

This decision is not a precedent of the TTAB.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

Baxley

January 29, 2020

Opposition No. 91238706

Xiang Yin He Chang Tuan Inc.

v.

Edison Chinese Chorus Inc. AKA Xiang Yin Chorus or Xiang Yin He Chang Tuan

Before Zervas, Dunn and Hudis,
Administrative Trademark Judges.

By the Board:

I. Background

Edison Chinese Chorus Inc. AKA Xiang Yin Chorus or Xiang Yin He Chang Tuan (“Applicant”) seeks to register the following marks, 乡音合唱团 for “Entertainment services in the nature of live vocal performances by Chorus”¹ and

鄉音合唱團

for “Entertainment services in the nature of live vocal

¹ Application Serial No. 87538374, filed July 21, 2017, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), alleging October 2, 2004 as the date of first use anywhere and of first use in commerce. The application includes (1) a statement that the mark consists of the five Chinese characters that transliterate into “Xiang Yin He Chang Tuan” which means “chorus of homeland voices,” and (2) a disclaimer of the non-Latin characters that transliterate to “he chang tuan.”

performances”² both in International Class 41. Xiang Yin He Chang Tuan Inc. (“Opposer”), in its third amended notice of opposition, 20 TTABVUE, opposes registration of Applicant’s marks, alleging (1) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its prior use of the same marks for the same services; (2) non-ownership of the applied-for marks under Trademark Act Section 1(a), 15 U.S.C. § 1051(a); (3) misrepresentation of source under Trademark Act Section 14(3), 15 U.S.C. § 1064(3); and (4) fraud. In its answer thereto, 26 TTABVUE, Applicant denied the salient allegations of the third amended notice of opposition and asserted affirmative defenses.

This case now comes up for consideration of: (1) Applicant’s motion (filed June 26, 2019) for summary judgment on all of Opposer’s pleaded claims, 27 TTABVUE;³ (2) Opposer’s cross-motion (filed July 17, 2019) for summary judgment on all of its pleaded claims, 29 TTABVUE; (3) Opposer’s motion (filed August 7, 2019) to reopen

² Application Serial No. 87566170, filed August 11, 2017, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging October 2, 2004 as the date of first use anywhere and of first use in commerce. The application includes (1) a statement that the mark consists of the five Chinese characters that transliterate into “Xiang Yin He Chang Tuan” which means “chorus of homeland voices,” and (2) a disclaimer of the non-Latin characters that transliterate to “he chang tuan.”

³ Applicant incorrectly refers to briefs in response as “reply brief[s]” and to reply briefs as “brief[s] in response to the reply brief.” *See, e.g.*, 31 TTABVUE 2. A non-movant’s brief in opposition to a motion is properly characterized as a brief in response or a brief in opposition; a movant’s brief that rebuts arguments in a brief in opposition is properly characterized as a reply brief. *See* Trademark Rules 2.127(a) and 2.127(e)(1); TBMP § 502.02(b) (2019).

In addition, Applicant relies in part on documents in Chinese that are not accompanied by English translations. *See, e.g.*, 31 TTABVUE 17-19. “Board proceedings are conducted in English. If a party intends to rely upon any submissions that are in a language other than English, the party should also file a translation of the submissions. If a translation is not filed, the submissions may not be considered.” TBMP § 104. Where an English translation was not submitted, we do not consider the documents in Chinese.

time to respond to requests for admission, 31 TTABVUE; (4) Opposer's motion (filed August 7, 2019) to strike evidence that Applicant submitted with its reply brief in support of its motion for summary judgment.⁴

II. Opposer's admissions amended

Opposer, in its combined brief in response to Applicant's motion for summary judgment and in support of its cross-motion, argues the merits of this case and does not treat the requests for admissions as admitted. Among other things, Opposer disputes Applicant's assertion that Applicant is the user of the involved marks. 29 TTABVUE 9. Accordingly, we treat that combined brief as incorporating a motion to amend Opposer's admissions under Fed. R. Civ. 36(b).⁵ Under Rule 36(b), the Board may permit withdrawal or amendment of admissions where (1) the presentation of the merits of the action will be subserved thereby and (2) the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits. *See Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1308-09 (TTAB 2007); TBMP § 525.

In this case, upholding the admissions would effectively eliminate Opposer's presentation of the merits of the case. Accordingly, we resolve the first factor in Opposer's favor. Moreover, there is no indication of any prejudice to Applicant that

⁴ Opposer filed its motion to reopen time to respond to requests for admission, its motion to strike, and its reply brief in support of its cross-motion for summary judgment in a single docket entry, 32 TTABVUE. To ensure appropriate processing of each motion, the Board strongly prefers that each motion brief be filed separately resulting in separate docket entries.

