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

Proceeding	91238706
Party	Defendant Edison Chinese Chorus Inc. AKA Xiang Yin Chorus or Xiang Yin He Chang Tu-an
Correspondence Address	CHENG Q SONG SONG LAW FIRM 1 WINDY HILL ROAD GREEN BROOK, NJ 08812 UNITED STATES chengqsong@gmail.com, chengqsong@yahoo.com 219-928-6191
Submission	Motion for Summary Judgment Yes , the Filer previously made its initial disclosures pursuant to Trademark Rule 2.120(a); OR the motion for summary judgment is based on claim or issue preclusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: 01/25/2020
Filer's Name	Cheng Q. Song
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Signature	/s/Cheng Q. Song
Date	06/26/2019
Attachments	Motion for Summary Judgment June 2019.pdf(147072 bytes) Exhibit 1 Motion for Summary Judgment.pdf(61209 bytes) Exhibit 2 Motion for Summary Judgment.pdf(89781 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

MOTION FOR SUMMARY JUDGMENT OF APPLICANT

Comes now the Applicant, Edison Chinese Chorus Inc., by counsel, Cheng Q. Song, and hereby submits the following memorandum of law in support of its Motion for Summary Judgment pursuant to Fed.R. Civ. P. 27 Rule 56.

SUMMARY JUDGMENT STANDARD OF REVIEW

Pursuant to Rule 56(c) of the Federal Rules of Civil Procedure, motion for summary judgment "shall be rendered forthwith if the pleadings, deposition, answers to interrogatories and admissions on file, together with affidavits, if any, show that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law." See, Fed R. Civ. P. 56(c); *Barwick v. Celotex Corp.*, 736 F.2d 946 (4th Cir.); *Celotex v. Catrett*, 477 U.S. 317, 322-24(1986). To prevail on a motion for summary judgment, the moving party has the burden of showing the absence of any genuine issues as to all the material facts, which under the applicable principles of substantive law, entitle him/her to judgment as a matter of law. *Lewis v. Coleman*, 257 F. Supp. 38 (S.D. W. Va. 1966). A genuine issue of material fact exists if the evidence is such that a responsible jury could return a verdict for the non-moving party. *Sayer v. General Nutrition Corp.*, 867 F. Supp. 431 (S.D. W. Va. 1994), Affirmed, 67 F.3d 296 (4th Cir. 1995).

STATEMENT OF FACTS

Opposer first alleges that he registered the identical trade/service mark and logo with the State of New Jersey on July 12, 2017, days before the Applicant filed the applications with the USPTO and later alleges that the trademarks under opposition was created in 2001 by Ms. Tan, "influential" wife of a former member of Applicant and a current member of Opposer, who now assigns the right of use to Opposer.

Applicant served its Initial Disclosure and First Set of Discovery Requests to Opposer on May 6, 2019 but it was not timely responded. The response to the First Set of Discovery Requests was served on June 10, 2019 (Exhibits 1 and 2). Therefore, STATEMENT OF FACTS, is divided under the following two situations:

1. Facts--- if the response to the Request for Admissions is considered as admitted;
2. Facts--- even if the response to the Request for Admissions is considered as timely.

Situation 1. FACTS--- if the response to the Request for Admission is considered as admitted

Applicant, Edison Chinese Chorus Inc., was founded on Feb. 3, 2001 and incorporated with the State of New Jersey on April 1, 2002. Its bylaws were approved by the membership on October 20, 2001. There is no dispute that the user of the trademarks is Applicant, Edison Chinese Chorus, in all the advertisement and program brochures of concerts from about 2002 to about 2017 when the principals of Opposer were a music director or a member of Applicant. There is no dispute that Opposer was incorporated in the State of New Jersey in 2017 after they were split from Applicant.

TBMP has stated that “If no response is timely served to a request for admission, the matter is automatically deemed admitted, and no motion is necessary (TBMP 524.01, Note 4). In the Request for Admissions, Opposer admitted that Ms. Tan never used the trademark from 2001 to 2017 (Request No. 2) and was never an owner, an officer or a member of Applicant and therefore, she has no control over Applicant (Request No. 3). The use of the trademarks by Applicant received no license request from anyone at any times (Request No. 6). It is further admitted that Applicant is the only user of the trademark from 2001 to 2017 (Request No. 7).

Situation 2. FACTS--- even if the response to the Request for Admission is considered timely

Applicant, Edison Chinese Chorus Inc., was founded on Feb. 3, 2001 and incorporated with the State of New Jersey on April 1, 2002. Its bylaws were approved by the membership on October 20, 2001. There is no dispute that the user of the trademarks is Applicant, Edison Chinese Chorus, in all the advertisement and program brochures of concerts from about 2002 to about 2017 when the principals of Opposer were a music director or a member of Applicant. There is no dispute that Opposer was incorporated in the State of New Jersey in 2017 after they were split from Applicant.

