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

Proceeding	91199231
Party	Defendant Sho Tay
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Attachments	Chinese_Daily_News,_Inc._v._Tay,_et_al.-_Defendants'_Answer_to_Plaintiff's_Complaint.pdf (17 pages)(525420 bytes)

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

WESTERN DIVISION

CHINESE DAILY NEWS, INC., a California corporation, Plaintiff, vs. SHOLIN TAY, an individual; SHO TAY, an individual; JING YANG, an individual; and DOES 1 to 10, inclusive, Defendants.	CASE NO. CV10-10079 PA (JEMx) **DEFENDANTS SHO TAY, SHOLIN TAY AND JING YANG'S ANSWER TO PLAINTIFF CHINESE DAILY NEWS, INC.'S COMPLAINT**

Defendants Sho Tay, Sholin Tay and Jing Yang ("Defendants") hereby answer the Complaint of Plaintiff Chinese Daily News, Inc. ("Chinese Daily News" or "Plaintiff") as follows:

PARTIES

1. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 1 of the Complaint, and on that basis deny them.

2. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 2 of the Complaint, and on that basis deny them.

3. In response to paragraph 3 of the Complaint, Defendants admit the allegations contained therein.

4. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 4 of the Complaint, and on that basis, deny them.

5. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 5 of the Complaint, and on that basis deny them.

6. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 6 of the Complaint, and on that basis deny them.

7. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 7 of the Complaint, and on that basis deny them.

8. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 8 of the Complaint, and on that basis deny them.

9. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 9 of the Complaint, and on that basis deny them.

10. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 10 of the Complaint, and on that basis deny them.

11. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 11 of the Complaint, and on that basis deny them.

12. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 12 of the Complaint, and on that basis deny them.

JURISDICTION AND VENUE

13. In response to paragraph 13 of the Complaint, Defendants do not contest this Court has subject matter jurisdiction pursuant to 15 U.S.C. sections 1125(a) and (c). Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 13 of the Complaint.

14. In response to paragraph 14 of the Complaint, Defendants do not contest this Court has subject matter jurisdiction pursuant to 28 U.S.C. sections 1331 and 1338. Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 14 of the Complaint.

15. In response to paragraph 15 of the Complaint, Defendants do not contest that venue is properly laid in this Judicial District pursuant to 28 U.S.C. sections 1391(b) and (c). Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 15 of the Complaint.

BACKGROUND FACTS

16. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 16 of the Complaint, and on that basis deny them.

17. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 17 of the Complaint, and on that basis deny them.

18. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 18 of the Complaint, and on that basis deny them.

19. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 19 of the Complaint, and on that basis deny them.

20. Defendants lack sufficient information or other belief upon which to admit the allegations set forth in paragraph 20 of the Complaint, and on that basis deny them.

21. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 21 of the Complaint, and on that basis deny them.

22. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 22 of the Complaint, and on that basis deny them.

23. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 23 of the Complaint, and on that basis deny them.

DEFENDANTS' UNLAWFUL ACTIVITIES

24. In response to paragraph 24 of the Complaint, Defendants admit that Defendants are engaged in an online website with the domain address "ChineseDailyNews.com" which provides online publication of news and current events and internet news portal featuring links to news stories and articles in the field of current events. Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 24 of the Complaint.

25. In response to paragraph 25 of the Complaint, Defendants admit that ChineseDailyNews.com website does contain a mark which consists of a globe design, with letters "WN" in blue imprinted within, and Chinese characters in red

next to it, and then the letters "ChineseDailyNews.com" in navy blue placed below. The "WN" appearing the mark signifies world news in the relevant trade or industry, and the transliteration of the Chinese characters in the mark is "mei quo zhi jie sheen woon ghan". The English translation of the Chinese characters is "America world news web". Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 25 of the Complaint.

26. In response to paragraph 26, Defendants admit that Defendants are engaged in an online website with the domain address "ChineseDailyNews.com" which provides online publication of news and current events and internet news portal featuring links to news stories and articles in the field of current events. A trademark application has been submitted to the United States Patent and Trademark Office for the registration of the mark "ChineseDailyNews.com". Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 26 of the Complaint.

