

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

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February 20, 2022

Opposition No. 91238706

Xiang Yin He Chang Tuan Inc.

v.

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

Ashley D. Hayes, Interlocutory Attorney:

This case now comes up for consideration of Opposer's motion (filed March 30, 2021) to strike Applicant's 12 testimony declarations, notice of reliance, and 44 exhibits attached thereto.¹ 57 TTABVUE.² The motion is fully briefed.

¹ To the extent Opposer's motion also seeks entry of judgment under the Board's inherent sanction authority for Applicant's failure to follow evidentiary rules, it will be given no consideration. Opposer alleges no pattern of misconduct in this proceeding and based on Opposer's own failure to follow the Board's rules, its motion to strike is not being granted in its entirety. While the Board does not condone failure to follow the rules by any party, lesser sanctions are appropriate here. *See Amazon Techs. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010).

² Citations to the record or briefs in this order 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.

The parties are advised that going forward, citations to the record in their filings should be made in the format shown above, rather than by referring to the ESTTA Tracking Number shown on the ESTTA cover sheet.

Opposer's brief exceeds the 25-page limit for a brief in support of a motion.³ See Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a). While objecting to the excessive length, Applicant also addressed the merits of the motion, and in its reply, Opposer offered to withdraw "to the extent not helpful or otherwise permitted" Exhibits A and B. 62 TTABVUE 9. In the interest of moving the case forward, the Board exercises its discretion to consider the motion in its entirety.⁴ Although the Board has carefully considered the parties' briefs and materials submitted therewith, it addresses the record only to the extent necessary to support its analysis and findings, and does not repeat or address all of the parties' arguments or materials. See *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings, and the arguments and materials submitted in connection with the subject motion.

I. Background

Edison Chinese Chorus Inc. AKA Xiang Yin Chorus or Xiang Yin He Chang Tuan ("Applicant") seeks to register the mark 乡音合唱团 for "[e]ntertainment services in the nature of live vocal performances by Chorus,"⁵ and 乡音合唱团 for

³ Exhibits A and B to Opposer's brief contain specific objections to Applicant's evidence, which should have been included in Opposer's brief. When included in the page count, the brief exceeds 25 pages. A party may not circumvent the Board's page limit by submitting part of a motion as an attachment. See *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (arguments filed as attachment to brief considered in page limit).

⁴ Opposer is advised that the Board expects Opposer's future filings to comply with the Board's procedural rules, including those related to the form and page limits for briefs. The Board may refuse to consider future submissions that fail to adhere to the Board's rules.

⁵ 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), and alleging October 2,

“[e]ntertainment services in the nature of live vocal performances,”⁶ both in International Class 41.

Xiang Yin He Chang Tuan Inc. (“Opposer”), in its third amended notice of opposition, 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. 20 TTABVUE. Applicant, in its answer, denied the salient allegations in the third amended notice of opposition and asserted four purported affirmative defenses. 26 TTABVUE.

As most recently reset, Applicant’s trial period closed on March 29, 2021. 47 TTABVUE 8. On March 28, 2021, Applicant filed its evidence comprised of 12 trial declarations, 54 TTABVUE, and a notice of reliance with 44 exhibits. 55 TTABVUE and 56 TTABVUE. Opposer’s motion to strike all of Applicant’s evidence followed two days later. 57 TTABVUE.⁷

2004, as the date of first use anywhere and 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.”

⁶ 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 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.”

⁷ The Board regrets the delay in deciding the motion.

II. Motion to Strike Evidence

Opposer seeks an order striking Applicant's notice of reliance, accompanying exhibits, and testimony declarations based on its failure to comply with the Board's procedural rules, as an estoppel sanction, and based on substantive objections to the evidence.

A. Deficient Notice of Reliance

Opposer contends Applicant's notice of reliance should be stricken because it lacks any substance and does not provide a sufficient statement of relevance for the attached exhibits, as required by Trademark Rule 2.122(g), 37 C.F.R. §2.122(g). 57 TTABVUE 8-9.

In response, Applicant argues a statement of relevance is not required for exhibits that are not offered under a notice of reliance, and that the statements on the cover page of each exhibit are sufficient in any event. 58 TTABVUE 15.

Under the Trademark Rules, a notice of reliance may be used to submit trademark registrations (Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2)), printed publications and Internet evidence (Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e)), and discovery responses⁸ and depositions (Trademark Rule 2.120(k), 37 C.F.R.