⁵ In view of this construction of Opposer's combined brief, Opposer's motion to reopen its time to respond to Applicant's request for admissions is moot.

would result from allowing Opposer to amend its admissions. *See SARL Corexco v. Webid Consulting Ltd.*, 110 USPQ2d 1587, 1589-90 (TTAB 2014) (“While the Board recognizes that petitioner relied on the admissions in filing its motion for summary judgment, such reliance does not rise to the level of ‘prejudice’ as contemplated under Rule 36(b).”). Based on the foregoing, Opposer’s motion to amend its admissions is granted, and Opposer’s responses to Applicant’s requests for admissions are accepted.

III. Motion to strike evidence granted

Applicant’s only evidence submitted with its main brief in support of its motion for summary judgment was a copy of its requests for admission and a copy of Opposer’s late responses thereto. Because Opposer’s late responses put Applicant on notice that Opposer did not concede the requests for admission as put, Applicant should have foreseen that Opposer would seek to amend those admissions. Thus, Applicant, as part of meeting its burden as a movant for summary judgment and in the interest of thoroughness, should have submitted the evidence that accompanied its reply brief in support of the motion for summary judgment with that main brief and set forth its alternative arguments based on that evidence.

Because Opposer could not file a surreply to respond to that evidence, the Board will not consider evidence newly submitted with Applicant’s reply brief in support of its motion for summary judgment. *See* Trademark Rule 2.127(a); *Kellogg Co. v. Pack’Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff’d*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (evidence supporting a motion for summary judgment must be submitted with the motion). Accordingly, Applicant’s motion to

strike is granted to the extent the challenged evidence submitted with the reply brief will receive no consideration.

IV. Motions for summary judgment denied

In support of its motion for summary judgment on all of Opposer's claims, Applicant alleges as follows. Applicant served requests for admissions by e-mail on May 6, 2019, 27 TTABVUE 6-7. Opposer did not serve its responses until June 10, 2019, 27 TTABVUE 8-11, five days after the June 5, 2019 due date, i.e., thirty days from the date of service of the requests for admission. *See* Trademark Rule 2.120(a)(3). Applicant contends that, because Opposer responded late to those requests, the requests stand admitted, and there is no genuine dispute as to the material facts of this opposition.⁶ The only evidence Applicant submitted in support

⁶ The requests for admission, 27 TTABVUE 6-7, are as follows:

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. 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.

of its motion is a copy of its requests for admission and a copy of Opposer's late responses thereto, 27 TTABVUE 6-11.

If Opposer's responses to the requests for admission are deemed timely, Applicant contends in the alternative as follows: Applicant was founded on February 3, 2001 and incorporated in the State of New Jersey on April 1, 2002. Applicant used the involved marks in advertisements and concert programs from 2002 to 2017, during which Opposer's principals, Mr. Jianshe Lu (AKA Bin Lv) ("Mr. Lu") and Mr. Yuanqi Wen, were a music director or a member, respectively, of Applicant. In 2017, Opposer's principals split from Applicant and incorporated. Although Applicant contends that Mr. Wen's wife, Ms. Qian Tan, proposed Applicant's involved marks in 2001 and controlled use of the marks through her influence on her husband, Mr. Wen, who was Applicant's president between 2009 and 2011, Ms. Tan was never an owner, officer, or member of Applicant, and Mr. Wen had only one vote out of twenty to 100, at various stages of Applicant's history, in making decisions on Applicant's behalf. Therefore, even if there was a secret licensing agreement between Ms. Tan and Mr. Wen, Applicant contends that it is the only user and owner of the involved marks and that it is entitled to entry of summary judgment dismissing this case in its entirety. However, Applicant submitted no additional evidence to support this narrative.

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.

In response to Applicant's motion and in support of its cross-motion for summary judgment on all of Opposer's pleaded claims, Opposer asserts as follows: Ms. Tan created the involved marks in 2001 and licensed them since such creation, first to Edison Chinese School Vocal Group ("Edison,") in 2001-02, then to Applicant, before assigning the marks to Opposer. When Applicant's conductor Mr. Lu and Mr. Wen left Applicant in February 2017 and formed Opposer, Ms. Tan exerted her control over the nature and quality of the services rendered under the involved marks by allowing Opposer to use marks and later assigning them to Mr. Lu. Based on the foregoing, Opposer contends that there is no genuine dispute as to the claims herein and that it is entitled to entry of summary judgment on all of them.