27. Defendants deny the allegations set forth in paragraph 27 of the Complaint.

28. Defendants deny the allegations set forth in paragraph 28 of the Complaint.

29. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 29 of the Complaint, and on that basis deny them.

30. Defendants deny the allegations set forth in paragraph 30 of the Complaint.

CDN'S BUSINESS & COPYRIGHTS

31. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 31 of the Complaint, and on that basis deny them.

32. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 32 of the Complaint, and on that basis deny them.

33. Defendants lack sufficient information and other belief upon which to admit the allegations set forth in paragraph 33 of the Complaint, and on that basis deny them.

DEFENDANTS' INFRINGING ACTIVITIES

34. Defendants deny the allegations set forth in paragraph 34 of the Complaint.

35. Defendants deny the allegations set forth in paragraph 35 of the Complaint.

36. Defendants deny the allegations set forth in paragraph 36 of the Complaint.

37. Defendants admit that Plaintiff sent a cease and desist letter dated November 17, 2009. Except as expressly admitted or qualified, Defendants deny each and every allegation contained in paragraph 37 of the Complaint.

38. Defendants deny the allegations set forth in paragraph 38 of the Complaint.

39. Defendants deny the allegations set forth in paragraph 39 of the Complaint.

40. Defendants deny the allegations set forth in paragraph 40 of the Complaint.

41. Defendants deny the allegations set forth in paragraph 41 of the Complaint.

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FIRST CAUSE OF ACTION

FALSE DESIGNATION OF ORIGIN UNDER LANHAM ACT §43(A)

(Against All Defendants and DOES 1-10)

42. Responsive to paragraph 42, Defendants hereby incorporate by reference paragraphs 1-41 the same as if fully set forth. Unless an allegation has been expressly admitted, Defendants deny it.

43. Defendants deny the allegations set forth in paragraph 43 of the Complaint.

44. Defendants deny the allegations set forth in paragraph 44 of the Complaint.

45. Defendants deny the allegations set forth in paragraph 45 of the Complaint.

46. Defendants deny the allegations set forth in paragraph 46 of the Complaint.

SECOND CAUSE OF ACTION

TRADEMARK DILUTION UNDER LANHAM ACT § 43(A)

(Against All Defendants and DOES 1 to 10)

47. Responsive to paragraph 47, Defendants hereby incorporate by reference paragraphs 1-46 the same as if fully set forth. Unless an allegation has been expressly admitted, Defendants deny it.

48. Defendants deny the allegations set forth in paragraph 48 of the Complaint.

49. Defendants deny the allegations set forth in paragraph 49 of the Complaint.

50. Defendants deny the allegations set forth in paragraph 50 of the Complaint.

51. Defendants deny the allegations set forth in paragraph 51 of the Complaint.

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT

(Against All Defendants and Does 1 to 10)

52. Responsive to paragraph 52, Defendants hereby incorporate by reference paragraphs 1-51 the same as if fully set forth. Unless an allegation has been expressly admitted, Defendants deny it.

53. Defendants deny the allegations set forth in paragraph 53 of the Complaint.

54. Defendants deny the allegations set forth in paragraph 54 of the Complaint.

55. Defendants deny the allegations set forth in paragraph 55 of the Complaint.

56. Defendants deny the allegations set forth in paragraph 56 of the Complaint.

57. Defendants deny the allegations set forth in paragraph 57 of the Complaint.

58. Defendants deny the allegations set forth in paragraph 58 of the Complaint.

59. Defendants deny the allegations set forth in paragraph 59 of the Complaint.

60. Defendants deny the allegations set forth in paragraph 60 of the Complaint.

61. Defendants deny the allegations set forth in paragraph 61 of the Complaint.

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FOURTH CAUSE OF ACTION

UNFAIR COMPETITION

(Against All Defendants and Does 1 to 10)

62. Responsive to paragraph 62, Defendants hereby incorporate by reference paragraphs 1-61 the same as if fully set forth. Unless an allegation has been expressly admitted, Defendants deny it.

