 2007. In support of the name change, Mr. Krause, as “Executive VP of East West Bank” submitted a declaration stating “the corporation has been doing business under the name East-West Federal Bank F.S.B. which is the owner of record of United States Registration Certificate No. 2025824 for the word mark EAST WEST BANK” and that “[t]he Corporation’s name has been changed and is now called East West Bank.” 82 TTABVUE 18. Based on these documents, Post Registration approved the combined Section 8 and 9 declaration/renewal.

Respondent’s first counterclaim to cancel Registration No. 2025824 centers on whether East West Federal Bank was the owner of the registration as of July 25, 2002, the filing date of the combined Section 8 and 15 declaration of use and incontestability. Only the current owner of a registration can file an affidavit or declaration of use or excusable nonuse, and the law is clear that a predecessor in interest is not eligible to make such filings.¹⁵ 15 U.S.C. § 1058(a); Trademark

¹⁵ Prior to the amendment of Section 8 by The Trademark Law Treaty Implementation Act of 1998 (“TLTIA”), the Trademark Act only required that the affidavit or declaration be filed by “the registrant.” According to the legislative history, “[t]hroughout the revised section 8, the term ‘registrant’ has been replaced by the term ‘owner.’ The practice at the Patent and Trademark Office has been to require that the current owner of the registration file all the post-registration affidavits needed to maintain a registration. The current owner of the registration must aver to actual

Rule 2.160(a), 37 C.F.R. § 2.160(a). As explained in the Trademark Manual of Examining Procedure (“TMEP”) Section 1604.07(a) (April 2016):

The affidavit or declaration of use or excusable nonuse must be filed by the owner of the registration. Filing by the owner is a minimum requirement that must be met before the expiration of the deadlines set forth in §8(a) of the Act, 15 U.S.C. §1058(a), (i.e., during the sixth year after the date of registration or publication under §12(c) of the Trademark Act, or within the year before the end of every ten-year period after the date of registration), or within the six-month grace period after expiration of these deadlines. 37 C.F.R. §§2.160(a), 2.161(a).

Hence, if the party who filed the affidavit or declaration was not the owner of the registration at the time of filing, and if there is no time remaining in the grace period, the registration will be cancelled. 15 U.S.C. § 1058(a). For example, in *In re Media Central IP Corp.*, 65 USPQ2d 1637, 1640 (Comm’r Pat. 2002), a combined declaration of use and application for renewal of a trademark registration, filed by the predecessor in interest of the registration’s owner of record, was properly refused on the ground that it was not filed by the owner of the registration, since 15 U.S.C. § 1058 specifically requires that an affidavit or declaration of use be filed by “the owner of the registration.” Moreover, even if

knowledge of the use of the mark in the subject registration. However, the definition of ‘registrant’ in section 45 of the Act states that the terms ‘applicant’ and ‘registrant’ embrace the legal representatives, predecessors, successors and assigns of each applicant and registrant.” Therefore, use of the term ‘registrant’ in section 8 of the Act would imply that any legal representative, predecessor, successor or assign... of the registrant could successfully file the affidavits required by sections 8 and 9. To correct this situation, and to keep with the general principal (sic), as set out in section 1, that the owner is the proper person to prosecute an application, section 8 has been amended to state that the owner must file the affidavits required by the section.” H.R. Rep. No. 194, 105th Cong., 1st Sess. 18-19 (1997).

it is assumed that the person who signed declaration had authority to sign for the true owner, that fact is irrelevant if the declaration is filed by an entity that does not own registration. *Id.*

Respondent argues that Petitioner, following a conversion from a federal savings bank to a California state commercial bank, incorporated as East West Bank in July 1995, and that from that date forward, East West Federal Bank ceased to exist. According to Respondent, East West Bank, not East-West Federal Bank, was the existing and operating entity as of July 25, 2002, the filing date of the combined Section 8 and 15 declaration of use and incontestability. As such, the combined declaration filed on that date was not filed by the owner, thereby making the registration void.

Petitioner counters that contrary to Respondent's assertions, the post-conversion entity East West Bank is the same legal entity as the pre-conversion entity East West Federal Bank but simply under a different name. Relying on both federal and California state banking law, Petitioner contends that following the conversion from a federal savings to a state commercial bank in July 1995, East West Bank automatically succeeded to all rights and property of East-West Federal Bank by operation of law, effectively dispensing with the requirement of conveying or changing the name and title of any assets and documents, including trademarks registered with the USPTO. Petitioner maintains that any reference in writing to East-West Federal Bank, even after the conversion, is deemed a reference to Petitioner without any further action; hence, Mr. Krause's signature on any post-registration maintenance documents

under the designation East-West Federal Bank essentially constitutes a signature on behalf of East West Bank. As a consequence, Petitioner asserts that it did not need to file any assignment or conveying documents for Registration No. 2025824 with the USPTO following the conversion. In support of its position, Petitioner relies on the discovery deposition of Mr. Krause, the person who signed the post-registration maintenance documents, and who stated that the conversion resulted in a name change from East West Federal Bank to East West Bank.¹⁶ Krause Discovery Deposition (Petitioner's Ex. 140) at 66:20-67:7, 103:5-20, 108:17-109:1, 120:8-127:5; 96 TTABVUE 29-30, 32, 36-37, 40-47; Krause Discovery Deposition (Respondent's Ex. 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; 90 TTABVUE 14-18, 35, 39, 44, 49, 63-65, 67-68, 73, 75-76. Petitioner also argues that the name change resulting from the charter conversion is confirmed by "extensive records" produced during discovery and made of record at trial, such as the East West Bank's initial articles of incorporation approved by the Superintendent of Banks of the State of California on July 20, 1995 (Petitioner's Ex. 137)¹⁷ and Post Registration's ultimate acceptance of the maintenance documents.

¹⁶ Some portions of Mr. Krause's discovery deposition transcript were properly made of record under notice of reliance by Respondent, the adverse party, and in turn by Petitioner as the non-offering party. See Trademark Rule 2.120(j)(1), 37 C.F.R. § 2.120(j)(1). When a discovery deposition has been made of record properly as is the case here it may be referred to by any party for any purpose permitted under the Federal Rules of Evidence. Trademark Rule 2.120(j)(7), 37 C.F.R. § 2.120(j)(7).

¹⁷ Petitioner also points to a publicly available document entitled the "Institution History for East West Bank of the National Information Center of the Federal Reserve System: A repository of financial data and institution characteristics collected by the

Despite his critical role as signatory of the post registration maintenance documents, Mr. Krause was not called as a witness at trial.¹⁸ Rather, portions of his discovery deposition are of record. His statements regarding the charter conversion are not a model of clarity, although ultimately he took the position that Petitioner underwent a name change. Krause Discovery Deposition (Petitioner's Ex. 140) at 66:20-109:2, 96 TTABVUE 29-36. Thus, in the absence of any corroborating written documentation, Mr. Krause's discovery deposition is not, standing alone, sufficient to support Petitioner's position. *Cf. Powermatics, Inc. v. Glebe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965) (oral testimony, even of a single witness, if "sufficiently probative," may be sufficient to prove priority); *4U Co. of America, Inc. v. Naas Foods, Inc.*, 175 UPSQ 251, 253 (TTAB 1972) (accepting facts stated on personal knowledge in sworn affidavit).¹⁹ We therefore look to the initial and subsequent articles of

Federal Reserve System" (Respondent's Notice of Reliance filed December 2, 2014, Ex. 7; 78 TTABVUE 189) as further evidence of Petitioner's successive name changes, as opposed to a change in legal entity type. This document, however, constitutes hearsay and cannot be used to prove the truth of the matter asserted therein unless a competent witness testifies to the truth of such matters. *See* Fed. R. Evid. 801. In other words, the document cannot constitute evidence that upon the charter conversion, East West Federal Bank was not dissolved but merely changed its name to East West Bank.

¹⁸ Of course, we do not know whether Mr. Krause was unavailable to testify during trial. We do know, however, that Petitioner, as the interrogated party, did not file a motion under Trademark Rule 2.120(j)(2), 37 C.F.R. § 2.120(j)(2), to introduce his discovery deposition in lieu of trial testimony. "This rule requires, in essence, that the party seeking to rely on its own discovery deposition for purposes of trial make an affirmative showing at the time of the proffer of such evidence that circumstances exist that justify acceptance of the evidence." *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987).

¹⁹ A certificate of conversion constitutes "prima facie evidence of the fact of the conversion and of the regularity of the proceedings taken for the conversion." Cal. Fin. Code § 4952(a). Respondent points out that despite requests during discovery and as ordered by the Board, Petitioner never produced during discovery or submitted as

incorporation for East West Bank authenticated by Petitioner's witness Ms. Woo, Legal and Executive Assistant of East West Bank. Article I of the initial Articles of Incorporation for East-West Bank dated July 24, 1995 states "[t]he name of this Corporation is East-West Bank." Ex. 21 to Respondent's December 2, 2014 Notice of Reliance, 82 TTABVUE 78-85. The only reference to East-West Federal Bank in the initial articles of incorporation appears in Paragraph IV ("Capital Stock"):

Upon the effective date hereof, each of the 100,000 outstanding shares of East-West Federal Bank, f.s.b. stock is hereby reclassified and reconstituted as 1,100 shares of common stock of the corporation.