If the responses to the discovery requests had been served timely Opposer’s claimed fact would have been that Ms. Tan was the one who proposed the Chinese name which was selected for use by Applicant and therefore later became the subject trademarks in this proceeding (in many parts of their oppositions and replies). Opposer admitted that Ms. Tan was “never an owner, an officer or a member of Applicant” (Reply No. 3 to Requests for Admissions) but she is “the influential wife...” (Reply No. 8 to Interrogatories to Opposer) and through her influence on her husband, Mr. Wen, she was able to exercise her control over the trademarks and therefore, she is the creator, adopter, and owner of the trademarks (in many parts of their oppositions and replies). They further admitted that Mr. Wen was the President of Applicant from 2009 to 2011 only (Reply to Request for Admission No. 12).

ARGUMENT

A trademark, according to Black's Law Dictionary definition, "is a device, word or combination of words, or symbol that indicates the source or ownership of a product or service." A common law trademark can be acquired by using the device, word or combination of words or symbol in commerce.

Under the Situation 1, Applicant, Edison Chinese Chorus Inc., is not only the user of the trademarks but also under no claims from anyone from about 2002 to about 2017. Therefore, it is obvious that Applicant is the owner of the trademark.

Under the Situation 2, Opposer claimed that the Chinese name which later became the trademarks under this opposition was the brainchild of Ms. Tan. Opposer admitted that Ms. Tan was "never an owner, an officer or a member of Applicant". They admitted that the user of the trademark was Applicant from about 2002 to about 2017 but "Any use of the Trademark by Applicant was by license and otherwise grant of rights to use by Ms. Tan, who controlled the use in part at all times through Mr. Wen until the time in 2017". (Reply to the First Set of Interrogatories to Opposer). Mr. Wen, her husband, who was a member of Applicant from about 2001 to about 2017 and was its President from about 2009 to about 2011.

There is no doubt that Ms. Tan's husband, Mr. Wen, had no control over Applicant either since he had only one vote and Applicant had over about 20 to about 100 votes at various stages of its history. When Mr. Wen was President of Applicant from about 2009 to about 2011 he still had only one vote in the decision making process since the highest decision making mechanism is the membership meeting. In the United States the trademark rights are acquired by using a mark; proposing a name which eventually becomes a trademark (or as called by Opposer "creation of a trademark") does not create priority rights. See *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1774 (Fed. Cir. 1987). Therefore, Applicant, who is the only user of the trademarks, is the owner of such trademarks even if there were some type of "secret" agreements or licenses between the husband and wife regarding the use of the trademarks. At the most such "secret" agreements or licenses will make Mr. Wen owe a favor to his wife, Ms. Tan, for using the Chinese name but not the trademarks.

CONCLUSION

In summary, Applicant is the only user and the owner of the trademark. Therefore, the opposition shall be dismissed and Applicant is entitled to summary judgment as a matter of law.

Respectfully submitted,

By: /s/Cheng Q. Song

Cheng Q. Song, Ph.D. J.D.
Attorney for the Applicant
Dated: June 26, 2019

Certificate of Service

I hereby certify that a true and complete copy of the foregoing MOTION FOR SUMMARY JUDGMENT OF APPLICANT has been served on H. Danny Kao, KAO & Associates, Counsel for the Opposer, by forwarding said copy on June 26, 2019, via email to dkao@kaolawus.com.

Signature: /s/Cheng Q. Song

Date: June 26, 2019

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the 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

v.

Edison Chinese Chorus Inc.
Applicant

Applicant's First Set of Requests for Admissions to Opposer

Applicant, Edison Chinese Chorus Inc., hereby requests that Opposer responds to the following Request for Admissions within thirty (30) days from the date of service. Applicant reserves the right to serve additional Requests for Admissions as appropriate. In the hereinbelow requests, Trademark means “乡音合唱团” and/or “乡音合唱团”, which were submitted in Application Serial Nos. 87566170 and 87538374.

Request No. 1: Opposer was established in 2017 and it never used Trademark before 2017.

Request No. 2: Ms. Tan never used Trademark from 2001 to present.

Request No. 3: Ms. Tan was never an owner, an officer or a member of Applicant and therefore, she has no control over Applicant.

Request No. 4: Opposer is aware and understands the Bylaws of Applicant which states that Membership meeting is the highest decision mechanism.