63. Defendants deny the allegations set forth in paragraph 63 of the Complaint.

FIFTH CAUSE OF ACTION

WRONGFUL TRADE NAME USE AND INJURY TO BUSINESS REPUTATION

(Against All Defendants and Does 1 to 10)

64. Responsive to paragraph 64, Defendants hereby incorporate by reference paragraphs 1-63 the same as if fully set forth. Unless an allegation has been expressly admitted, Defendants deny it.

65. Defendants deny the allegations set forth in paragraph 65 of the Complaint.

66. Defendants deny the allegations set forth in paragraph 66 of the Complaint.

SIXTH CAUSE OF ACTION

INJURY TO BUSINESS REPUTATION AND TRADEMARK DILUTION

(Against All Defendants and Does 1 to 10)

67. Responsive to paragraph 67, Defendants hereby incorporate by reference paragraphs 1-66 the same as if fully set forth. Unless an allegation has been expressly admitted, Defendants deny it.

68. Defendants deny the allegations set forth in paragraph 68 of the Complaint.

69. Defendants deny the allegations set forth in paragraph 69 of the Complaint.

70. Defendants deny the allegations set forth in paragraph 70 of the Complaint.

71. Defendants deny the allegations set forth in paragraph 71 of the Complaint.

72. Defendants deny the allegations set forth in paragraph 72 of the Complaint.

73. Defendants deny the allegations set forth in paragraph 73 of the Complaint.

PRAYER FOR RELIEF AND DAMAGES

INJUNCTIVE RELIEF

74. Responsive to paragraph 1 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 1 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

75. Responsive to paragraph 2 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 2 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

76. Responsive to paragraph 3 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 3 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

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DAMAGES

77. Responsive to paragraph 4 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 4 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

78. Responsive to paragraph 5 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 5 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

79. Responsive to paragraph 6 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 6 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

80. Responsive to paragraph 7 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 7 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

81. Responsive to paragraph 8 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 8 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

82. Responsive to paragraph 9 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect

to this paragraph. To the extent this Court finds paragraph 9 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

83. Responsive to paragraph 10 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 10 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

84. Responsive to paragraph 11 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 11 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

85. Responsive to paragraph 12 of the Prayer for Relief and Damages, no material allegations are contained therein, thus no answer is required with respect to this paragraph. To the extent this Court finds paragraph 12 contains allegations requiring a response, Defendants deny each and every allegation contained therein.

AFFIRMATIVE DEFENSES

As separate and affirmative defenses to the allegations of the Complaint, Defendants allege as follows:

FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim)

86. The Complaint fails to state facts sufficient to constitute a cause of action or to state a claim upon which relief can be granted against Defendants.

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SECOND AFFIRMATIVE DEFENSE

(Lawful Exercise)

87. Defendants' conduct constituted lawful exercise of their legal rights, which does not violate the trademark laws, unfair competition laws, or any other law.

THIRD AFFIRMATIVE DEFENSE

(Unclean Hands/Wrongful Conduct)

88. The causes of actions are barred by the doctrine of unclean hands and the Plaintiff's wrongful conduct.

FOURTH AFFIRMATIVE DEFENSE

(No Fault of Defendants)

89. Plaintiff has not suffered injury to its business or property by reason of any conduct by Defendants that violates applicable laws or other legal duty.

FIFTH AFFIRMATIVE DEFENSE

(Plaintiff's Fault)

90. Plaintiff's injuries and damages, if any, were caused, in whole or in part, by its own conduct and not the conduct of Defendants.

SIXTH AFFIRMATIVE DEFENSE

(Necessary/Indispensable Parties)

91. Plaintiff has failed to serve process on the other named Defendants in this action and those Defendants are necessary/indispensable parties to this action.

SEVENTH AFFIRMATIVE DEFENSE

(Noninfringement)

92. Defendants have not directly infringed, indirectly infringed, contributed to or induced infringement of any valid and enforceable claim of Plaintiff's mark "Chinese Daily News", the logo and the Chinese characters "Shi

Ja Sin Wen Wan", and have not otherwise committed any acts in violation of 15 U.S.C. §1125.

EIGHTH AFFIRMATIVE DEFENSE

(No immediate or Irreparable Injury)

93. Plaintiff is not entitled to injunctive relief because any alleged injury to Plaintiff is not immediate or irreparable, and Plaintiff would have an adequate remedy at law.