82 TTABVUE 71. Hence, it appears that as of July 24, 1995, East-West Federal Bank ceased to exist as a separate legal entity. This is confirmed by the provisions set forth in the California Financial Code stating that "[w]hen a conversion becomes effective: The converting depository corporation shall cease to exist." Cal. Fin. Code § 4950(a). Thus, despite statements in Mr. Krause's discovery deposition of a mere name change and continuation of the same legal entity, the articles of incorporation show otherwise – that as of July 1995 East West Federal Bank ceased to exist because there was a change in legal entity.

evidence at trial a certificate of conversion. The Board is not questioning whether the conversion took place – the evidence of record clearly establishes that a conversion occurred. Rather, the issue before us is the narrower question of whether after the conversion, did East West Federal Bank remain in existence under the new name East West Bank or was it dissolved?

This is consistent with the statutory provisions governing California banking conversions.

We therefore find by a preponderance of the evidence that because the owner did not file an affidavit or declaration of continued use or excusable nonuse before the expiration of the statutory grace period, the requirements of Section 8 of the Trademark Act were not satisfied.²⁰ In view of the foregoing, Respondent's counterclaim to cancel Petitioner's Registration No. 2025824 is granted and the registration will be cancelled in due course.²¹

C. Counterclaims to Cancel Registration No. 3430148

We turn now to Respondent's counterclaim of unlawful use in commerce asserted against Petitioner's Registration No. 3430148 for the mark  EASTWESTBANK with regard to the services identified as "insurance brokerage; insurance consultation" and "securities brokerage."

1. Unlawful Use in Commerce

In order to protect consumers, the banking, insurance and securities industries are highly regulated at both the state and federal levels. Respondent argues that Petitioner failed to comply with various state and federal regulations governing the provision of such services because Petitioner, as a

²⁰ Clearly, this deficiency could have been rectified if a corrected Section 8 had been filed during the proscribed time period. *See* Trademark Rule 2.164, 37 C.F.R. § 2.164.

²¹ In light of our determination, we need not consider Respondent's alternative counterclaims of fraud.

commercial bank, is legally prohibited from holding itself out as an insurance or securities broker.

With regard to the insurance brokerage services, Respondent contends that Petitioner East West Bank is merely a marketing vehicle, and that the services are actually rendered by Petitioner's sister company, East West Insurance Services. Respondent points out that Petitioner was not a licensed insurance broker at the time it filed the underlying application or at any time subsequent thereto. In support of its position, Respondent relies on two statutory provisions of the California Insurance Code which bar unlicensed insurance brokerage and make such conduct punishable as a misdemeanor.²² Respondent also cites a California district court case, *Multifamily Captive Group, LLC v. Assur. Risk Managers, Inc.*, 578 F. Supp. 2d 1242 (E.D. Cal. 2008), which applied those provisions to bar a third party which was not a licensed insurance broker from soliciting insurance and receiving commissions.

In addition, Respondent argues that because East West Bank is neither a licensed security broker nor a member of the Securities Investor Protection

²² Cal. Ins. Code § 1631 ("Necessity of license"): "Unless exempt by the provisions of this article, a person shall not solicit, negotiate, or effect contracts of insurance, or act in any of the capacities defined in Article 1 (commencing with Section 1621) unless the person holds a valid license from the commissioner authorizing the person to act in that capacity. The issuance of a certificate of authority to an insurer does not exempt an insurer from complying with this article."

Cal. Ins. Code § 1633 ("Unlicensed transactions; punishment"): "Any person who transacts insurance without a valid license so to act is guilty of a misdemeanor punishable by a fine not exceeding fifty thousand dollars (\$50,000) or by imprisonment in a county jail for a period not exceeding one year, or by both that fine and imprisonment."

Corporation (“SIPC”)²³ or Financial Industry Regulatory Authority (“FINRA”),²⁴ it could not have legally used its registered mark for security brokerage services as of the filing date of the underlying application. As Respondent contends, such services are actually rendered by Cetera, an unrelated but properly licensed broker-dealer partner. In view thereof, Respondent argues that Petitioner has per se violated the broker-dealer registration requirements as set forth under the Securities and Exchange Act of 1934 by marketing such services.²⁵ Respondent also argues that Petitioner

²³ The Securities Investor Protection Corporation (“SIPC”) is “a nonprofit corporation created by an act of Congress to protect the clients of brokerage firms that are forced into bankruptcy. Members to the SIPC include all brokers and dealers registered under the Securities Exchange Act of 1934, all members of securities exchanges and most NASD members.”

Investopedia at <http://www.investopedia.com/terms/s/sipc.asp#ixzz491bgFKWN>

The Board may take judicial notice of definitions of online industry specific encyclopedias. *See* Fed. R. Evid. 201(b)(2) and (c)(1) (“Judicial Notice of Adjudicative Facts”). *See also Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982) (Board takes judicial notice of dictionary definitions), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011) (information from encyclopedias- yes), *aff’d*, No. 1:11-cv-01623-RC, 2016 WL 3034150 (D.D.C. May 27, 2016); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (online reference works which exist in printed format or have regular fixed editions -- yes).

²⁴ “The Financial Industry Regulatory Authority (FINRA) resulted from the merger of the New York Stock Exchange’s regulatory committee and the National Association of Securities Dealers. FINRA, as a regulatory body, is tasked with governing all business dealings conducted between dealers, brokers and all public investors.”

Investopedia <http://www.investopedia.com/terms/f/finra.asp#ixzz491cjCmNY>

See id.

²⁵ 15 U.S.C. § 78o(a)(1) states in relevant part that it is “unlawful for any broker or dealer to make use of any means of interstate commerce and to effect any transactions in, or to induce or attempt to induce the purchase or sale of, any security without registering as a broker with the Commission.

does not market security brokerage services under the registered mark but rather under the mark East West Investment Services.

Petitioner counters that Respondent's assertion that Petitioner merely markets but does not actually provide insurance brokerage services is inaccurate because Petitioner employs dual employees who are legally licensed through its sister company, East West Insurance Services, to provide such services to Petitioner's banking customers. In addition, Petitioner argues that East West Insurance Services' use of its registered mark can be attributed to Petitioner because Petitioner, as the owner of the registered mark, retains control and oversight over its sister company through dual employees. And lastly, in response to Respondent's arguments that Petitioner is unlawfully providing securities brokerage services, Petitioner contends that because it employs dual employees legally licensed through Petitioner's broker-dealer Cetera through its division East West Investment Services at Petitioner's bank branches and under Petitioner's operational rules, it has not violated any SEC statutory provisions or regulations.

The unlawful use in commerce doctrine is derived from Section 45 of the Trademark Act, 15 U.S.C. § 1127, which defines "commerce" as "all commerce which may lawfully be regulated by Congress." Thus, in order to obtain a federal registration, use of a mark in commerce must be lawful. *In re Midwest Tennis & Track Co.*, 29 USPQ2d 1386 n.2 (TTAB 1993) (citing *Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB 1982)). *See also Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) ("A valid

application cannot be filed at all for registration of a mark without ‘lawful use in commerce,’ and, where a claim is made of concurrent rights, such use must begin prior to the filing date of any application by a conflicting claimant to the mark.”). In Board proceedings, the unlawful use doctrine is narrowly applied, and only when “the issue of compliance has previously been determined (with a finding of non-compliance) by a court or government agency having competent jurisdiction under the statute involved, or there has been a per se violation of a statute regulating the sale of a party’s goods or rendering of services, in commerce....” *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958, 964 (TTAB 1981).²⁶ *See also Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045, 2047 (TTAB 1988). “[I]t is incumbent upon the party charging that the use was unlawful to demonstrate by clear and convincing evidence more than that the use in question was not in compliance with applicable law.” *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d 1270, 1274 (TTAB 1992). Not every per se violation is sufficient to justify cancellation of a registration based on unlawful use. “[T]here must be some nexus between the use of the mark and the alleged violation before the unlawfulness of a shipment can be said to result in the invalidity of a registration.” *Id.* (citing *Santinine*, 209 USPQ at 967). In addition, the non-compliance must be “material,” meaning that it “was of such

²⁶ For example, “when a regulatory statute requires that a party’s labels must be registered with or approved by the regulatory agency charged with administering the statute before his goods may lawfully enter the stream of commerce, and the party has failed to obtain such registration or approval.” *Id. See, e.g., Coahoma Chem. Co., Inc. v. Smith*, 113 USPQ 413, 418 (Comm’r Pat. 1957) (“...use of mark in connection with unlawful shipments [in violation of the Federal Economic Poisons Act] in interstate commerce is not use of mark in commerce which Patent Office may recognize.”).

gravity and significance that the previous usage must be considered unlawful — so tainted that, as a matter of law, it could create no trademark rights — warranting cancellation of the registration of the mark involved.” *Id.*

We find that Respondent, as the plaintiff of its asserted counterclaim, has not met its burden of proof. There has been no final determination of noncompliance by Petitioner from any competent court or agency involving any federal or California state statute or regulation governing the provision of Petitioner’s identified “insurance brokerage, insurance consultation” or “securities brokerage” services. *Multifamily, supra*, the California district court case Respondent relies upon, cannot be invoked in this forum to prove unlawful use of a mark in connection with insurance brokerage services because it did not involve Petitioner as a party.