Request No. 5: The principal of Opposer, Mr. Jianshe Lu, is a paid music director for Edison Chinese Chorus, aka Xiang Yin Chorus, from about Feb. 2001 to about Feb 2017.

Request No. 6: Applicant's use of Trademark was a result of selection voted by membership in 2001 and no license request was ever mentioned or required by anyone at any time.

Request No. 7: Applicant is the only user of Trademark from about 2001 to about 2017.

Request No. 8: Opposer had no knowledge that a trademark right is acquired by using it in commerce.

Request No. 9: Opposer filed his trademark application in the State of New Jersey before he had a license from Ms. Tan.

Request No. 10: Opposer knows that Applicant used and continuously uses Trademark in the past 18 years.

Request No. 11: Opposer's first use of his trademark, which is identical to Trademark, is on April 28, 2017 in its filing with the State of New Jersey.

Request No. 12: Mr. Yuanqi Wen of Opposer was a member of Applicant from about 2001 to about 2017.

Request No. 13: Mr. Yuanqi Wen has no control over Applicant from about 2001 to about 2017.

Request No. 14: Mr. Jianshe Lu has no control over Applicant from about 2001 to about 2017.

Respectfully submitted:

By: /s/Cheng Q. Song

Cheng Q. Song, Ph.D. J.D.
Attorney for the Applicant
Dated: May 6, 2019

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Applicant's First Set of Requests for Admissions to Opposer has been served on H. Danny Kao, KAO & Associates, Counsel for the Opposer, by forwarding said copy on May 6, via email to dkao@kaolawus.com.

Signature: /s/Cheng Q. Song

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
Before the Trademark Trial and Appeal Board
P.O. Box 1451
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Opposition No. 91238706
Application Serial Nos. 87566170 and 87538374

Xiang Yin He Chang Tuan Inc.
Opposer

v.

Edison Chinese Chorus Inc.
Applicant

Opposer's Replies to Applicant's First Set of Requests for Admissions

Opposer, Xiang Yin He Chang Tuan Inc., hereby submits its Replies to the Applicant's First Set of Requests for Admissions. Opposer reserves the right to supplement and/or amend these Replies as appropriate during the course of this action.

Request No. 1: Opposer was established in 2017 and it never used Trademark before 2017.

Reply No. 1: Opposer objects to this request because the term "established," which can have different practical and legal meanings, is undefined.

Denied. Opposer was incorporated in 2017. Concerning the use of the "Trademark before 2017," Ms. Tan created the Trademark and owned, licensed, and otherwise granted rights to use the Trademark to members of Opposer and the related entities in which they belonged. Ms. Tan used the Trademark with these members and their related entities continuously and without abandonment since she created it in 2001 until she assigned it to Opposer.

Request No. 2: Ms. Tan never used Trademark from 2001 to present.

Reply No. 2: Denied. See Reply No. 1. Ms. Tan used the Trademark continuously and without abandonment from 2001 to the present by granting rights to it to (a) the Edison Chinese School Vocal Group, which included members of Opposer, from 2001 to 2002, in the form of a license and otherwise grant of rights to use; (b) an entity that later became Applicant, which included members of Opposer, from 2002 to 2017, in the form of a license and otherwise grant of rights to use; (c) and then to the Opposer from 2017 to the present, in the form of a license and otherwise grant of rights to use, and then later, in the form of an assignment. At all times Ms. Tan has exerted control over the Trademark's use in part through her husband and Mr. Lv, who were leaders of all of the chorus groups, including from 2001 to the present. See Replies Nos. 5, 6 and 12.

Request No. 3: Ms. Tan was never an owner, an officer or a member of Applicant and therefore, she has no control over Applicant.

Reply No. 3: Opposer objects to this request because the term “control,” which can have different practical and legal meanings, is undefined.

Admitted that Ms. Tan was “never an owner, an officer or a member of Applicant.” Otherwise denied. Ms. Tan maintained control over the Trademark from when she created it in 2001 until it was assigned to Opposer. See Replies No. 1, 2 and 12.

Request No. 4: Opposer is aware and understands the Bylaws of Applicant which states that Membership meeting is the highest decision mechanism.

Reply No. 4: Admitted that the current Bylaws of Applicant states that “Membership meeting is the highest decision mechanism” but that this fact is irrelevant. Otherwise denied. In particular it is denied that this phrase, “Membership meeting is the highest decision mechanism” has any understandable meaning. Denied that at the time of creation and first use of the Trademark on 2/3/2001, there weren’t any Bylaws in place, written or otherwise, or that the Applicant as it is now constituted existed as an entity. The Bylaws were adopted on 10/1/2001. Applicant did not exist on 2/3/2001. An entity that later became Applicant and which included members of Opposer was created and was registered on 4/1/2002.

