

**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

**Response to Amended Petition for Cancellation
by Diamond Hong, Inc & H & C Trading Co. Inc**

Opposition No. 92062714 - 85327448

**Cai, Zheng, d/b/a Tai Chi Green Tea Inc.
Registrant of Reg. No. 4,114,136**

V.

**Diamond Hong, Inc & H & C Trading Co. Inc.
Petitioner**

Dear Examination Attorneys and Trademark Trial and Appeal Board,

We deny all the allegations that the petitioner made against our trade mark "Wu Dang Tai Chi Green Tea" in this Amended Petition filed on June 4, 2016. All the petitioner's allegations against our registered mark are completely groundless and senseless.

General Statement

On November 20, 2015, the petitioner filed a petition to cancel our registered mark "Wu Dang Tai Chi Green Tea", alleged that: 1. our mark will cause confusion with their marks; 2. we deceived the trademark office to get our mark registered; 3. we employed fraud to get our mark registered.

On January 4, 2016 we filed a response rebuked all the petitioner's allegations against us and showed evidence to prove that all the petitioner's allegations against our trademark are completely groundless.

On January 12, 2016, the petitioner filed a motion for default judgement, claiming that our response is "non-responsive answer to petitioner's Petition, and Registrant's own admissions, the petitioner will be harmed by the continuous existence of the registration of registrant's mark." The petitioner seems to believe that others cannot read and he knows trademark law better than anyone else. Obviously, attorneys at Trademark Trial and Appeal Board know trademark law better. His motion is denied.



On May 11, 2016, we had a conference. The Interlocutory Attorney pointed out that “Opposer has sufficiently alleged its standing and a claim for priority and likelihood of confusion”, but “the facts of this case do not appear to present a claim for deceptiveness” and “Petitioner also has not adequately pleaded a claim of fraud”. Thus “petitioner is allowed until June 6, 2016 to file an amended complaint that includes an adequately pleaded claim of fraud.” Petitioner’s attorney agreed to discuss that amendment with his client.

On June 4, 2016, instead of filing “an amended complaint that includes an adequately pleaded claim of fraud”, the petitioner filed an “Amended Petition for Cancellation”, in which he just repeated some of the claims he already made in the original petition.

We noticed that in this “Amended Petition” the petitioner dropped two far more serious allegations against us and repeated some points he made in the original petition, claiming **that our wording and design are identical to theirs, the nature of our products is “identical” to theirs** (“the identical wording and design of registrant’s mark to petitioner’s marks and the identical nature of the tea good offered under the marks” in the petitioner’s words), thus will **“definitely result in consumer confusion”** .

In this “Amendment”, just as in the original petition (filed on Nov 20, 2015) and in the motion demanding default judgement (filed January 12, 2016), the petitioner distorts the facts at leisure to make his arguments. Since we had already rebuked all of his senseless allegations in our response filed on January 4th, 2016, in the following, we will only simply respond to the relevant points the petitioner made against us. For detailed answers, please refer to our response filed on January 4th, 2016.

In the following, we will explain how our mark and the petitioner’s marks are so strikingly different and why none would possibly confuse the marks. We will first **make a few points**, then process to illustrate the unmistakable difference between our **goods, wording, design, and general impression and the petitioner’s, then come to our conclusion.**

1. A Few Points:

A. The Petitioner’s Products or Trademark are not that “famous”.

In several occasions, the petitioner claims that their mark and products have “extensive reputation” and sounds like that his products and mark are known to quite a few people. The fact is that till now, probably nobody knows his products or trademarks except a few tiny herbal stores in some Chinatowns. It was even more so when we started use our mark in commerce in 2005. To claim that his mark and products have “extensive reputation” is just enjoying his Freedom of Speech.

B. Our mark has been used in commerce since 2005.

Though “Wu Dang Tai Chi Green Tea” (Reg. No. 4114136) as one mark was first used in commerce in June, 2010, the dominant part of our mark  (Reg. No. 3958,979) was first used in commerce no later than July 2005 (*See Exhibit 1.*). We used this mark in commerce far earlier than the petitioners’ filing date of the mark Reg. No. 3,966,518 (Filed on Aug. 21, 2008).

Thus the goods green tea under our mark have priority of use in commerce over the petitioner’s mark Reg. No. 3,966,518 except that the petitioner can prove otherwise.

C. We will only compare the petitioner’s first mark (Reg. No. 2,449,580) with our mark in the following illustrations.

The petitioner has two registered marks. The second mark (Reg. No. 3,966,518) is identical to the first one (Reg. No. 2,449,580) except that two Chinese characters are added to it, which makes the mark Reg. No. 3,966,518 further different from ours, thus in the comparison of the marks, we only compare the petitioner’s first mark (Reg. No. 2,449,580) with our mark.