Moreover, Respondent’s attempt to prove that Petitioner’s conduct constitutes a per se violation of any federal or state statute or regulation governing insurance and securities brokerage falls short. It is well established that use of a mark by a related company of the owner of the mark can be attributed to use by the owner. 15 U.S.C. §§ 1055 and 1127; Section 5 of the Trademark Act, 15 U.S.C. § 1055, provides in relevant part:

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

A “related company” is defined under Section 45 of the Trademark Act, 15 U.S.C. § 1127, as follows:

The term “related company: means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

Cent. Fidelity Banks, Inc. v. First Bankers Corp. of Fla., 225 USPQ 438, 440 (TTAB 1984), provides an illustration of the unlawful use in commerce doctrine in instances where the mark is not used by the owner but rather by a related entity. In that case, the Board held that that use of a mark for “commercial banking services” by petitioner’s wholly-owned subsidiary banks inured to the benefit of the petitioner bank holding company, even though the bank holding company could not legally render banking services and, thus, could not use the mark in commerce. As the Board explained:

There is nothing in Section 5 which requires that the person to whose benefit the “related company” use inures be in a position to use the mark lawfully in commerce for the same goods or services in respect of which it is used by the related companies, and no cases are cited by respondent in support of its “unique” proposition to the contrary. In fact, it is common practice for a parent corporation having ownership rights in all of the trademarks of an enterprise to rely on use by related distributing and manufacturing subsidiaries, even though the parent corporation may not itself be authorized to do business in commerce with or in states outside the state of its incorporation. Moreover, respondent’s theory is inconsistent with the rule, long followed by this Office, that ownership rights in a trademark or service mark may be acquired through controlled use by one’s related companies (or licensees) even in the absence of any use by the applicant, registrant or purported owner. (internal citations omitted).

Id. at 439-40. This case makes clear that even if the owner of a registered mark is prohibited from lawfully using that mark in commerce, so long as the mark

is legally used by a related company, and the owner retains control over the “nature and quality” of the services, the unlawful use in commerce doctrine does not apply. *Id.* at 440 n.3. *See also* Section 45 of the Trademark Act, 15 U.S.C. § 1127.

We see no reason why this same principle would not hold true with sister companies so long as the registrant exercises control over the nature and quality of the goods or services on or in connection with which the mark is used. It is uncontroverted that as a commercial bank, Petitioner does not have a license to conduct insurance brokerage services and is legally prohibited from doing so. Instead, the record shows that Petitioner offers insurance brokerage services through dual employees who are legally licensed through its sister affiliate East West Insurance Services. Krause Discovery Deposition (Petitioner’s Ex. 140) at 146:22-147:5; 151:11-155:23, 96 TTABVUE 48-158; Krause Discovery Deposition (Respondent’s Ex. 40) at 57:15-64:17, 90 TTABVUE 26-34; Wang Testimony Deposition at 105:7-109:7 and Ex. 16, 98 TTABVUE 109-113, 318-322. The fact that Petitioner is not licensed to provide insurance brokerage services does not invalidate its registration. This is because Petitioner’s use of its registered mark for “insurance brokerage services” through its properly licensed sister company inures to Petitioner’s benefit. The record reflects that Petitioner exercises control over the nature and quality of the insurance brokerage services provided to its bank customers under the registered mark  EASTWESTBANK. Krause Discovery Deposition (Petitioner’s Ex. 140) at 146:22-147:5, 151:11-155:23; Krause Discovery

Deposition (Respondent's Ex. 40) at 158:1-14, 90 TTABVUE 89; Wang Testimony Deposition at 105:7-109:7 and Ex. 16 (photo of Petitioner's former branch office in San Marino, CA), 98 TTABVUE 109-113, 318-322. Bank customers "can't get to East West Insurance unless [they] walk through East West Bank, so – their offices are within East West Bank." Krause Discovery Deposition (Respondent's Ex. 40) at 58:2-5, 90 TTABVUE 27. When asked whether Petitioner has "any oversight or control over East West Insurance services" and "the quality of services," Petitioner replied that its audit department reviews the insurance services rendered by East West Insurance and provides "support services" such as "financial reporting, IT, HR." Krause Discovery Deposition (Petitioner's Ex. 140) at 157:8-25; 96 TTABVUE 59; Krause Discovery Deposition (Respondent's Ex. 40) at 158:1-14, 90 TTABVUE 89. In addition, Petitioner's marketing department provides support to East West Insurance Services in advertising the registered mark  EASTWESTBANK with the public. In fact, both Petitioner and East West Insurance Services engage in "joint marketing"; for example, East West Insurance Services is listed on and linked to Petitioner's website. Krause Discovery Deposition (Respondent's Ex. 40) at 58:2-5, 90 TTABVUE 27. The record further shows that Petitioner's licensed dual employees act within the scope of their employment with East West Bank, thereby maintaining control over the registered mark and the quality of the services. Krause Discovery Deposition (Respondent's Ex. 40) at 153:7-9, 90 TTABVUE 86. Notably, the President of East West Insurance is also employed by East West Insurance.

Krause Discovery Deposition (Respondent's Ex. 40) at 158:1-3, 90 TTABVue 89.

With regard to the securities brokerage services, Regulation R ("Exceptions for Banks from the Definition of Broker in the Securities Exchange Act of 1934") implements certain of the broker exceptions for banks, including those relating to third-party networking arrangements, from the definition of the term "broker" under Section 3(a)(4) of the Securities Exchange Act of 1934 ("Exchange Act"), as amended by the Gramm-Leach-Bliley Act ("GLBA"). 12 C.F.R. § 218 and 17 C.F.R. § 247. *For further explanation, see* Board of Governors of the Federal Reserve System "Compliance Guide to Small Entities" at www.federalreserve.gov. The networking exception in Section 3(a)(4)(B)(i) of the Exchange Act permits bank employees that are not registered representatives of a broker-dealer to refer customers to a broker-dealer subject to several conditions. For example, one of these conditions generally prohibits a bank employee that refers a customer to a securities broker-dealer from receiving "incentive compensation" for a securities brokerage transaction other than a "nominal" one-time cash fee for making the referral that is not contingent on whether the referral results in a securities transaction. *See id.*

The record fails to establish that Petitioner has engaged in any per se violations of the relevant statutes or corresponding regulations.²⁷ Petitioner

²⁷ Petitioner's parent holding company's report on Form 10-K filed annually with the Securities and Exchange Commission specifically refers to Regulation R and provides the following explanation of Petitioner's activities:

employs dual employees legally licensed by Petitioner's third-party broker-dealer through its division East West Investment Services. East West Investment Services offers products other than the traditional certificate of deposit such as annuities, bond, REITS, and mutual funds to Petitioner's bank customers. Wang Testimony Deposition at 109:10-21, 98 TTABVUE 113. These dual employees provide securities brokerage services at Petitioner's bank branches under Petitioner's operational rules. Krause Discovery Deposition (Respondent's Ex. 40) at 65:8-25; 159:1-161:24, 90 TTABVUE 90-92. And as a division, East West Investment Services, is the same legal entity as Petitioner. Under this arrangement, Petitioner is able to maintain control over its registered mark in the rendering of "securities brokerage services." *See Cent. Fidelity Banks, Inc. v. First Bankers Corp. of Fla.*, 225 USPQ at 440.

In summary, based on this record, we cannot find that Respondent, as plaintiff in its asserted counterclaim, has shown by either "clear and convincing

FRB Regulation R implements exceptions provided in GLBA for securities activities which banks may conduct without registering with the SEC as a securities broker or moving such activities to a broker-dealer affiliate. Regulation R provides exceptions for networking arrangements with third-party broker dealers and authorizes compensation for bank employees who refer and assist retail and high net worth bank customers with their securities, including sweep accounts to money market funds, and with related trust, fiduciary, custodial and safekeeping needs. The current securities activities which the Bank [Petitioner] provides customers are conducted in conformance with these rules and regulations.

Respondent's Notice of Reliance dated December 2, 2014, Ex. 15 ("East-West Bancorp, Inc. 2013 Annual Report on Form 10-K"), 81 TTABVUE 176. Of course, this document constitutes hearsay. In the absence of the appropriate testimony these statements do not qualify for the business records exception and cannot be considered to prove the truth of the matters asserted therein.

evidence,” or for that matter, a preponderance of the evidence, that Petitioner has committed a per se violation of the broker-dealer registration requirements of the Securities and Exchange Act or any of the pertinent regulations arising from the Exchange Act such as Regulation R. For all of the aforementioned reasons, Respondent’s counterclaim of unlawful use in commerce of is dismissed.²⁸

2. Fraud

We turn now to Respondent’s counterclaim that Petitioner fraudulently procured Registration No. 3430148 by making false statements regarding the scope of the services rendered under its registered mark  EASTWEST BANK. Respondent’s fraud counterclaim hinges on Petitioner’s allegedly inconsistent Section 7 request forms²⁹ filed for two different registrations. First, Respondent points to Petitioner’s deletion on November 12, 2010 of “administration of investment trust for others; brokerage services rendered in the fields of shares

²⁸ Another counterclaim against Petitioner’s Registration No. 3430148 is that Petitioner is not truly providing “insurance consultation” services because it merely advises bank customers when they need insurance in connection with securing a loan as opposed to providing expert knowledge to a third party for a fee. Petitioner maintains that contrary to Respondent’s assertion, it does provide “insurance consultation” services for a fee because its dual employees’ time and costs associated with the consultation are recouped when a customer purchases a particular product or service. We find that Respondent has failed to carry its burden of proof as to this counterclaim as well.

