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

Proceeding	91238706
Party	Plaintiff Xiang Yin He Chang Tuan Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Attachments	180408 - SECCOND AMENDED NOTICE OF OPPOSITION.pdf(47245 bytes )

IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Opposition No. 91238706  
Application Serial Nos. 87566170 and 87538374

Xiang Yin He Chang Tuan Inc.  
Opposer

Vs.

Edison Chinese Chorus Inc.  
Applicant

SECOND AMENDED NOTICE OF OPPOSITION

Comes now the Opposer, Xiang Yin He Chang Tuan Inc. (“Xiang Yin”), by counsel, H. Danny Kao, filing this second amended notice of opposition, with the grounds for this opposition as follows:

Introduction

1. The Opposer filed two oppositions dated January 3, 2018 for two published trademark applications, 87566170 (‘170) and 87538374 (‘374) (collectively, the “marks”).

2. The Opposer’s original opposition and resulting motion to dismiss raised such significant origination and ownership issues that the Opposer then engaged new counsel to investigate. That investigation resulted in the identification of the creator and first user of the marks, Ms. Tan, and a discovery of the correct facts relating to these issues, therefore creating new and bona fide grounds of opposition, that are stated below.

### Standing

3. Opposer, who uses the marks in interstate commerce to designate its Chinese choral group, has now been assigned the marks by Ms. Tan, who created and owned them. Opposer would be damaged by the registrations of the marks because they cause confusion, mistake and deception within the choral group listening public and within the group of potential singers who wish to join a choral group. Opposer uses the marks with rights to do so while Applicant uses the marks without permission and in the same area but in a different Chinese choral group, causing confusion, mistake and with deception.

4. The founders of a choral group split from the group and took their marks, the marks in issue, with them. The marks had been created by a founder's wife, Ms. Tan, who permitted the founders to use them in their original group and then the new group. The group that they left still exists and is the Applicant. The Applicant was aware of these facts yet it attempted to take the marks and confuse and deceive the public as to the origin of its chorus group, willfully submitting false ownership and false first use assertions to the USPTO to obtain the registrations. This is an amended opposition seeking in effect to return the marks to their rightful owner and place them where she intends.

### First Claim Priority Of Use

5. Ms. Tan, who created the marks, used the marks in interstate commerce with the chorus in February of 2002 (e.g., in New Jersey and New York) before Applicant alleges it used them as its first use on October 2004.

### Second Claim

Likely To Cause Confusion, Mistake Or To Deceive  
Trademark Act § 2(d). 15 U.S.C. § 1052(d)

6. Ms. Tan, who created the marks, permitted them to be used with a different Chinese chorus group that had split with the Applicant's chorus group under contentious conditions. Both groups using the same marks in, for example, the same areas of New Jersey and New York, to designate Chinese choral groups, will obviously cause confusion and mistake with the listening public and new singers seeking to join a choral group. Applicant, who is aware of these facts from the history of the group is knowingly causing confusion, mistake and deception.

Third Claim

Applicant Is Not And Was Not The Owner

7. Ms. Tan, who created the marks, owned the marks and never transferred them to Applicant. Ms. Tan has applied for her own trademarks (Serial Numbers: 87811480 and 87811521).

Fourth Claim

Applicant Is Misrepresenting The Source Of The Group

8. Ms. Tan, who created the marks, permitted them to be used with a different Chinese chorus group that had split with the Applicant's chorus group under contentious conditions. Applicant's knowledge of the history of the marks establishes its intentional misrepresentation of the source of the chorus group.

Fifth Claim

Applicant Committed Fraud In The Procurement Of Its Registrations

9. The Applicant knew (Applicant was "there" as an entity at the time) that Ms. Tan created and owned the marks and that Applicant could not truthfully claim ownership or any rights in the marks. The Applicant knew that Ms. Tan used

the marks first and that Applicant could not claim a first use. The Applicant was reminded of these material and false facts that it had submitted with the original applications in the original opposition but it failed to correct the record, thereby obtaining and maintaining the registration by knowingly submitting this false and highly material information to successfully procure the registrations with a willful intent to deceive. If Applicant's intent only can be inferred before the original opposition, once Applicant did nothing to correct the record after the originally opposition was filed by the group rightfully using the marks, and Applicant's motion to dismiss was filed, actual evidence of intent should be found.

Relief Requested

WHEREFORE, For the foregoing reasons, the registrations sought by Applicants are contrary to the provisions of the Trademark Act, and Opposer believes that it would be damaged thereby and therefore Opposer respectfully requests that the registrations of the marks shown above be refused and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

By: /s/ H. Danny Kao  
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Attorney for the Opposer  
Dated: April 8, 2018

Certificate of Service

I hereby certify that a true and complete copy of the foregoing SECOND AMENDED NOTICE OF OPPOSITION has been served on Cheng Q. Song, Counsel for the Opposer, by forwarding said copy on April 8, 2018, visa email to chengqsong@gmail.com.

Signature: /s/H. Danny Kao

Date: April 8, 2018