NINTH AFFIRMATIVE DEFENSE

(No Willful Infringement)

94. Should Defendants be found to infringe Plaintiff's mark "Chinese Daily News", the logo and the Chinese characters "Shi Ja Sin Wen Wan", such infringement was not willful.

TENTH AFFIRMATIVE DEFENSE

(Limitation of Damages)

95. To the extent Plaintiff may be entitled to damages, any claim for damages for trademark infringement by Plaintiff is limited to those damages occurring only after notice of infringement.

ELEVENTH AFFIRMATIVE DEFENSE

(Waiver)

96. The causes of action are barred by the doctrine of waiver.

TWELFTH AFFIRMATIVE DEFENSE

(Estoppel)

97. The causes of action are barred by the doctrine of estoppel.

THIRTEENTH AFFIRMATIVE DEFENSE

(Statute of Limitations)

98. The Complaint is barred, in whole or in part, by the applicable Statutes of Limitations.

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FOURTEENTH AFFIRMATIVE DEFENSE

(Other Factors Causing Alleged Damage)

99. Factors other than Defendants' purported wrongful conduct caused some or all of Plaintiff's alleged damages.

FIFTHTEENTH AFFIRMATIVE DEFENSE

(Laches)

100. The Complaint is barred by doctrine of laches.

SIXTEENTH AFFIRMATIVE DEFENSE

(Failure to Mitigate Damages)

101. Plaintiff has suffered no damages and/or has failed to mitigate its damages, if any.

SEVENTEENTH AFFIRMATIVE DEFENSE

(No Injury to Plaintiff)

102. Plaintiff has suffered no injury, nor is there any likelihood of injury.

EIGHTEENTH AFFIRMATIVE DEFENSE

(Defendants Acting in Reasonable Manner)

103. Defendants have acted in a commercially reasonable and lawful manner.

NINETEENTH AFFIRMATIVE DEFENSE

(Standing)

104. Plaintiff lacks standing to assert the claims for relief in the Complaint.

TWENTIETH AFFIRMATIVE DEFENSE

(Fault of Others)

105. The Complaint fails, in whole or in part, because any and all damages allegedly suffered by Plaintiff were directly and proximately caused and contributed to by the breach, conduct, acts, omissions, activities, carelessness,

recklessness, negligence, intentional misconduct, supervening or intervening acts, and/or omissions of Plaintiff or persons or entities other than Defendants.

TWENTY-FIRST AFFIRMATIVE DEFENSE

(Consent)

106. The Complaint is barred in whole or in part by the doctrine of consent.

TWENTY-SECOND AFFIRMATIVE DEFENSE

(Preemption)

107. The Complaint is barred in whole or in part by the doctrine of preemption.

TWENTY-THIRD AFFIRMATIVE DEFENSE

(Trademark Misuse)

108. The Complaint is barred in whole or in part by the doctrine of trademark misuse.

TWENTY-FOURTH AFFIRMATIVE DEFENSE

(Antitrust)

109. The Complaint is barred in whole or in part because Plaintiff using its mark to violate U.S. and California antitrust laws, including Section 1 of the Sherman Act, 15 U.S.C. § 1.

TWENTY-FIFTH AFFIRMATIVE DEFENSE

(Privilege of Competition)

110. The Complaint is barred in whole or in part by the privilege of competition.

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TWENTY-SIXTH AFFIRMATIVE DEFENSE

(Right to Assert Additional Affirmative Defenses)

111. Defendants presently have insufficient knowledge or information on which to form a belief as to whether they have additional, as yet unstated,

affirmative defenses available. Defendants reserve the right to assert additional affirmative defenses in the event discovery indicates that they would be appropriate.

PRAYER FOR RELIEF

WHEREFORE, Defendants pray for the following relief:

A. That Plaintiff's Complaint be dismissed with prejudice and that its request for damages and other relief be denied in full;

B. That Defendants be awarded their attorneys' fees, costs and expenses in this action, pursuant applicable law; and

C. That Defendants be awarded such further relief as this Court may deem fair and just.

DATED: April 19, 2011

CHIAO & WU, LLP

By:_____

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