²⁹ This refers to the TEAS form entitled “Section 7 Request for Amendment or Correction of Registration Certificate.” Under Section 7(h) of the Trademark Act, 15 U.S.C. § 1057(h), if a mistake in a registration occurs in good faith through the fault of the owner of the registration, the Director may correct the error upon written request and payment of the fee required by 37 C.F.R. § 2.6, provided the correction does not result in a change that would require republication of the mark. See TMEP § 1609.10(b) (“Correction of Owner’s Error”) for further information.

and property” from Registration No. 2025824. Respondent then argues that Petitioner should have also deleted “insurance brokerage; insurance consultation; security brokerage” services from Registration No. 3430148 because it cannot legally render such services, and that its failure to do so “raises a huge red flag as to Petitioner’s intent to deceive the USPTO.” Brief, p. 49. Respondent, citing *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990), further contends that Petitioner continues to perpetuate these “false statements” through the Section 8 declaration of use for Registration No. 3430148 filed during the course of the instant proceeding because the declaration was executed by a paralegal who lacks the requisite knowledge to be a proper signatory. Brief, p. 49.

Fraud in procuring a trademark registration or renewal occurs only when an applicant or registrant knowingly makes a false, material representation with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009) (“Bose”). A party seeking cancellation of a trademark registration for fraudulent procurement or maintenance of a registration bears a heavy burden of proof. *Id.* (citing *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 153 USPQ 749, 750 (CCPA 1967)). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Id.* at 1939 (quoting *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). As emphasized in *Bose*:

Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis. Of course, “because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 88 USPQ2d 1001 (Fed. Cir. 2008).

Id. at 1941. “[A]bsent the requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation.” *Bose*, 91 USPQ2d at 1940 (internal citation omitted).

Respondent’s counterclaim of fraud necessarily fails because the record does not show that Petitioner knowingly made any false statements in connection with the filing of the post-registration documents. As explained above, we did not find that any of these services were unlawfully provided by Petitioner. Even if we were to assume that the services identified in both registrations were the same or legally identical and that some sort of misrepresentation was made, we cannot find, based on the present record, the requisite intent to deceive the USPTO on the part of Petitioner.

In addition, the fact that Petitioner’s trademark paralegal lacks the requisite knowledge to be a proper signatory cannot serve as a basis for finding fraud. Respondent’s reliance on *Spacebase, supra*, is misplaced. That case clarifies the holding of a prior Board decision that “a person can commit fraud upon the Office by willfully failing to correct his or her own misrepresentation, even if originally innocent, as long as that person subsequently learns of the misrepresentation, and knows that the Office has relied upon that

misrepresentation in conferring a substantive benefit upon that person to which the person knows it is not entitled.” *Spacebase*, 17 USPQ2d at 1219. There are no such facts in evidence here. Respondent therefore has failed to carry its burden of showing that the inclusion of “insurance brokerage; insurance consultation; security brokerage” services from Registration No. 3430148 constitutes a fraudulent misrepresentation. Accordingly, Respondent’s fraud counterclaim is dismissed.

VII. Petitioner’s Claims

A. Standing

Standing is a threshold issue that must be proved in every *inter partes* case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. In the case of a cancellation proceeding, the standing requirement has its basis in Section 14 of the Trademark Act which provides in relevant part that “[a]ny person who believes that he is or will be damaged ... by the registration of a mark upon the principal register” may file upon payment of the prescribed fee, a petition to cancel stating the grounds therefor. 15 U.S.C. § 1064. Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that he possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *See Empresa*

Cubana del Tabaco v. General Cigar Co., 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

Respondent challenges Petitioner’s standing to bring the instant cancellation proceeding, arguing that the evidence of record shows that East West Bancorp, Petitioner’s parent holding company, not Petitioner East West Bank, owns Petitioner’s three pleaded registrations. In support thereof, Respondent points to a printout from Petitioner’s website that states, “East West Bank, compass logo, and East West Bank with Compass logo are separately registered trademarks of East West Bancorp in the United States and other countries.” Respondent’s Supplemental Notice of Reliance dated December 2, 2014, Ex. 42. Respondent also relies on the following statement made by Mr. Krause during his discovery deposition: “...East West Bancorp owns East West Bank, so whichever entity is the registered owner, it’s owned by East West Bancorp.” Krause Discovery Deposition (Respondent’s Ex. 40) at 136:11-13, 90 TTABVUE 84. Lastly, Respondent contends that East West Bancorp’s use of the compass logo in its annual reports is suggestive of its ownership.

The printout from Respondent’s website and excerpts from Respondent’s annual reports cannot be used to establish that East West Bancorp is the owner of Petitioner’s pleaded registrations because they each constitute hearsay, and as such, cannot be used to prove the truth of the matter asserted therein unless

a competent witness testifies to the truth of such matters. *See* Fed. R. Evid. 801. In that regard, we read Mr. Krause’s testimony as simply explaining that East West Bancorp, in its capacity as the parent holding company of Petitioner East West Bank, *indirectly* owns all of Petitioner’s assets, including all trademark registrations and that East West Bancorp is the “owner” within the meaning of the Trademark Act.

Petitioner’s standing though can be established through its ownership of its two remaining valid and subsisting registrations for the marks  EASTWESTBANK and **BUSINESS BRIDGE** for the services identified therein, as well as through its position as defendant in the multiple counterclaims brought by Respondent. Not only did Petitioner properly make both remaining registrations of record; the registered mark  EASTWESTBANK is automatically of record by virtue of being the subject of multiple counterclaims. *See Ohio State University v. Ohio University*, 51 USPQ2d at 1293. And even if this were not the case, Ms. Wang, Petitioner’s Senior Vice President and Director of Marketing and Community Development, presented clear and uncontroverted testimony that the marks  EASTWESTBANK and **BUSINESS BRIDGE** were in use in commerce at least as early as July 1996 and May 15, 1997, respectively, in connection with the services identified therein. Petitioner therefore possesses a “real interest” in this proceeding; that is to say, a “direct and personal stake” in the outcome beyond that of a mere intermeddler; and “a reasonable basis for [its] belief of damage.” *Ritchie v. Simpson*, 50 USPQ2d at 1023.

B. Claim of Non-Use

We commence with Petitioner's claim of non-use against Respondent's registered mark **EAST-WEST BUSINESS BRIDGE** for "[p]roviding business information and business consultation to others about requirements for doing business between China and other countries and facilitating the conducting of business transactions between China and other countries." This is because if Petitioner prevails on this claim, Petitioner's claims of abandonment and likelihood of confusion under Section 2(d) are rendered moot.

An application filed under Trademark Act Section 1(a) includes a declaration that the mark is in use at the time of filing; therefore, an applicant filing under this provision is required to have used its mark in commerce prior to the filing of its application. Trademark Act Section 1(a), 15 U.S.C. § 1051(a); Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i). By logical extension, a registration issued from an underlying application not meeting this requirement is void ab initio. *Id. See Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1289 (TTAB 2007) ("...an opposition will be sustained as to any of the identified goods as to which it is shown that no use had been made as of the application filing date."); *Laboratories du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600, 1605-06 (TTAB 1987) (Board sustained opposition on ground that the mark PEYOTE either in the word format or in the design format, had not been used on any goods "either in commerce or anywhere"). *See also Gay Toys, Inc. v. McDonald's Corp.*, 585 F.2d 1067, 199 USPQ 722 (CCPA 1978). The term "use" in this context means "the

bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.” Section 45 of the Trademark Act, 15 U.S.C. § 1127. Under this provision, a mark is deemed to be used in commerce for services when:

[1] it is used or displayed in the sale or advertising of services and [2] the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Id. (numbering added). See *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2044 (Fed. Cir. 2015) (quoting 15 U.S.C. § 1127). To elaborate further on the meaning of “use in commerce” of a service mark:

Although the definition of use of a service mark in Section 45 of the Trademark Act is less concrete than the definition of use of a trademark, it is nonetheless clear that, at the very least, there must be an open and notorious public offering of the services to those for whom the services are intended. (Internal citations omitted). In addition, mere publicity about services to be rendered in the future does not lay a foundation for an application. The statute requires not only the display of the mark in the sale or advertising of services but also the rendition of those services in order to constitute use of the service mark in commerce.

Intermed Communications, Inc. v. Chaney, 197 USPQ 501, 507-08 (TTAB 1977).

“[P]reparations to use a mark in commerce are insufficient to constitute use in commerce. Rather, the mark must be actually used in conjunction with the services described in the application for the mark.” *Aycock*, 90 USPQ2d at 1305.