D. The discrepancy of the Petitioner’s claimed goods of “tea” under his marks.

The petitioner has two registered marks: Reg. No. 2,449,580, and Reg. No. 3,966,518.

Under the mark Reg. No. 2,449,580, the claimed Goods are “ **Herbal Tea; herbal Food Beverages** In class 30 (U.S. CL. 46). **First use 10-8-1999; in commerce 10-8-1999.**” The petitioner renewed this mark on July 14, 2010.

The Mark Reg. No. 3,966,518 is identical to Reg. 2,449,580 except two Chinese character are added. The claimed goods related to “tea” is: “**Processed Herbs; Processed Gingseng Used as an Herb; Herbal Food Beverages; Royal Jelly For Food Purpose; and Tea**, In class 30 (U. S. CL. 46). **First Use 10-8-1999; in Commerce 10-8-1999**”.

Compare the goods and the “First Use” date of the petitioner’s two marks, we notice that the petitioner’s products could only be “Herbal Tea; herbal Food Beverages” as claimed in the Mark Reg. No. 2,449,580. Otherwise, if the petitioner tries to stretch its claim outside of the products of “herbal teas, herbal food beverage,” it is a fraud.

What’s more, the second trademark of the petitioner’s (Reg. No. 3,966,518.) was filed on August 21, 2008, which was three years later after we used our mark  (*See Exhibit I*) in commerce for selling green tea. Thus we have priority of use of the goods green tea in commerce under our mark over the petitioner even the petitioner do sell green tea after August 21, 2008 except the petitioner can prove otherwise.

Therefore, in the following when we compare the goods of ours and the petitioner's, we will only take the petitioner's "tea goods" as "**herbal teas, herbal food beverage**" as claimed under the mark Reg. No. 2,449,580.

2. Goods

- A. In the final statement, the petitioner says our products will cause confusion with theirs due to "the identical nature of the tea goods offered under the marks".

Nobody knows what the petitioner's "identical nature" means. Does the petitioner mean that both of our products are in "a line of health care goods"? If he means this, he is wrong. Our product is green tea. Green tea is food. It is against the law for any green tea seller to claim green tea as "health product". FDA prohibits that. We cannot claim any health benefits of green tea on the package, just like an onion seller cannot claim any health benefits of onions. The petitioner's herbal teas may be categorized as "health products", our product green tea cannot.

- B. To make the point that our product will cause confusion with theirs, the petitioner keeps using a vague term "tea products", "tea goods" to describe their goods and our goods. In fact, their "tea goods", "tea products" are "herbal teas" and ours is green tea. In the market, no one can sell a products simply labeled as "tea products" or "tea goods". FDA does not allow any ambiguity here. It is either herbal teas or green tea (black tea, wolong tea) and herbal teas must be clearly labeled as what herb it is, otherwise it cannot be put in the market.

Herbal teas are not **Generally Recognized Safe (GRAS)**, because herbal teas can be extremely dangerous and in some cases can be fatal if misused. No sellers of herbal teas are allowed to confuse herbal teas with green tea or tea (woolong tea, black tea, white tea). **It is illegal to disguise herbal teas as green tea. Green tea (tea) is considered generally recognized as safe (GRAS), thus it is categorized as food in the US. Since it is food, in many states (like in Michigan state) where food is free of sales tax, green tea is free of sales tax, and all across the United States, customers can buy green tea with food stamps, but herbal teas were categorized as "supplement" or even drugs, there is a sales tax on it and you cannot buy it with food stamps across the US.**

Our "tea products" is green tea, a totally different product from the petitioner's "herbal teas" and the law prohibits anyone to confuse herbal teas with green tea. Therefore to claim that our "tea goods" green tea has "identical nature" as the petitioner's "tea goods" herbal teas ("due to ... the identical nature of the tea goods offered under the marks") is misleading.

For the unmistakable difference between green tea and herbal teas, please refer to #3 of our response filed on January 4, 2016.

3. The Design

The petitioner claims in his final statement (#7) in the Amended Petition that our design is identical to his (“Due to the **identical** wording and **design of Registrant’s mark to Petitioner’s marks**”). This is a senseless allegation.

We adopted Tai Chi Graph , which represents “extreme ultimate” “extremely superior” and means the absolute harmony of Yin and Yang (negative and positive), and changed the black part of it to be green to symbolize our product green tea, and the white part symbolizes water. The whole design means “the Top Green Tea helps keeping the balance of the body”.

Our mark is so uniquely designed to incorporating Tai Chi Graph and our goods green tea into one. Our design so sharply distinguishes itself from any marks ever registered, including the petitioner’s.

Does a picture of a man stepping on a disfigured Tai Chi graph practicing Tai Chi Chuan in black and white is identical to a full Tai Chi graph in green and white? Anyone with a normal eyesight and in his right mind will know the answer is an absolutely “No.”

