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

Proceeding	92056759
Party	Defendant Yangpu NGT Industrial Co., Ltd.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE VANTONE GROUP, LLC)	
)	
Petitioner,)	Cancellation No. 92056759
)	
v.)	Registration No. 4,230,555
)	Registration No. 4,234,787
)	
)	
YANGPU NGT INDUSTRIAL CO., LTD,)	
Respondent.)	

**REGISTRANT’S ANSWER AND AFFIRMATIVE DEFENSES TO PETITIONER’S
PETITION FOR CANCELLATION**

COMES NOW, Respondent, Yangpu NGT Industrial Co., Ltd. (“Respondent” or “Yangpu”), and for its Answer and Affirmative Defenses to Petitioner’s Petition for Cancellation, states as follows:

I. ANSWER TO INTRODUCTORY PARAGRAPHS

Respondent admits that it owns Registration Nos. 4,230,555 and 4,234,787 which registrations speak for themselves, including the classes and descriptions of services. Respondent admits that it does business at No. 236 Zhonghang Building Yangpu Guanghua Co. Hainan China, and further states that it also does business internationally and in the United States. Respondent denies Petitioner’s translation and transliterations the marks seen in Registration Nos. 4,230,555 and 4,234,787 (Respondent’s “Chinese Character Marks”) and further states, without waiving any available rights, remedies or defenses, that the Chinese

Character Marks are not similar in sight, sound, or meaning to VANTONE in English. The remainder of Petitioner's introductory paragraphs, to the extent they are allegations, are denied.

II. ANSWER TO ALLEGATIONS

1. **Paragraph 1:** "Since long prior to December 31, 2010, Respondent's effective date of first use based on the filing date of its earlier filed application which matured into Registration No. 4230555, Petitioner has offered for sale in commerce within the United States various real estate and finance related services including, but not limited to, the following:

IC 036 - Real Estate Brokerage, Financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others

which are offered by or originate with Petitioner under it's THE VANTONE GROUP mark and name."

ANSWER: Denied.

2. **Paragraph 2:** "Since long prior to December 31, 2010, Respondent's effective date of first use based on the filing date of its earlier filed application which matured into Registration No. 4230555, Petitioner has used and continues to use the mark THE VANTONE GROUP in commerce in the United States in connection with such services. As a consequence, the public has attributed and continues to attribute to Petitioner, and Petitioner has used and continues to use the THE VANTONE GROUP mark and name in connection with the various services listed in classes 36."

ANSWER: Denied.

3. **Paragraph 3:** "By reason of such use in commerce, Petitioner is the owner at common law of the THE VANTONE GROUP mark."

ANSWER: Denied.

4. **Paragraph 4:** “Petitioner’s rights in THE VANTONE GROUP mark have been recognized by the United States Patent and Trademark Office, which has issued the following two federal registrations to Petitioner.

Mark	Reg. No.	Services
THE VANTONE GROUP	3856724	IC 036: Real Estate Brokerage
THE VANTONE GROUP	4238285	IC 036: Financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others”

ANSWER: Respondent admits that Petitioner is the “Registrant” of US Registration Nos. 3,856,724 and 4,238,285 but otherwise denies the allegations in Paragraph 4.

5. **Paragraph 5:** “A copy of the registration certificate for Petitioner’s two registrations are attached hereto as Exhibit A and B respectively. Petitioner’s registrations are valid and subsisting. These registrations provides prima facie evidence of Petitioner’s ownership of the THE VANTONE GROUP mark, of the validity of the mark, and of Petitioner’s exclusive right to use the mark in commerce.”

RESPONSE: Respondent admits that copies of Registration Nos. 3,856,724 and 4,238,285 are attached as Exhibits A and B to the Petition, but otherwise denies the allegations in Paragraph 5.

6. **Paragraph 6:** “Petitioner recognizing that the largest group of foreign investors in the U.S. real estate market are Chinese nationals, used and continues to use a Chinese character mark and name in connection with the various services listed in class 36 (hereinafter “Petitioner’s Chinese Character Mark”). Attached hereto as Exhibits C and D are images of the

Chinese and English language pages of Petitioner’s website wherein the two versions of THE VANTONE GROUP mark is displayed. This same mark is the subject of the following pending U.S. Trademark Application filed by Petitioner:

Mark	Serial No.:	Services
万通集团	85618998	IC 036: Real Estate Brokerage

RESPONSE: Respondent admits that Petitioner has filed Application Serial No. 85/618,998, but otherwise denies the allegations in Paragraph 6.