“Without question, advertising or publicizing a service that the applicant intends to perform in the future will not support registration”; the advertising

must instead “relate to an *existing service* which has already been offered to the public.” *Id.* at 1358 (internal quotation marks and citations omitted) (emphasis added). In other words, “rendering services requires actual provision of services.” *Couture v. Playdom, Inc.*, 113 USPQ2d at 2044 (citing 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:103 (4th ed. Supp. 2013)).

To prevail on its claim of non-use, Petitioner must prove by a preponderance of the evidence that Respondent did not make use of its registered mark prior to September 28, 2007, the filing date of the underlying application.³⁰ Respondent cannot rely on the mere existence of its federal registration and allegations of use therein nor the specimen submitted in connection with *ex parte* examination to defend against Petitioner’s claim of non-use.³¹ If it could do so, a contested cancellation based on non-use could never be successful, despite the fact that such claims are clearly contemplated by statute. *See* Section 45 of the Trademark Act, 15 U.S.C. § 1127. *Cf. Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1395 (Fed. Cir. 1990) (“[T]he Lanham Act was not intended to provide a warehouse for unused marks.”).

Applying these principles, we find that Petitioner has carried its burden of proof. The sole evidence we have showing the actual provision of the identified

³⁰ The relevant time period for a claim of non-use is of course different than the time period for an abandonment claim which begins no earlier than the date of registration.

³¹ Respondent’s specimen of use submitted with its Section 8 declaration on November 12, 2014 falls outside of the relevant time period for analyzing a claim of non-use.

services by Respondent under its registered mark is a single invoice dated October 23, 2013, authenticated by Ms. Plubell, but which falls outside of the relevant time period. Plubell Testimony Deposition (December 2, 2014) at 39:13-42; Ex. 57, 109 TTABVUE 362-365.

In some cases, testimony alone of a single, credible witness is enough to establish use of a mark for the identified services. *See Powermatics, Inc. v. Glebe Roofing Prods. Co.*, 144 USPQ at 432 (oral testimony, even of a single witness, if “sufficiently probative,” may be sufficient to prove priority); *4U Co. of America, Inc. v. Naas Foods, Inc.*, 175 UPSQ at 253. Such is not the case here. Instead, Ms. Plubell’s testimony on the topic of Respondent’s use of its mark prior to September 28, 2007 is evasive and riddled with inconsistencies. *See B.R. Co. v. Lebow Brothers*, 66 USPQ 232, 236 (CCPA 1945) (“When, in cases like the one at bar, the oral testimony of a single witness, testifying long after the events happened, is relied upon to prove priority, such testimony, while entitled to consideration, should be most carefully scrutinized; and if it does not carry conviction of its accuracy and applicability, it should not be permitted to thus successfully attack the presumed validity of a registered trade mark.”). *See also, e.g., Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d 1361 (TTAB 2014). During her discovery deposition taken on March 30, 2012, Ms. Plubell presented the following testimony on the topic of Respondent’s first use in commerce of its registered mark “to a very senior [unnamed] individual,” none of which is corroborated by any written documentation:

Q: When did you start using the words East-West Business Bridge in any capacity related to your consulting?

A: It was to the best of my recollection June 2002.

Q: What use did you make of the words East-West Business Bridge in June 2002?

A: I used them to brand myself.

Q: How did you use them? On what materials did you use them?

A: I used them on my business cards, letterhead, to mark documents, in conversation and discussion when introducing myself in describing the unique services that I provide.

Q: Do you recall which of those uses that you just mentioned that you used first?

A: I don't recall exactly but to the best of my recollection, I would have used it in verbal conversation.

Q: Is there a specific conversation you recall that enables you to identify June 2002 as the first time or date?

A: A specific conversation, no, but I can identify June 2002 as the date.

Q: How is it that you are able to do so?

...

A: The printer's receipt for my business card printing is dated that date and also an article that I wrote for a professional magazine in China related to corporate governance and the role of the independent director that is marked with my card from June 2002, and we did produce that also.

...

Q: Are you able to name a specific engagement or project that you would describe as being the first such engagement or project wherein you used East-West Business Bridge?

A: I am not naming the individual. Are you asking about the nature of the work, the specific engagement?

Q: First, I am just asking if there is one such?

...

A: The initial engagement centered around the specific need of a very senior individual to have a thorough understanding of a highly specialized technical environment at the international level and I was engaged to advise to listen and to talk with him, to help him to prepare for international meetings relative to these matters, to accompany him, to sit behind him...to make sure that he and the positions he represented were clear and the diverse cultural environment with which he was dealing, and that he fully understood the diverse cultural environment and significance of responses to him and the position he was representing.

Q: When did you begin this engagement?

A: This engagement is long standing and I was already engaged in this at least when this filing was our filing in 2003. So it would have been in 2002 but I don't recall exactly when.

...

Q: ...[w]ould you consider your client on that engagement to be the first customer for whom you provided services under the East-West Business Bridge?

A: There were several customers coming around the same time so it is really hard to know and let me explain why I say it that way.

When my identity East-West Business Bridge is in use, it is like making soup and when you are stirring ingredients it is hard to tell what it is and you cannot unstir it, so if I put in coriander, but perhaps that is not a good example, but powdered cinnamon in I can't unstir my powdered cinnamon. I am not trying to be cute here.

Plubell Discovery Deposition at 38-39; 118-121, 91 TTABVUE 9-14.

Although Ms. Plubell had previously stated during her discovery deposition that "[t]he mark East-West Business Bridge is consistently and steadily used" since 2002, she was either unable to recall or unwilling to reveal any specifics regarding client services and receipt of payments at trial. Plubell Testimony

Deposition (October 3, 2014) at 56:12-13; 101 TTABVUE 60. When asked during two separate testimony depositions about Respondent's receipt of payment for services rendered under the mark EAST WEST BUSINESS BRIDGE beginning in 2003, Ms. Plubell was evasive, repeatedly asserting the "standing objection" that "I haven't reviewed any of the business records in preparation for today's examination, so I cannot recall sitting here."³² Plubell Testimony Deposition (October 3, 2014) at 25-37, 100 TTABVUE 29-38; Plubell Testimony Deposition (December 2, 2014) at 254:1-285:5, 109 TTABVUE 563-594. When questioned about receipt of payment for services rendered for each calendar year prior to the filing date of the application/registration, Ms. Plubell repeatedly testified that she was unable to recall specific revenue flows or specific sources of income. Plubell Testimony Deposition (October 3, 2014) at 74:6 (confidential). When asked about the alleged date of first use in the registration of January 4, 2003, she stated that the mark was used "well before that [date] in connection with

³² Indeed, during the entire course of this proceeding, Respondent, through its principal Ms. Plubell, has engaged in a pattern of evasive conduct. At the outset, during the discovery phase, the Board granted Petitioner's motion to compel and ordered Respondent to produce documents showing annual revenues for every calendar year services were rendered under Respondent's registered EAST-WEST BUSINESS BRIDGE mark as well as representative samples of use since 2003. Board Order dated November 13, 2014, 51 TTABVUE 3-4. In response thereto, Respondent stated that it does not generate or keep in the ordinary course of business any documents or reports setting forth Respondent's annual revenues derived from its registered mark. Petitioner's Ex. 33 (Responses to Document Production Request Nos. 47-49). This was confirmed by Ms. Plubell at trial. Plubell Testimony Deposition (October 3, 2014) 202:12-16, 100 TTABVUE 206. So instead of producing invoices or other types of documentary evidence during discovery, Respondent produced heavily redacted federal tax reports filed with the Internal Revenue Service ("IRS") for the years 2002-12. These documents, which have been made of record at trial, are designated highly confidential and for this reason the contents cannot be discussed in this opinion. From what the Board can glean, none of the documents show Respondent's use of its registered mark, either directly or when considered in conjunction with Ms. Plubell's testimony.

the services identified in the trademark registration” but when asked when she was paid for the rendering of such services replied, “I don’t specifically recall dates and times of payment. Clients come and go. And so I can’t recall any specifics.” Plubell Testimony Deposition (October 3, 2014) at 81:3-6 (confidential). When pressed to provide details, Ms. Plubell said:

The use of my trademark East-West Business Bridge has been active and never interrupted and constant. And it has always been my intention to maintain it, as you can tell by my fierce defense of this attempt to force me to relinquish it without even being able to reach adjudication on the merits.

...

So you know that it’s a real, live, and active provision of services and use under the mark East-West Business Bridge, which is me and my identity.

Plubell Testimony Deposition at 84:3-14 (confidential).