We do not need to say anymore. Please see the designs side by side:



If the petitioner believes that our design is “identical” to his design and will “definitely result in consumer confusion”, the petitioner should file another petition to cancel our

design. This design  was used in commerce since 2005 and it is a registered mark of ours, Reg. No. is 3958,979.

4. Wording

A. Wordings “Wu Dang ”

To support his arguments, the petitioner claims “the words Wu Dang meaning a form of martial arts ”. This claim is ridiculously out of sense.

Anyone in China know that Wu Dang refers to Wu Dang Mountain, which is located in Hubei province, where our tea is selected. Wu Dang Mountain is a world heritage site. It is famous for its Taoism temple and beautiful scenery. Though Wu Dang Mountain, just like other big mountains in China, has its own martial arts style (Just like different areas have different styles of cuisines), which is called “Wu Dang Chuan” (Wu Dang Boxing or Wu Dang Fist). While Tai Chi could be the abbreviation of Tai Chi Chuan, probably because Tai Chi Chuan simply means “the extremely superior boxing”; however, Wu Dang Chuan, probably because it is closely associated with Wu Dang Mountain, does not have such a similar abbreviation as Tai Chi Chuan has. Wu Dang always refer to Wu Dang Mountain, just like Beijing refers to Beijing City, the capital of China, or Chinese government, not “a kind of Roasted Duck”, though Beijing Roasted Duck (北京烤鸭) is associated with Beijing. To say “the words Wu Dang meaning a form of martial arts” is just like saying “Beijing meaning a kind of roasted duck”.

The words “Wu Dang” is a registered trademark of ours.

For the Meaning of Wu Dang and our registration of Wu Dang, please refer to the Response we filed on January 4th, 2016.

- B. In the final statement the petitioner claims that our wording is identical to his (“Due to the **identical wording and design of Registrant’s mark to Petitioner’s marks**”). This is another senseless allegation.

First of all, “Tai Chi” is such a broadly used word in Chinese language. It is not a word created or invented by the petitioner. And “Tai Chi” is an adjective in the first place and simply means “the supreme ultimate”, “the very top”, “the extremely superior”, “very top”, “incomparable” and etc. It could also be the abbreviation of Tai Chi Chuan, a form of martial arts. (Regarding the definition of Tai Chi, please refer to the #4 of our response filed on Jan 4th, 2016).

Even though there is wording “Tai Chi” in our mark and in the petitioner’s mark, the wording “Tai Chi” in our mark has a total different meaning from the “Tai Chi” in the petitioner’s marks. In the petitioner’s marks, wording “Tai Chi”, combined with the designs of a man practicing Tai Chi Chuan, means “Tai Chi Chuan”, a form of physical exercise. In our mark, it is placed in front of a noun “green tea”, it is descriptive, and simply means “the top”.

Claiming that our wordings are identical to his, does the petitioner mean that “Wu Dang” is identical to “Tai Chi”? If so he believes, he should file another petition to cancel our mark “Wu Dang” (Reg. No. 3,921,201). Or does the petitioner mean “Tai Chi” is identical to “Wu Dang Tai Chi Green Tea”?

Is “Tai Chi” identical “Wu Dang Tai Chi Green Tea”? Anyone in his right mind would know the answer is an absolutely NO.

5. General impression

- A. Anyone with normal eyesight could tell the striking difference between our mark and the petitioner's.



Notice that, since our product is green tea, green color is essential to our mark.

- B. The petitioner claims that **“the dominant and conspicuous portion and feature of both of the marks are a Yin-Yang Symbol and Tai Chi wording.”** This claim blatantly distorts the facts.

First of all, we should know that Tai Chi Graph (taiji tu), or the so-called yin-yang symbol is the logo of Taoism religion and it has been created for hundreds of years. It is not the petitioner's invention or creation. Tai Chi Graph is a full circle like this



. It is not an oval shape like something appeared in the petitioner's design



. The petitioner only partially adopted the Tai Chi Graph into the background of his design.

Anyone with normal eyesight would tell that the dominant and conspicuous portion

and feature of our mark is the Tai Chi Graph in green and white , there is a man practicing Tai Chi Chuan, the oval shaped, the partially blocked Yin-Yang graph is just a background. The dominant wordings in petitioner's marks are “Tai Chi” and in ours are “Wu Dang”, which has bigger font than other wordings and takes the central position.

The petitioner's mark impresses upon viewers in the following order:

1. A man practicing Tai Chi Chuan, an exercise with slow movement;
2. Wording “Tai Chi”;
3. An oval shaped, partially blocked Tai Chi Graph in the background.

The petitioner's mark impresses people with one man practicing Tai Chi Chuan. The petitioner has stated that “Tai Chi” only means “Tai Chi Chuan” in the petition filed

on No 20, 2015 and its design and wording successfully conveys that meaning. The oval shaped, partially blocked Yin-Yang graph is just a background.