Opposer's evidence submitted with its combined brief includes the following: (1) a declaration of its attorney Danny Kao, which makes of record: (a) a copy of Opposer's service mark application No. 25268, filed September 19, 2017 with the New Jersey Division of Revenue and Enterprise Services for the mark XIANG YIN CHORUS XIANG YIN HE CHANG TUAN and design, which incorporates Applicant's involved mark 乡音合唱团 at the bottom (29 TTABVUE 22-24); (b) a program for the 2002 New Jersey Chinese Spring Festival Singing and Dancing Party, where Mr. Lu served as "Chief Planner" and an entity identified as "Xiang Yin Chorus (or Xiang Yin He Chang Tuan)" allegedly performed, with accompanying English translation (29 TTABVUE 25-32); (c) a list of performances led by Mr. Lu from 1999 to present (29 TTABVUE 33-36); (d) a document, dated February 26, 2018, reflecting the assignment of the involved marks from Ms. Tan to Mr. Lu, with accompanying

English translation (29 TTABVUE 37-39); (e) a declaration of Ms. Tan, dated February 26, 2018 (29 TTABVUE 40), wherein she avers that: (i) when Mr. Lu, Mr. Wen and others founded a chorus in 2001, she proposed XIANG YIN HE CHANG TUAN as the name of that chorus; (ii) she allowed XIANG YIN HE CHANG TUAN to be used as the name of the chorus directed by Mr. Lu because her husband, Mr. Wen, was “also the leader of the chorus;” (iii) Mr. Lu and Mr. Wen left the original chorus and formed a new one in February 2017; (iv) she allowed Mr. Lu and Mr. Wen to use of XIANG YIN HE CHANG TUAN as the name of their new chorus; and (2) Opposer’s interrogatory responses (29 TTABVUE 45-51).

The Board, in its July 18, 2019 order, allowed Applicant until August 16, 2019 to file a combined brief in response to the cross-motion and reply brief in support or its motion, not to exceed twenty-five pages.⁷ 30 TTABVUE 1. However, Applicant, on August 6, 2019, filed a reply brief in support of its motion for summary judgment wherein it stated in the preamble that it “believes that there is no need to file [a brief in response] to Opposer’s Cross-Motion for Summary Judgment for the sake of judicial economy” and that it would focus on replying to statements made in response to Applicant’s motion for summary judgment only. 31 TTABVUE 2.⁸ In view of Applicant’s clear and unambiguous intent, we have treated the August 6, 2019 brief,

⁷ In that order, the Board noted that Applicant’s requests for admission were properly served by e-mail and that Opposer’s responses to those requests were untimely. 30 TTABVUE 1-2 n.1.

⁸ In light of this statement, Opposer, on August 7, 2019, filed a reply brief in support of its cross-motion wherein it asks that the Board grant the cross-motion as conceded. 32 TTABVUE 14-16. Applicant, on August 9, 2019, then filed a sur-reply in response to Opposer’s reply brief. 35 TTABVUE.

31 TTABVUE, solely as a reply brief in support of Applicant's motion for summary judgment and not as incorporating a brief in response to the cross-motion.

In its reply brief, Applicant contends as follows: Opposer admitted that two of Opposer's principals, Mr. Lu and Mr. Wen, were a musical director and a member, respectively, of Applicant from its inception to 2017 and that Applicant was the sole user of the involved marks from 2002 to 2017. Ms. Tan was not a singer and never associated her name with the trademark in any promotion or advertisement. There is no record of any agreement between Ms. Tan and Mr. Wen to allow Applicant to use the involved marks. Opposer's assertion that Ms. Tan first licensed the involved marks to Edison contradicts her declaration, in which she avers that she created the marks when Applicant was founded in 2001 for use by Applicant. When Applicant was organized, several Chinese names were proposed by members and friends of Applicant, with the membership voting and selecting the involved mark 乡音合唱团 as Applicant's Chinese name. Ms. Tan was not present for such vote, but Mr. Wen was. No one mentioned any agreement between Ms. Tan and Mr. Wen which allowed Applicant to use that mark until this Opposition.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts,⁹ thus leaving the case to be resolved as