If Ms. Plubell’s testimony were corroborated by another witness or written documentation, that would strengthen her credibility. The record, however, shows otherwise. As noted earlier, Respondent is operated solely by Ms. Plubell, and the firm does not retain an accountant. Plubell Testimony Deposition (October 3, 2014) at 202:12-16; 100 TTABVUE 206. Respondent urges us to rely on “word-of-mouth referrals, letterhead, business cards, website, published articles, speeches, presentations, emails and phone calls” as evidence of use of Respondent’s registered mark since 2003. Respondent’s Brief, p. 28. None of this evidence shows use of a service mark in commerce prior to September 28, 2007. Respondent’s display of its mark on letterhead and business cards and the distribution of business cards at speeches, presentations and networking events are merely evidence of marketing and promotional activities instead of

the actual rendering of services. *See* Plubell Testimony Deposition (December 2, 2014), Exs. 55, 56, 59, 66 and 68. Indeed, even Respondent characterizes use of its registered mark on presentations where existing and potential clients are in the audience as “a marketing tool.” Respondent’s Brief, p. 29; 114 TTABVUE 31. The fact that Respondent made available the presentations directly to the audience or to the sponsor is mere dissemination of advertising, not use in commerce as contemplated by the statute. *See* Plubell Testimony Deposition (December 2, 2104) at 125:11-128:12, Ex. 59 (during 2003 presentation to Chinese government officials, Respondent distributed its business card displaying its mark); 140:12-146:17, Ex. 65 (Respondent’s mark appears on the first and last page of a 2006 presentation delivered to a group of business leaders), 109 TTABVUE 435-436, 464-469. By the same token, Respondent’s distribution of articles at conferences and posting articles on its website touting Respondent’s “deep cultural understanding” and ability to “render senior advisory or consulting services related to doing business in China and facilitating business in China” are simply additional kinds of promotional activities. Plubell Testimony Deposition Plubell Testimony Deposition (October 3, 2014) at 167:4-168:10, 109 TTABVUE 490-491. *See, e.g.*, Ex. 72 (October 2002 article in *Caijing Magazine* identifying the Plubell Firm as the “EAST-WEST BUSINESS BRIDGE; June 2002 article in *Caijing Magazine*); 175:14-184:8, 109 TTABVUE 498-507, Exs. 74-76 (Respondent prepared an article for a Chinese delegation which included a copy of Respondent’s business card and biography and was distributed at a meeting with officials from China).

Similarly, Respondent's display of its mark on its website at www.plubellfirm.com since May 27, 2004 serves only as advertising. Plubell Testimony Deposition (December 2, 2014) at 101:10-105:13, Ex. 54, 109 TTABVUE 424-426. The record shows that Respondent does not provide any of its services via Respondent's website and that no revenues have been generated from the site. Petitioner's Ex. 28 (Interrogatory Response No. 26(c)). In addition, Respondent's purchase of the domain name www.plubellfirm.com in June 7, 2002 and subsequent annual renewals do not constitute use in commerce. Plubell Testimony Deposition (December 2, 2014) at 97:22-98:21, 117:1-118:16, Ex. 51, 109 TTABVUE 420-421, 440-441; Respondent's Notice of Reliance Ex. 13. As noted earlier, the fact that the USPTO accepted a print out from Respondent's website as an acceptable specimen of use during *ex parte* examination does not constitute evidence that Respondent's services were actually being provided to clients prior to the filing date of the underlying application.

With regard to the emails, Respondent contends that it began using its registered mark in the signature block of all of the firm's emails at least as early as February 2005. Plubell Testimony Deposition (December 2, 2014) at 205:6-208:1, Ex. 85, 109 TTABVUE 528-531. None of this, however, rises to the level of use in commerce within the meaning of the Trademark Act. Ms. Plubell testified that email is used essentially as another marketing vehicle: "as a way to demonstrate my expertise and present myself and my mark and a way to access and communicate with me." *Id.* at 195:2-15, 109 TTABVUE 518.

The Board has carefully examined each email and Ms. Plubell's corresponding testimony to ascertain whether any show the actual rendering of "[p]roviding business information and business consultation to others about requirements for doing business between China and other countries and facilitating the conducting of business transactions between China and other countries" under the registered mark during the relevant time period. As with much of the other evidence in this record, the emails are designated confidential and heavily redacted; nonetheless, we cannot discern any evidence of use in commerce during the pertinent time period. By way of example, we note that Respondent in its trial brief highlights an email Respondent sent on February 2, 2002 to a native Chinese speaker, requesting an English translation of Respondent's June 29, 2002 article published in *Caijing Magazine* which Respondent intended for use "for marketing purposes and to demonstrates [sic] Respondent's expertise." Respondent's Brief, p. 32; Plubell Testimony Deposition (December 2, 2014) at 196:11-201:16, Exs. 73, 81, and 106; 109 TTABVUE 518-524. This activity is not the same as rendering Respondent's identified services. Ms. Plubell also testified that she sent an email in February 2004 to an existing client providing advice regarding an upcoming presentation; however, the email is undated and does not bear Respondent's registered mark. Ex. 83 to Plubell Testimony Deposition (December 2, 2014) (confidential). Other emails mentioned in Respondent's brief, while bearing Respondent's mark in the signature line, are also undated and so vague that we cannot determine

whether services were actually rendered. *See* Exs. 86 and 88 to Plubell Testimony Deposition (December 2, 2014) (confidential).

Respondent also points to various client engagement agreements it made of record via Ms. Plubell's testimony as showing use of its registered mark. She testified, for example, that C-level executives of various U.S. and Chinese entities retained Respondent to provide consulting services. Plubell Testimony Deposition (December 2, 2012) at 78:2-91:3, Exs. 57, 98-103 (confidential). Respondent's standard engagement agreement, and copies of undated and mostly unsigned written client agreements, do not suffice to show the actual rendering of such services under the mark.³³ Plubell Testimony Deposition (December 2, 2012) at 78:2-91:3, 109 TTABVUE 400-414, Exs. 57, 98-103 (confidential). None of these client agreements include any reference to Respondent's registered mark. *See id.* We hasten to add that Ms. Plubell's testimony as to the engagement agreements was either vague or silent regarding the date Respondent rendered services. *See id.*

In summary, we find that Petitioner has established by a preponderance of evidence that Respondent did not use its mark in commerce within the meaning of Section 45 of the Trademark Act for the services identified in its involved registration prior to September 28, 2007, the filing date of its use-based

³³ In addition, the record shows that the majority of Respondent's client agreements are oral and not memorialized in writing. Petitioner's Exhibit 29 (Response to Interrogatory No. 6).

application. Accordingly, we grant Petitioner's non-use claim. Trademark Act Section 1(a), 15 U.S.C. §1051(a).³⁴

VIII. Affirmative Defense of Unclean Hands

Lastly, we address Respondent's affirmative defense of unclean hands. Respondent argues that because Petitioner fraudulently maintained two out of three of its pleaded registrations, or alternatively, without the required use, it is barred by the doctrine of unclean hands from obtaining judgment on its asserted claim of non-use. Petitioner counters that the defense of unclean hands is a "serious charge" and because Petitioner legitimately maintained its pleaded registrations, it does not apply. Reply Brief, p. 43, 116 TTABVUE 52.

At the outset we note that unlike cases where the ground for cancellation is abandonment, the doctrine of unclean hands is available as a defense to claims of non-use. *Compare American Vitamin Prods. Inc. v. Dow Brands, Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) ("Where the ground for cancellation is abandonment, equitable defenses such as laches, bad faith and unclean hands, are not available in light of the overriding public interest in removing abandoned registrations from the register."), *with Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d at 1290-93 (unclean hands regarding opposer's alleged misuse of the federal registration symbol considered as a defense to non-use

³⁴ In view thereof, we need not reach Petitioner's Section 2(d) and abandonment claims.

claim). *Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209

USPQ 1057, 1065-66 (TTAB 1981) explains the requirements of the defense:

The doctrine of “unclean hands” imposes upon a complainant the burden of showing not only that he has a good and meritorious cause of action, but that he comes into court with clean hands or, as the maxim is stated, “he who comes into equity must come with clean hands.” That is, as stated in *Precision Instrument Manufacturing Company et al. v. Automotive Maintenance Machinery Company*, 65 USPQ 113 (Sup. Ct. 1945), “. . . Any willful act concerning the cause of action which rightfully can be said to transgress equitable standards of conduct is sufficient cause for the invocation of the maxim by the chancellor.”

We have determined that Petitioner did not commit fraud in connection with the filing of maintenance documents for Registration No. 3430148. We do not think that it logically follows that Respondent has proven that Petitioner’s action rises to the level of “unconscionable,” “highly improper” or “inequitable” conduct. *See id.* at 1066. The record does not support such a finding. As a result, we find that the doctrine of unclean hands does not preclude Petitioner from bringing its claim of non-use.

Decision: The petition to cancel Registration No. 3448481 on the claim of non-use is granted; the Section 2(d) and abandonment claims are dismissed as moot.

The counterclaim to cancel Registration No. 2025824 on the ground that the combined Section 8 and 15 declaration filed in 2002 was void is granted; the remaining fraud claims are dismissed as moot. The counterclaims to cancel

Cancellation No. 92053712

Registration No. 3430148 based on unlawful use in commerce and fraud are dismissed.

Respondent's Registration No. 3448481 and Petitioner's Registration No. 2025824 will be cancelled in due course.

APPENDIX A – Petitioner’s Evidentiary Objections

Petitioner has interposed numerous evidentiary objections. To the extent an objection has not been specifically addressed below, we have considered the objected-to evidence, keeping in mind the objection, and have accorded it whatever probative value it merits. *See Alcatraz Media Inc. v. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d at 1756.