7. **Paragraph 7:** “Petitioner, upon information and belief, claims that the non-Latin characters in Petitioner’s Chinese Character Mark transliterate to “WAN TONG Jí Tuán” (emphasis added) and this means Ten Thousand Group in English. Petitioner further asserts upon information and belief that the English translation of the Chinese characters in Petitioner’s Chinese Character Mark is THE VANTONE GROUP.”

ANSWER: Denied.

8. **Paragraph 8:** “The services of the Respondent as described in its two registrations, are closely related, and in some instances identical, to the services offered and sold by Petitioner as described in paragraph 1 herein. Many of the services offered and sold by Petitioner under it’s THE VANTONE GROUP mark and name are likely to be purchased and consumed by the same class of purchasers who are likely to purchase and consume Respondent’s services, namely Chinese nationals and Chinese immigrants to the U.S. who seek real estate and

finance related services. In addition, many of the services of Petitioner and Respondent are marketed through similar and related channels of trade. The first two Chinese characters in Respondent's marks are visually identical the first two Chinese characters that comprise Petitioner's Chinese character mark as shown

below:

Respondent's Chinese Character Marks:

Registration No. 4230555

万通地产

Registration No. 4234787

万通

Petitioner's Chinese Character Mark:

Serial No.: 85618998"

万通集团

ANSWER: Denied.

9. **Paragraph 9:** "Petitioner alleges, based on information and belief, that Chinese is a common, major, modern language read and spoken by hundreds of thousands of persons in the U.S. and billions of people around the world."

ANSWER: Respondent is without knowledge sufficient to form a belief as to the truth of the allegations contained in paragraph 9, and therefore denies these allegations.

10. **Paragraph 10:** “Petitioner further claims, based on information and belief, that in the Chinese language:

- i. there is no letter “V” and the “V” sound is most closely pronounced by native Chinese speakers as the “W” sound.
- ii. in the syllable “ong”, the letter “G” is almost silent.
- iii. the word “the” does not occur in the Chinese language.

The key portions of both Petitioner’s and Respondent’s Chinese character marks, thus, are pronounced as **WAN TON** by native Chinese speakers or **VANTONE** by native English speakers.”

ANSWER: Denied.

11. **Paragraph 11:** “On information and belief, Respondent has made no use of its alleged Chinese character marks in the United States for the services identified in U.S.

Registration Nos. 4230555 and 4234787, prior to December 31, 2010, Respondent’s effective date of first use based on the filing date of its earlier filed application which matured into Registration No. 4230555, which is a date subsequent to the date on which the Petitioner first used it’s THE VANTONE GROUP mark and name in commerce within the United States.”

ANSWER: Denied.

12. **Paragraph 12:** “On information and belief, Respondent has made no use of its alleged Chinese character marks in the United States for any goods or services, prior to December 31, 2010, Respondent’s effective date of first use based on the filing date of its earlier

filed application which matured into Registration No. 4230555, which is a date subsequent to the date on which the Petitioner first used it's THE VANTONE GROUP mark and name in commerce within the United States.”

ANSWER: Denied.

13. **Paragraph 13:** “Petitioner, over a period of some years, has expended much time, effort and money in advertising and in otherwise promoting the sale of its services, and in encouraging its customers to recognize its services under THE VANTONE GROUP mark and name, wherefore the registrations of the Respondent enables Respondent to reap the benefits of such goodwill and reputation attached to Petitioner’s mark, all to Petitioner’s irreparable damage and injury as a result of the confusion which is likely to arise.”

ANSWER: Denied.

14. **Paragraph 14:** “Since long prior to December 31, 2010, Respondent’s effective date of first use based on the filing date of its earlier filed application which matured into Registration No. 4230555, Petitioner has used and continues to use THE VANTONE GROUP mark and name, and Petitioner has continuously and in good faith used THE VANTONE GROUP mark and name as described in paragraphs 1 through 3 hereof. As a consequence of the use of THE VANTONE GROUP mark and name, Petitioner’s THE VANTONE GROUP mark and name has become distinctive in the minds of the trade and business community of the quality of the services offered by Petitioner.”

ANSWER: Denied.

