

This decision is not a TTAB precedent.

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Baxley

August 28, 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:

This case now comes up for consideration of Applicant's renewed motion (filed March 30, 2020, 39 TTABVUE) for summary judgment, and Opposer's motion (filed March 30, 2020, 42 TTABVUE) to reopen its time to serve responses to Applicant's second set of requests for admissions and second set of interrogatories.<sup>1</sup> The motions have been fully briefed.

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<sup>1</sup> Applicant's motion is captioned as a motion for judgment on the pleadings. However, because Applicant relies on matters beyond the pleadings, the Board determined in its April 1, 2020 suspension order, 44 TTABVUE, that the motion would be treated as a renewed motion for summary judgment.

Citations to the record or briefs in this order also include citations to the publicly available documents on TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n. 6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. All citations to documents contained in the TTABVUE database are to the downloadable .pdf versions of the documents in the USPTO TTABVUE Case Viewer.

## 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”<sup>2</sup> and **鄉音合唱團** for “Entertainment services in the nature of live vocal performances”<sup>3</sup> 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.<sup>4</sup> In its answer

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<sup>2</sup> Application Serial No. 87538374, filed July 21, 2017, based on an assertion of 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.”

<sup>3</sup> 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), 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.”

<sup>4</sup> In a February 4, 2019 order, 25 TTABVUE, the Board denied Applicant’s motion to dismiss the third amended notice of opposition under Fed. R. Civ. P 12(b)(6), finding that the foregoing claims were sufficiently pleaded in the third amended notice of opposition.

thereto, 26 TTABVUE, Applicant denied the salient allegations of the third amended notice of opposition and asserted affirmative defenses.

In a January 29, 2020 decision, 38 TTABVUE, we, among other things, granted Opposer's motion to amend its admissions and denied the parties' cross-motions for summary judgment. Because Applicant's first motion for summary judgment was based on admissions which we, in that decision, allowed Opposer to amend, 38 TTABVUE 3-4, we denied Applicant's first motion for summary judgment, 38 TTABVUE 10-11. We further found that Opposer failed to establish the absence of a genuine dispute as to any material fact remaining for trial and that it was entitled to entry of judgment as a matter of law, 38 TTABVUE 11-12. Applicant filed its renewed motion for summary judgment two months later.<sup>5</sup>

## II. Opposer's response to second set of interrogatories accepted; admissions amended

We first consider Opposer's motion to reopen time to respond to the second set of interrogatories and second set of requests for admission that Applicant served on June 19, 2019. Proceedings herein were suspended between the filing of Applicant's motion for summary judgment on June 26, 2019, 27 TTABVUE, and the issuance of

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<sup>5</sup> Concurrently with the renewed motion for summary judgment, Applicant filed two motions to compel, 40 and 41 TTABVUE which the Board denied in its April 1, 2020 suspension order, 44 TTABVUE. In the first motion to compel, 40 TTABVUE, Applicant sought to compel responses to its second set of interrogatories that it served on June 26, 2019. The Board denied that motion without prejudice for failure to make a good faith effort to resolve the parties' dispute discovery prior to seeking Board intervention, 44 TTABVUE 2. In the second motion to compel, 41 TTABVUE, Applicant sought to compel service of a revised first and second sets of document requests that corrected typographical errors that Opposer made in the preambles thereof regarding the identification of the party serving those requests. The Board determined that Applicant failed to make a good faith effort to resolve the parties' discovery dispute and that, in view of the obviousness of the typographical errors at issue, requiring revised sets of document requests was unnecessary, 44 TTABVUE 2-3.

the Board's January 29, 2020 order, 38 TTABVUE. *See* Trademark Rule 2.127(d); TBMP § 528.03. Applicant's second sets of interrogatories were not at issue in the briefing of the motions decided in the January 29, 2020 decision, and the Board did not expressly reset time to respond to them in the January 29, 2020 decision.<sup>6</sup>

Opposer contends that it forgot about the second sets of interrogatories and requests for admission until March 30, 2020, when Applicant filed its motion to compel responses to the second set of interrogatories, and served responses on that day.<sup>7</sup> In view of Opposer's service of responses to the interrogatories on the same day that the motion to compel responses thereto was filed and the Board's denial of that motion to compel in the April 1, 2020 order, 44 TTABVUE, the motion to reopen time to respond to the interrogatories is moot. Opposer's responses to Applicant's second set of interrogatories are accepted.

With regard to the requests for admissions, the Board, under Fed. R. Civ. P. 36(b), 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 Board that withdrawal or amendment will prejudice

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<sup>6</sup> The Board noted in the April 1, 2020 order that "the Board generally allows parties until thirty days from the date of resumption to serve responses to any outstanding written discovery requests. Accordingly, the parties were allowed until February 28, 2020 to respond to any written discovery requests that were outstanding at the time the January 29, 2020 order was issued." 44 TTABVUE 1 n.1.

<sup>7</sup> Applicant did not request responses without objection in that motion. In any event, the Board denied that motion without prejudice in the April 1, 2020 order.

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.