A. Petitioner’s Objections to Discovery Deposition Testimony of Emily Wang taken on January 30, 2012 and Exhibit 7 (Appendix A)

Petitioner has moved to strike portions of the January 30, 2012 discovery deposition of Petitioner’s Fed. R. Civ. P. 30(b)(6) witness Emily Wang, Petitioner’s Senior Vice President and Director of Marketing and Community Development, as well as Exhibit 7 thereto regarding the Chinese translation of Petitioner’s home page at www.eastwestbank.com as irrelevant under Fed. R. Evid. 402. Petitioner also asserts lack of foundation as to Ms. Wang’s translation expertise. Petitioner’s Main Brief, Appendix A; 112 TTABVUE 54-55. Insofar as we see no relevance to the claims presently before us of the Chinese translation of Petitioner’s home page, Petitioner’s objection is sustained.

B. Petitioner’s Objections to Trial Witnesses and Exhibits (Appendices B, C and D)

Petitioner has moved to strike portions of the September 22, 2014 testimony of its own witness, Ms. Wang, in response to certain of Respondent’s cross-examination questions on multiple grounds including “argumentative and asked and answered” and “improper as they assume facts not in evidence.”

Petitioner's Main Brief, Appendix B; 112 TTABVUE 54. Petitioner also seeks to strike portions of the October 3, 2014 cross-examination and December 2, 2014 direct examination testimony of Respondent's witness, Ann Marie Plubell, on multiple grounds, such as that the testimony is self-serving, non-responsive or irrelevant. Petitioner's Main Brief, Appendices C & D; 112 TTABVUE 56-59. The Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony at final hearing. *See Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005). *See also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d at 1755. Thus, in accordance with our practice, we have not stricken any of the trial testimony offered by Ms. Wang and Ms. Plubell. Nonetheless, we have considered the probative value of each witness' testimony in light of Petitioner's objections. "Where we have relied on testimony to which respondent objected, it should be apparent to the parties that we have deemed the material both admissible and probative to the extent indicated in the opinion." *Krause*, 76 USPQ2d at 1907.

Petitioner has also asserted numerous objections to portions of the cross-examination testimony of Ms. Plubell taken on October 3, 2014 as well as certain of Respondent's counsel's direct examination questions and narrative testimony taken on December 2, 2014 on various grounds, including lack of foundation and non-responsiveness. As indicated above, because the Board does not ordinarily strike testimony taken in accordance with the applicable

rules on the basis of substantive objections, we have considered Respondent's objections in weighing the probative value of Ms. Plubell's testimony.

In addition, Petitioner has asserted various substantive objections to certain trial exhibits in connection with Ms. Plubell's December 2, 2014 testimony on various grounds, including that some of the exhibits were requested but not produced during discovery. The substantive objections are overruled; that being said, in rendering our decision we have kept in mind the objections, and have accorded the evidence the appropriate probative value. However, to the extent any testimony or evidence is excluded pursuant to the estoppel sanction, it has not been considered.³⁵ And even if such evidence has been or were considered, it would not change the outcome.

C. Petitioner's Objections to Respondent's December 2, 2014 Notice of Reliance and Respondent's Second Supplemental Notice of Reliance dated March 18, 2015 (Appendices E and F)

Petitioner objects to the submission under notice of reliance of Respondent's copy of its People's Republic of China Certificate of Trademark Registration Chinese Reg. No. 9565000 (Ex. 3) and selected discovery responses of another Board proceeding involving the parties, Opposition No. 91215389, *The Plubell*

³⁵ Under the estoppel sanction, a party that fails to provide information during discovery may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, "unless the failure was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1). *See, e.g., Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009) (documents not produced until after the start of trial stricken). *See also* TBMP § 527.01(e) ("Estoppel Sanction") and cases cited therein. Parties have a duty to supplement discovery responses "in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing." Fed. R. Civ. P. 26(e)(1)(A).

Firm, LLC v. East West Bank, (Exs. 43-45) as “irrelevant and inadmissible” under Fed. R. Evid. 402, or alternatively as cumulative under Fed. R. Evid. 403. Petitioner’s Trial Brief, Appendices E & F; 112 TTABVUE 64-65.

The objection to the People’s Republic of China trademark registration is sustained on relevancy grounds. At issue here are U.S. trademark registrations, and no issues regarding translation of foreign wording are before us.

The objection to the submission of the discovery responses from the other Board proceeding involving the parties is sustained due to lack of compliance with the Trademark Rules of Practice and Board procedure. Opposition No. 912153892 was never consolidated with the instant proceeding. Furthermore, there is nothing in the text of Trademark Rule 2.120(j), 37 C.F.R. § 2.120(j), or for that matter any other Trademark Rule, Federal Rule of Civil Procedure or Federal Rule of Evidence that permits a party to introduce discovery responses from another proceeding, even if it involved the same parties, absent a stipulation from the parties or upon motion approved by the Board. For these reasons, and also on relevancy grounds, none of this evidence has been considered.³⁶ We hasten to add that Respondent’s submission unnecessarily added to the volume of an already enormous trial record. *See* TBMP § 702.05 (“Overly Large Records”).

³⁶ None of these materials would have changed the outcome of this case.

APPENDIX B – Summary of the Parties’ Submissions

A. *Petitioner’s Evidence*

1. The testimony deposition of Emily Wang, Director of Marketing and Community Development, Senior Vice President, East West Bank with Exhibits 1-6 and 9-25.
2. The testimony deposition of Ann Marie Plubell, founder and Senior Advisor of The Plubell Firm, LLC with Exhibits 42-56.
3. The testimony deposition of Mary Woo, Legal and Executive Assistant of East West Bank with Exhibits 132-138.
4. Petitioner’s Notice of Reliance (filed October 3, 2014) comprising the following:
 - True and correct copies of printouts from the electronic database records of the USPTO Trademark Status and Document Retrieval (“TSDR”) database, of Petitioner’s pleaded Registration Nos. 2025824, 3430148, and 3633050 showing the current status and title pursuant to Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e) (Exhibit 26);³⁷
 - True and correct copies of printouts from TSDR of third-party registrations (Exhibit 27);
 - Respondent’s Verified Supplemental Responses to Petitioner’s First and Second Set of Interrogatories served on October 3, 2011 (Interrogatory and Response Nos. 1-2, 7-8, 26-27, 31) (Exhibit 28);
 - Respondent’s Verified Second Set of Supplemental Responses to Petitioner’s First and Second Set of Interrogatories served on June 4, 2013 and documents cited therein (Interrogatory and Response Nos. 4(b), 6, 28, and 31) (Exhibit 29);

³⁷ Insofar as Petitioner made its pleaded registrations of record with its petition to cancel under Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), the submission of its pleaded registrations under notice of reliance was unnecessary.

- Respondent's First Set of Supplemental Responses to Petitioner's First and Third Request for Production of Documents and Things served on June 4, 2013 (Request and Response Nos. 50-51) (Exhibit 30);
- Respondent's Third Set of Supplemental Responses to Petitioner's Set of Interrogatories served on December 16, 2013 (Interrogatory and Response No. 4(c) – Response designated in part as Highly Confidential, Trade-Secret/Commercially Sensitive pursuant to the Board's Standard Protective Order) (Exhibit 31);
- Respondent's Second Set of Supplemental Responses to Petitioner's First and Third Request for Production of Documents and Things served on December 16, 2013 (Request and Response Nos. 7 and 46-49) (Exhibit 32);
- Respondent's Amended Second Set of Supplemental Responses to Petitioner's First and Third Request for Production of Documents and Things served on December 20, 2013 (Request and Response Nos. 7, 44 and 46-49) (Exhibit 33);
- Respondent's Initial Disclosures (Exhibit 34); and
- True and correct copies of select excerpts of the Discovery Deposition Transcripts of Ann Marie Plubell taken on March 30, 2012 (day 1) and July 30, 2012 (day 2) and accompanying Exhibits 101, 110 and 112-113 (Exhibit 35).

Pursuant to Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d) and *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) ("*Safer*"), the following documents obtained from the Internet:

- True and correct copies of printouts from the Internet Archive Wayback Machine website of a webpage from the USPTO dated May 9, 2007 in which the requirements for the conveyances of Change of Owner (Assignments) and Change of Owner Name are set forth; and the USPTO Electronic Trademark Assignment System in which various conveyance types are set forth (Exhibit 39);

- True and correct copies of printouts of (1) Petitioner's website regarding background information/corporate profile of Petitioner, location of Petitioner's branches throughout the United States and China, Hong Kong, and Taiwan, and products and services offered under Petitioner's Registered Marks; (2) Wikipedia excerpt regarding general background information on Petitioner; (3) select website traffic information sites regarding monthly estimate of website traffic to Petitioner's website; and (4) various news media reports from the Internet and official press releases accessed from Petitioner's website regarding the reporting of Petitioner's record levels of steadily increasing annual net income since 1998 to 2014 (Exhibit 40); and

- True and correct copies of printouts from (1) the Federal Financial Institutions Examination Council website of the National Information Center ranking of Holding Companies with Assets Greater Than \$10 Billion with Petitioner's parent company ranked at 53 as of June 30, 2014; (2) Forbes website of Forbes' 2014 rankings of America's best banks with Petitioner's parent company ranked in top 10; and (3) Forbes website listing Petitioner's parent company in Forbes Global 2000 rankings (Exhibit 41).