15. **Paragraph 15:** “Respondent’s Chinese Character Marks so closely resemble Petitioner’s THE VANTONE GROUP mark and name and Petitioner’s Chinese Character Mark in sight, sound, connotation, and commercial impression that consumers are likely to be confused as to an affiliation or association between Respondent’s Chinese Character Marks and Petitioner’s THE VANTONE GROUP mark and name and Petitioner’s Chinese Character Mark.”

ANSWER: Denied.

16. **Paragraph 16:** “Respondent’s use and registration of Respondent’s Chinese Character Marks is likely to cause confusion or to deceive consumers in the mistaken belief that the services of Respondent emanate from, or are disseminated under Petitioner’s approval, sponsorship, or control, creating an adverse commercial impact due to the use of similar marks by Respondent all to the detriment of Petitioner, who is the prior user and lawful owner of THE VANTONE GROUP mark and name. Attached hereto As Exhibit E is the declaration of Mei Wang, a New York Real Estate Agent attesting to the likelihood of confusion between Respondent’s Chinese Character Marks and Petitioner’s THE VANTONE GROUP mark and name and Petitioner’s Chinese Character Marks for real estate and financial services.”

ANSWER: Denied.

17. [THIS SPACE INTENTIONALLY LEFT BLANK, PETITION DID NOT CONTAIN A PARAGRAPH 17]

18. **Paragraph 18:** “Unless Respondent’s registrations are cancelled, Petitioner will suffer irreparable harm especially since it will not be able to promote its services to Chinese

nationals and immigrants using the Chinese characters into which THE VANTONE GROUP mark and name are transliterated.”

RESPONSE: Denied.

AFFIRMATIVE DEFENSES

1. **First Affirmative Defense:** Petitioner’s Petition fails to state a claim upon which relief may be granted.

2. **Second Affirmative Defense:** Petitioner lacks standing to petition for cancellation.

3. **Third Affirmative Defense:** Petitioner’s claims are barred by the doctrine unclean hands.

a. On information and belief, Petitioner has made false and misleading statements to the United States Patent and Trademark Office and others regarding the use, history, and ownership of its alleged THE VANTONE GROUP marks, including without limitation Registration Nos. 3,856,724 and 4,238,285, and Application Ser. No. Application Serial No. 85/618,998 (Chinese character mark) (collectively, “THE VANTONE GROUP marks”).

b. Additionally, Petitioner’s actions constitute unfair competition because Petitioner filed trademark applications for and claims to have made use of marks in classes of services that has and will cause a likelihood of confusion with Registrant’s marks, with knowledge of Registrant’s exclusive rights and priority in the marks.

4. **Fourth Affirmative Defense:** Petitioner’s claims are barred by the doctrines of laches and acquiescence.

5. **Fifth Affirmative Defense:** Respondent's Registration Nos. 4,230,555 and 4,234,787 (Respondent's "Chinese Character Marks") are not the same as Petitioners THE VANTONE GROUP marks (Registration Nos. 3,856724 and 4,238,285 and Application Ser. No. 85/618,998). Without waiving any available claims, rights, or defenses, Respondent further states that the Chinese Character Marks are not similar in sight, sound, or meaning to VANTONE in English.

6. **Sixth Affirmative Defense:** Respondent has priority of use for its Chinese Character marks, based both on actual use in the United States and the famous foreign mark or well-known mark doctrine.

7. **Seventh Affirmative Defense:** Respondent has abandoned its THE VANTONE GROUP Marks, Registration Nos. 3,856724 and 4,238,285 and Application Serial No. 85/618,998.

WHEREFORE, Registrant denies Petitioner claims and that is entitled to any relief whatsoever and respectfully prays that the Petition be dismissed, with costs and attorney's fees to be adjudged against Petitioner, and for such other relief allowed to the Registrant as the Trademark Trial and Appeal Board may deem just and proper.

Please address all correspondence to Tamara Carmichael, LOEB & LOEB LLP,
345 Park Avenue, New York, New York, 10154.

Date: May 17, 2013

Respectfully Submitted,

LOEB & LOEB LLP

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CERTIFICATE OF SERVICE

I, Noreen Gosselin, hereby certify that a copy of the foregoing REGISTRANT'S ANSWER AND AFFIRMATIVE DEFENSES TO PETITIONER'S PETITION FOR CANCELLATION AND COUNTERCLAIMS, has been served upon:

THOMAS TD FOSTER
TD FOSTER INTELLECTUAL PROPERTY LAW
11622 EL CAMINO REAL, SUITE 100
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Via first class mail, postage prepaid on May 17, 2013

/s/ Noreen Gosselin