⁹ The parties disagree as to the applicable standard for granting summary judgment. *See* 27 TTABVUE 2, 29 TTABVUE 5, 31 TTABVUE 3. Applicant, in its motion, uses the outdated wording "no genuine issue of material fact" in setting forth the applicable standard for granting a motion for summary judgment and argues against Opposer's use of the wording "genuine dispute of material fact" in setting forth that standard. *Id.* Fed. R. Civ. P. 56(a) was amended in 2010 to state that "[t]he court shall grant summary judgment if the movant shows that there is **no genuine dispute as to any material fact** and the movant is entitled to judgment as a matter of law." (emphasis added). This amendment did not substantially

a matter of law. *See* Fed. R. Civ. P. 56(a). In deciding motions for summary judgment, we follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

After reviewing the parties' arguments and evidence, we find that neither party is entitled to entry of summary judgment. The only evidence that Applicant submitted with its main brief in support of its motion for summary judgment is copies of its requests for admission and Opposer's late responses thereto, which we accepted *supra*. An admission in response to a request for admission "conclusively establishe[s]" the matter that is the subject of that request, whereas a denial in response to a request for admission is merely a refusal to stipulate to certain matter, thus leaving that matter to be resolved on the merits. Fed. R. Civ. P. 36(b); *Phillies v. Phila. Consol. Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1036 n.8 (TTAB 2007). Because many of the matters that Applicant had treated as admitted are now at issue in view of Opposer's

change the standard for granting summary judgment. *See* Fed. R. Civ. P. 56; Committee Notes on Rules – 2010 Amendment ("Dispute' better reflects the focus of a summary-judgment determination.").

denials, Applicant has failed to establish the absence of a genuine dispute of material fact as to any of Opposer's claims and that it is entitled to entry of judgment as a matter of law. Accordingly, Applicant's motion for summary judgment is denied.

Although Applicant did not file a brief in response to the cross-motion, we decline to grant Opposer's cross-motion as conceded. *See* Trademark Rule 2.127(a); TBMP § 502.04. Trademark rights in the United States are acquired by adoption and use of a mark; creation of a trademark does not create trademark rights. *See Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1774 (Fed. Cir. 1987). Where multiple parties claim use and ownership of the mark, whoever controls the nature and quality of services rendered under the mark is the owner of that mark. *See In re Wella A.G.*, 229 USPQ 274, 278 (Fed. Cir. 1986). For example, members of a musical group do not retain rights to use the group's name when they leave the group. *See, e.g., Robi v. Reed*, 173 F.2d 736, 50 USPQ2d 1315, 1317 (9th Cir. 1999), and cases cited therein. Rather, in determining ownership rights in the name of a performing group, the Board considers whether the group name is personal to the individual members, or (2) distinguishes the style and quality of that group. If the latter, the Board must determine whatever quality or characteristic for which the group known and who controls that quality. *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1306 (TTAB 2015).

We find that Opposer has failed to establish the absence of a genuine dispute as to any material fact remaining for trial and that it is entitled to entry of judgment as a matter of law. At a minimum, we find that Opposer has failed to establish the

absence of a genuine dispute as to whether Ms. Tan controlled the nature and quality of services rendered by Applicant after allegedly choosing the involved marks and prior to Mr. Lu's and Mr. Wen's departure from Applicant in February 2017. We further find that there is a genuine dispute as to whether Ms. Tan had any rights in the marks to assign to Mr. Lu that would be sufficient to give rise to any of the claims in this proceeding. In view of the foregoing, Opposer's cross-motion for summary judgment is denied.¹⁰

Proceedings herein are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	4/29/2020
Discovery Closes	5/29/2020
Plaintiff's Pretrial Disclosures Due	7/13/2020
Plaintiff's 30-day Trial Period Ends	8/27/2020
Defendant's Pretrial Disclosures Due	9/11/2020
Defendant's 30-day Trial Period Ends	10/26/2020
Plaintiff's Rebuttal Disclosures Due	11/10/2020
Plaintiff's 15-day Rebuttal Period Ends	12/10/2020
Plaintiff's Opening Brief Due	2/8/2021
Defendant's Brief Due	3/10/2021
Plaintiff's Reply Brief Due	3/25/2021
Request for Oral Hearing (optional) Due	4/4/2021

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is

¹⁰ The parties should not presume that these are the only issues remaining for trial. The Board, in exercising its inherent authority to control conduct of cases on its docket, will not consider any further motions for summary judgment on the claims currently pleaded in this proceeding.

Evidence submitted in connection with the cross-motions for summary judgment is of record for consideration of those motions only. If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. *See* TBMP § 528.05(a)(1).

taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).