5. Petitioner's Supplemental Notice of Reliance (October 3, 2014) comprising the following:

- Respondent's Verified Second Set of Supplemental Responses to Petitioner's First and Second Set of Interrogatories served on June 4, 2013 and documents cited therein (Documents produced in response to Interrogatory Nos. 4(b), 6, 28, and 31, namely, TPF00357-00359, TPF00406-00414, TPF00469-00471, and TPF01907-01913) (Exhibit 29).

6. Petitioner's Second Supplemental Notice of Reliance (October 6, 2014) comprising the following:

- True and correct copies of select excerpts of the Discovery Deposition Transcript of Ann Marie Plubell taken on July 30, 2012 and accompanying Exhibits 112, 116, and 119) (Exhibit 57).

7. Petitioner's Third Supplemental Notice of Reliance (January 30, 2015) comprising the following:
 - True and correct copies of printouts of online dictionary definitions of the terms "broker," "consultant," "consulting" and "facilitate" (Exhibit 139); and
 - True and correct copies of select excerpts of the Discovery Deposition Transcript of Douglas Krause taken on June 26, 2014 (Vol. 1) provide context to the excerpts already introduced by the submitting party (Exhibit 140).
8. Petitioner's Fourth Supplemental Notice of Reliance (February 2, 2015) comprising the following:
 - True and correct copies of select excerpts of the discovery deposition transcript of Emily Wang taken on January 20, 2012 (Vol. 1) provide context to the excerpts already introduced by the submitting party (Exhibit 141); and
 - True and correct copies of select excerpts of the discovery deposition transcript of Emily Wang taken on March 7, 2012 (Vol. 3) provide context to the excerpts already introduced by the submitting party and accompanying Exhibits 11-12 (Exhibit 142).

C. Respondent' Evidence

1. Respondent testimony deposition of Ann Marie Plubell of The Plubell Firm, LLC dated December 2, 2014, Respondent's Trial Exhibits 50-106 and Petitioner's Exhibits 126-131.
2. Respondent's Notice of Reliance (December 2, 2014) comprising the following:
 - Copies of printouts of various "East West" marks (not limited to Classes 35 and 36) from the Trademark Electronic Search System ("TESS") Registration Nos. 1182880; 1679210; 1733028; 1764085; 2805406; 2845509; 2897234; 3302909; 3649907; 3669254;

3774258; 3871358; 4052900; 4141201; 4174446; 4287626; 4323199; 4529017; and 4532707 (Exhibit 1);

- Copies of printouts of various “Bridge” marks from TESS: Registration Nos. 1825473; 2784833; 3080517; 3350588; 3471766; 3623026; 3992090; 4355456; 4418461; 4453589; 4507842; 4571969; 4583791; and 4598148 (Exhibit 2);

- Copies of various articles represented by Respondent as published in periodicals available to the public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding for the years 2002, 2004, 2008, 2011, and 2014 (Exhibit 4);

- Copies of printouts of various online dictionary definitions of “East,” “West,” “Business,” “Bridge,” “Bank,” “Banking,” “Consultant,” “Consulting,” “Broker,” and “Cash Management” (Exhibit 5);

- Copies of printouts of Respondent’s website as well as printouts from the Internet Archive Wayback Machine capturing printouts of Respondent’s website (Exhibit 6);

- Copy of online printout published by the National Information Center detailing the historical events related to Petitioner’s conversion from a Federal Savings Bank to a State Member Bank (Exhibit 7);

- Copies of printouts of various websites accessed in an October 2011 Google search for “East West” (Exhibit 8);

- Copies of printouts of various websites accessed in October and November 2014 Google searches for “East West” and “Business” (Exhibit 9);

- Copies of select excerpts of an online document published by U.S. Bank Locations, an online bank directory (Exhibit 10);

- Copies of printouts of Petitioner’s website accessed in an October 2014 Internet search (Exhibit 11);

- Copies of printouts of websites of East West Investment Services and East West Insurance Services accessed in an October 2014 Google search (Exhibit 12);
- Copy of the WhoIs record for Respondent's website, www.plubellfirm.com, accessed in an October 2014 Google search (Exhibit 13);
- Copies of select excerpts of East West Bancorp's Annual Reports from 2003-2010 (Exhibit 14);
- Copies of select excerpts of East West Bancorp's 10-Ks from 2003-2013 (Exhibit 15);
- Copies of Petitioner's service mark assignment recordation documents from 1995 and 2000 for U.S. Trademark Registration Nos. 1970770 and 1791861, and Petitioner's change of name recordation document from 2007 for Registration No. 2025824 (Exhibit 16);
- Copies of Petitioner's Trademark Registration Maintenance and Renewal Filings for U.S. Trademark Registration No. 2025824 (Exhibit 17);
- Copy of Petitioner's Trademark Registration Maintenance and Renewal Filing for U.S. Trademark Registration No. 2092030 (Exhibit 18);
- Copy of Petitioner's Response to Post Registration Office Action for Registration No. 2025824 (Exhibit 19);
- Copies of Petitioner's Section 7 Request Forms for Registration Nos. 2025824 and 3430148 (Exhibit 20);
- Copies of select documents from Petitioner's corporate records filed with the Secretary of State of the State of California (Exhibit 21);
- Copies of printouts of the results of the California Secretary of State Business Search for California corporations that contain the term "East West" (Exhibit 22);

- Copies of printouts of the results of the California Secretary of State Business Search for California LLCs that contain the term “East West” (Exhibit 23);
- Petitioner’s Supplemental Responses and Objections to Respondent’s First Set of Interrogatories dated October 3, 2011 (Interrogatory and Response Nos. 32-35) (Exhibit 24);
- Petitioner’s Responses and Objections to Respondent’s Revised Second Set of Interrogatories Nos. 1-15 dated August 2, 2012 (Interrogatory and Response Nos. 13 and 15) (Exhibit 25);
- Petitioner’s Supplemental Responses and Objections to Respondent’s First Set of Interrogatories dated June 4, 2013 (Interrogatory and Response No.17) (Exhibit 26);
- Petitioner’s Supplemental Responses and Objections to Respondent’s Revised Second Set of Interrogatories dated June 4, 2013 (Interrogatory and Response No. 4) (Exhibit 27);
- Petitioner’s Consolidated Supplemental Discovery Responses Pursuant to Order Dated November 14, 2013: Petitioner’s Supplemental Responses to Respondent’s Revised Second Set of Interrogatories dated December 16, 2013 (Interrogatory and Response No. 8) (Exhibit 28);
- Petitioner’s Supplemental Responses and Objections to Respondent’s First Set of Requests for Admissions dated October 3, 2011 (Request and Response No. 94) (Exhibit 29);
- Petitioner’s Supplemental Responses and Objections to Respondent’s Second Set of Requests for Admissions dated October 3, 2011 (Request and Response Nos. 36-37) (Exhibit 30);
- Petitioner’s Responses and Objections to Requests for Production of Documents and Things, Set One dated July 25, 2011 (Request and Response Nos. 60-61) (Exhibit 31);

- Petitioner's Objections and Rejections to Respondent's Second Set of Requests for Production of Documents and Things dated September 6, 2011 (Request and Response Nos. 22-23) (Exhibit 32);
 - Petitioner's Supplemental Responses and Objections to Respondent's First Set of Requests for Production of Documents and Things dated October 3, 2011 (Request and Response Nos. 56-57) (Exhibit 33);
 - Petitioner's Supplemental Responses and Objections to Respondent's First Set of Requests for Production of Documents and Things dated June 4, 2013 (Request and Response Nos. 40 and 51-52) (Exhibit 34);
 - Petitioner's Consolidated Supplemental Discovery Responses Pursuant to Order Dated November 14, 2013: Petitioner's Supplemental Responses to Respondent's First Set of Requests for Production of Documents and Things dated December 16, 2013 (Request and Response Nos. 41-42, 49-50, and 55) (Exhibit 35);
 - Petitioner's Consolidated Supplemental Discovery Responses Pursuant to Order Dated November 14, 2013: Petitioner's Supplemental Responses to Respondent's Second Set of Requests for Production of Documents and Things dated December 16, 2013 (Request and Response No. 25) (Exhibit 36); and
 - Respondent's Third Set of Supplemental Responses to Petitioner's Set of Interrogatories dated December 16, 2013 (Interrogatory and Response No. 4(b)) (Exhibit 37).
3. Respondent's Supplemental Notice of Reliance (December 2, 2014) comprising the following:
- True and correct copies of select excerpts of the Discovery Deposition Transcripts of Emily Wang taken on January 30, 2012 (Vol. 1) and accompanying Exhibits 1 and 6 (Exhibit 38);
 - Excerpts of the discovery deposition transcripts of Emily Wang taken on March 7, 2012 (Vol. 3) and accompanying Exhibits 16, 16a, 17, 17a-d, 18-21 and 30 (Exhibit 39);

- Excerpts of the discovery deposition transcript of Douglas Krause taken on June 26, and accompanying Exhibits H and L (Exhibit 40); and

- Excerpts of the discovery deposition transcript of Ann Marie Plubell taken on March 30, 2012 (Vol. 1) (Exhibit 41).

4. Respondent's Second Supplemental Notice of Reliance (March 18, 2015) comprising the following:

- Excerpts of the discovery deposition Transcript of Douglas Krause taken on June 26, 2014 (Vol. 1) and accompanying Exhibits C-F, I and K (Exhibit 42).