The admissions do not subserve the presentation of the merits of the action, because Opposer's positions in this litigation are inconsistent with the admissions made under Rule 36. For example, Opposer now disputes that there was no written license or permission between 2001 and 2017 from Ms. Qian Tan, the alleged creator of the involved mark, to her husband, Mr. Yuanqi Wen, a former member and president of Applicant, regarding use of the involved mark (request no. 22); and that the claimed license regarding the use of the involved mark between Mr. Wen and Ms. Tan was not witnessed by anyone from 2001 to 2017 (request no. 23), 45 TTABVUE 51-54. Accordingly, we resolve the first factor in Opposer's favor.

Moreover, there is no indication of any prejudice as contemplated under Rule 36(b) to Applicant that 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 served on March 30, 2020 are accepted as Opposer's responses to Applicant's second set of requests for admissions.

### III. Renewed motion for summary judgment denied

In support of its renewed motion for summary judgment, Applicant seeks dismissal of this entire proceeding without specifying any basis for each particular claim on grounds that (1) the “complaint fail[s] to pass the plausibility test; (2) Applicant’s second set of requests for admission stand admitted; and (3) in view of these admissions, the opposition should be dismissed.

Regarding Applicant’s assertion that the third amended notice of opposition fails to set forth plausible claims, the Board, in its February 14, 2019 order, 25 TTABVUE, determined that, in the third amended notice of opposition, Opposer had adequately pleaded the four claims mentioned above. A legally sufficient claim, by definition, is plausible. See *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009). Applicant did not timely seek reconsideration of that order. See Trademark Rule 2.127(b). Under the law of the case doctrine, we decline to revisit that determination. See *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010).

In asserting that Opposer failed to set forth a plausible claim, Applicant asserts that Ms. Tan never used or owned the involved marks; that neither Ms. Tan nor her husband, Mr. Wen, had control over Applicant; and that whatever rights Ms. Tan had in the involved marks have been abandoned. However, in view of the declaration of Bin Lv (AKA Bin Lü and Jianshe Lü), Applicant’s former musical director from its founding until 2017 and Opposer’s current musical and artistic director since 2017,<sup>8</sup>

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<sup>8</sup> In his declaration, Mr. Lv. avers, among other things, that Ms. Tan proposed the name for the group, which she permitted Applicant to use through an oral license; that Ms. Tan was

45 TTABVUE 63-68, we find that there are genuine disputes as to whether Ms. Tan controlled the nature and quality of services rendered by Applicant after allegedly choosing the involved marks in 2001 and prior to Mr. Lv's and Mr. Wen's departure from Applicant in February 2017. Further, the February 26, 2018 assignment of the involved marks from Ms. Tan to Opposer that Opposer submitted in support of its earlier decided cross-motion for summary judgment, 29 TTABVUE 38, raises a genuine dispute as to whether Ms. Tan had any rights in the marks to assign to Opposer that would be sufficient to give rise to any of the claims in this proceeding.

Applicant also asserts that its second set of requests for admissions stand admitted and that, in view of such admissions, the opposition should be dismissed in its entirety. However, those admissions have been withdrawn, and we have accepted Opposer's March 30, 2020 responses to the second set of requests for admission. We therefore decline to grant summary judgment on this basis.

Based on the foregoing, Applicant's renewed motion for summary judgment is denied. Bearing in mind that we have now denied three motions for summary judgment in this case, **the parties may not file any additional motions for**

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"was very involved" with Applicant's "performances and insured that the content and the quality of" Applicant's performances under the involved marks "were authentic and of the highest quality; that Ms. Tan and Mr. Lv worked closely on a "March 16, 2013 concert that commemorated the 100th anniversary of the birth of Wang Luobin, ... a famous Chinese songwriter that wrote songs based upon the music of various ethnic minorities in western China;" that, for the March 16, 2013 concert, Ms. Tan "proposed the idea for the performance, selected the form of the performance, and was involved with the selection of the songs and the style of the performance;" that, when Mr. Wen and Mr. Lv. left Applicant in 2017 to form Opposer, she permitted Opposer to use the involved marks; and that Opposer has used the marks since then. 45 TTABVUE 63-68.

**summary judgment in this case. The parties are ordered to move this case forward to trial without undue delay.**

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

Expert Disclosures Due	9/30/2020
Discovery Closes	10/30/2020
Plaintiff's Pretrial Disclosures Due	12/14/2020
Plaintiff's 30-day Trial Period Ends	1/28/2021
Defendant's Pretrial Disclosures Due	2/12/2021
Defendant's 30-day Trial Period Ends	3/29/2021
Plaintiff's Rebuttal Disclosures Due	4/13/2021
Plaintiff's 15-day Rebuttal Period Ends	5/13/2021
Plaintiff's Opening Brief Due	7/12/2021
Defendant's Brief Due	8/11/2021
Plaintiff's Reply Brief Due	8/26/2021
Request for Oral Hearing (optional) Due	9/5/2021

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

**Each party's counsel must submit bar membership information**

Each party is represented by an attorney. Effective August 3, 2019, the USPTO amended its rules to require all practitioners qualified under Patent and Trademark Rule 11.14(a) to be an active member in good standing and to provide the name of a state in which he or she is an active member in good standing; the date of admission to the bar of the named state; and the bar license number, if one is issued by the named state. Trademark Rule 2.17(b)(3).

Accordingly, each party's counsel is allowed **thirty days** from the date of this order to provide the information using the Change of Address form in ESTTA. The bar information entered on the ESTTA Change of Address form will be masked from TTABVUE. If either fails to comply with this order, the Board may issue an order to show cause.