Request No. 5: The principal of Opposer, Mr. Jianshe Lu, is a paid music director for Edison Chinese Chorus, aka Xiang Yin Chorus, from about Feb. 2001 to about Feb 2017.

Reply No. 5: Denied. Mr. Jianshe Lu, also known as Mr. Bin Lv, was the teacher and leader of a chorus group (Edison Chinese School Vocal Group) since 1999. It was one of his students who proposed forming a chorus group, which group later formed the origin of the Edison Chinese Chorus Group, which registered as an entity on 4/1/2002. At that time, in order for the chorus group to apply for grants, Mr. Lv was listed as the music director because of his qualifications. Mr. Lv was never a “paid” music director, and he neither received a salary nor had any employment contract. Mr. Lv continuously led the chorus groups in all musical performances and otherwise from before 2001 until the present.

Request No. 6: Applicant’s use of Trademark was a result of selection voted by membership in 2001 and no license request was ever mentioned or required by anyone at any time.

Reply No. 6: Denied. There was a selection of the Trademark on 2/3/2001 but not by the entity currently known as Applicant. Applicant did not exist at the time the Trademark was selected on 2/3/2001. An entity, which had no Bylaws, written or otherwise, that later formed the origin of Applicant and which included members of Opposer was created and was registered on 4/1/2002. When the Trademark was selected by this entity on 2/3/2001 and at that time, Mr. Lv, the music teacher and Mr. Wen, Ms. Tan’s husband, who together led that entity, asked Ms. Tan whether they could use the Trademark. Ms. Tan granted them a license and otherwise granted them rights to use the Trademark.

Request No. 7: Applicant is the only user of Trademark from about 2001 to about 2017.

Reply No. 7: Denied. See Replies to Nos. 2 and 6.

Request No. 8: Opposer had no knowledge that a trademark right is acquired by using it in commerce.

Reply No. 8: Opposer objects to this request because it misstates the origin and acquisition of trademark rights.

Denied.

Request No. 9: Opposer filed his trademark application in the State of New Jersey before he had a license from Ms. Tan.

Reply No. 9: Denied. Ms. Tan, licensed, otherwise granted rights to use, and assigned the Trademark and the Opposer's servicemark to the choral group in which her husband was a member.

Request No. 10: Opposer knows that Applicant used and continuously uses Trademark in the past 18 years.

Reply No. 10: Denied. See Replies No. 2 and 6.

Request No. 11: Opposer's first use of his trademark, which is identical to Trademark, is on April 28, 2017 in its filing with the State of New Jersey.

Reply No. 11: Denied. See Replies Nos. 2 and 6. The Opposer's servicemark filed with the State of New Jersey is not identical to the Trademark that is the subject of this opposition proceeding.

Request No. 12: Mr. Yuanqi Wen of Opposer was a member of Applicant from about 2001 to about 2017.

Reply No. 12: Denied. See Replies Nos. 2 and 6. Mr. Wen, husband of Ms. Tan, was learning chorus from Mr. Lv before the entity that formed the origin of Applicant was created on 4/1/2002. Mr. Wen was listed as one of the three initial Board of Trustees on the corporation formation application on 4/1/2002 of that entity. Mr. Wen was president of the entity that was the origin of the Applicant, the Edison Chinese Chorus Group, from 2009 to 2011. Mr. Wen and Mr. Lv were leaders of the chorus groups from 2001 until the present. Mr. Wen left the Edison Chinese Chorus Group in 2017.

Request No. 13: Mr. Yuanqi Wen has no control over Applicant from about 2001 to about 2017.

Reply No. 13: Opposer objects to this request because the term "control," which can have several practical and legal meanings, is undefined.

Denied. See Replies Nos. 1, 2, 5, 6 and 12.

Request No. 14. Mr. Jianshe Lu has no control over Applicant from about 2001 to about 2017.

Reply No. 13: Opposer objects to this request because the term “control,” which can have different practical and legal meanings, is undefined.

Denied. See Replies Nos. 1, 2, 5, 6 and 12.

Respectfully submitted:

By: /s/ H. Danny Kao
H. Danny Kao, Ph.D. J.D.
Attorney for the Opposer

Dated: June 10, 2019

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Opposer’s Replies to First Set of Requests for Admissions has been served on Cheng Q. Song, Counsel for the Opposer, by forwarding said copy on June 10, 2019, visa email to chengqsong@gmail.com.

Signature: /s/ H. Danny Kao