Our mark impresses upon viewers in the following order:

1. First and most striking is our logo .
2. Secondly, people will notice the wording "Wu Dang", **which has bigger font than other wordings and takes the central position.**
3. Thirdly, people will notice "Tai Chi Green Tea" on the top of the Tai Chi Graph, which means "the top green tea".

Our mark is so uniquely designed to incorporating Tai Chi Graph and our goods green tea into one. Our mark carries a clear message totally different from the petitioner's. Anyone with a glance at our trademark will be deeply impressed and know what goods we are providing: the best green tea from Wu Dang mountainous areas.

Our mark with the design so sharply distinguishes itself from any marks ever registered, including the petitioner's.

Giving the unmistakable different impression of our mark and the petitioner's marks upon customers, even both of us carry exactly the same products with our marks on, that is, we sell ginseng tea and the petitioner sell green tea, and put our products side by side, none could possibly confuse the two! In this wild world, besides the petitioner pretends to be confused about our mark and theirs, none with a normal eyesight will possibly be confused with them!

Conclusion

As illustrated above, our mark is so sharply, strikingly and unmistakably different from the petitioner's marks in terms of general impression, wording, design and goods, there is no any confusion could possibly exist between our mark and the petitioner's. The petitioner's allegations that "identical wording and design of Registrant's mark to Petitioner's marks, and the identical nature of the tea goods offered under the marks" will "result in consumer confusion", just like his other allegations against us for deception and fraud in the original petition, are completely groundless and senseless. We believe the Trial and Appeal Board will make a swift decision to deny his petition.

Respectfully submitted

By _____
Zheng Cai



6/15/16



Owner of Wu Dang Tai Chi Green Tea, Reg. NO. 4,114,136.

352 S Barnswallow Lane, Vernon Hills, IL 60061

Tel: 847-387-9327

Email: zanecai@yahoo.com

Exhibit:

Exhibit 1. Our Design  was in Use in Commerce since 2005.

Note:

A Hard Copy of this response will be sent to USPTO and the Petitioner via US Post Service while an electronic version of the response will be filed via USPTO's webpage.

Certificate of Service

I hereby certify that a copy of the foregoing RESPONSE TO AMENDED PETITION FOR CANCELLATION was served on:

Kenneth Cang Li
Law Offices of Kenneth Cang Li
1745 Broadway, 17th Floor,
New York, NY 10019 United States

By placing same with the U. S. Postal Service, Via first class mail, postage pre-paid, this 15th Day of June, 2016

Certificate of Electronic Service

It is hereby certified that the foregoing RESPONSE TO AMENDED PETITION FOR CANCELLATION was served electronically at <http://estta.uspto.gov> on this 15th day of June, 2016

By _____

Name: Zheng Cai

6/15/16

Exhibit A



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太极绿茶

Word Mark TAI CHI GREEN TEA**Translations** The non-Latin characters in the mark transliterate to "Tai Chee Lyu Cha.". The foreign wording in the mark translates into English as **Tai Chi Green Tea**.**Goods and Services** (ABANDONED) IC 030. US 046. G & S: (Based on Intent to Use) Woolong tea, Black tea ; beverages made of Woolong tea and Black tea; (Based on Use in Commerce) Green tea, beverage made of green tea. FIRST USE: 20050718. FIRST USE IN COMMERCE: 20050718**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS**Design** 24.17.18 - Yin-Yang symbol**Search Code** 28.01.03 - Asian characters; Chinese characters; Japanese characters**Serial Number** 78821249**Filing Date** February 23, 2006**Current Basis** 1A;1B**Original Filing Basis** 1A;1B**Owner** (APPLICANT) Zheng Cai INDIVIDUAL CHINA 352 Barn Swallow Vernon Hills ILLINOIS 60061**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GREEN TEA "or the non-Latin characters that mean "GREEN TEA" APART FROM THE MARK AS SHOWN**Description of Mark** The colors green and white are claimed as a feature of the mark. The mark consists of an image adopted from the Tai Chi graph, Taijitu, but the black part of the Tai Chi Graph is changed to green. The image looks like two drops of water, one is up and one is down, and there are two tiny dots in each part of the two sides. The color green appears on the right side of the Tai Chi graph and the color white appears on the left side of the graph. The tiny dot on the left side of the graph is at the top of that portion of the graph and it is in green. The tiny dot on the right side of the graph is at the bottom of that portion of the graph and it is in white. Surrounding the top portion of the circle formed by the Tai Chi graph are the words "Tai Chi Green Tea" in green and at the bottom of the circle are the words Tai Chi Green Tea in green again, but this time the words are written using Chinese characters.

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator DEAD

Abandonment Date December 16, 2008

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