⁸ Documents produced in discovery may not be introduced by notice of reliance alone, except to the extent the documents are otherwise admissible by notice of reliance, for example, as printed publications or official records under 37 C.F.R. § 2.122(e). *See Bos. Athletic Ass'n v. Velocity, LLC*, 117 USPQ2d 1492, 1494 (TTAB 2015) ("a party that has obtained documents through a response to a request for production of documents may not make the documents of record by notice of reliance alone"); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 704.11 (2021). Additionally, denials to admission requests cannot be submitted under notice of reliance. *See, e.g., Tivo Brands, LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1101 n.14 (TTAB 2018); TBMP § 704.10.

§ 2.120(k)). Because evidence which is not self-authenticating requires identification and foundation necessarily provided by a witness, an offering party cannot use a notice of reliance “for any or all ‘exhibits.’” *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015). “A notice of reliance may only be used for the specific categories of documents set out in the relevant rules.” *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014). For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. *See id.* Evidence submitted with a notice of reliance which does not comply with the requirements for introduction of such evidence may be excluded. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1718-19 (Fed. Cir. 2012) (Board did not abuse its discretion by excluding opposer corporation’s annual reports from record in opposition proceeding on ground that reports were not admissible through notice of reliance).

The Board finds Applicant’s notice of reliance (55 and 56 TTABVUE), which is used to introduce a jumble of documents exceeding 400 pages, is deficient as to form. More specifically, the notice of reliance impermissibly: (i) combines evidence appropriate for submission by notice of reliance with evidence labelled “trial exhibits” which is not admissible by notice of reliance; and (ii) omits the required listing of attached evidence with the relevance of the evidence and association with one or more issues in the proceeding. To be clear, Applicant’s prefatory statement that “[t]he Description and Relevance of each of the Applicant’s Trial Exhibits are listed in the

cover page for each Exhibit” is insufficient. The notice of reliance itself must list the required information for each attached exhibit. *See* Trademark Rule 2.122(g); TBMP § 704.02.

While the Board will not address each of the more than 400 pages attached to the notice of reliance, the Board notes that Applicant’s description of the relevance of the submitted information set forth in the cover page for the exhibits is also deficient in its lack of specificity. For example, Applicant’s Trial Exhibit 8 consists of Opposer’s operative pleading (the third amended notice of opposition). 55 TTABVUE 84-93. This is duplicative evidence because the pleadings form part of the record without any action by the parties. *See Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 (TTAB 2011).⁹ Even if the notice of opposition was not duplicative, but submitted as an official record, the notice of reliance is deficient in describing its relevance as statements that “relate to the five claims in the Notice of Opposition.” 55 TTABVUE 84. *See Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1164 (TTAB 2017) (“offering party should associate the materials with a specific factor relevant to a specific and pleaded claim or defense, or a specific fact relevant to determining a particular claim or defense [].”); *see also FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (holding notice of reliance should associate materials with a specific likelihood of confusion factor) (citing *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039-4 (TTAB 2010)).

⁹ Additionally, the parties are reminded that evidence properly made of record by one party may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. *See* Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a).

In view of the foregoing, Opposer's motion to strike Applicant's notice of reliance is **GRANTED**.

1. Applicant May Cure Deficiencies in the Notice of Reliance

The deficiencies in Applicant's notice of reliance are procedural defects which are curable. *See Barclays Capital Inc.*, 124 USPQ2d at 1165; *FUJIFILM SonoSite, Inc.*, 111 USPQ2d at 1237. Accordingly, Applicant is allowed until **TEN (10) DAYS** from the date of this order to submit a substitute notice of reliance which complies with the Board's rules, including providing in the body thereof, a list identifying the specific exhibits offered thereunder (i.e., A, B, C., etc.) which: (i) states the basis upon which the exhibit is being offered under the notice of reliance (e.g., trademark registrations (Trademark Rule 2.122(d)(2)), printed publications and Internet evidence (Trademark Rule 2.122(e)), or discovery responses and depositions (Trademark Rule 2.120(k)); and (ii) indicates generally the relevance of the evidence and associates it with one or more issues in the proceeding.

Because Applicant's testimony period is closed and Applicant may not submit new evidence with the substitute notice of reliance, *see* Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a), for each exhibit listed in the substitute notice of reliance, following the description of the exhibit's relevance, Applicant must state where in the record the exhibit was previously submitted during its testimony period. For example, Applicant's substitute notice of reliance could list as Exhibit A, Opposer's service mark application for registration and registration with the State of New Jersey, submitted as official records of the New Jersey Division of Revenue and Enterprise Services pursuant to Trademark Act 2.122(e)(1); the documents are relevant to _____

(identify a specific factor(s) or fact(s) at issue in a pleaded claim or defense to which Applicant contends the evidence is relevant, [e.g., ownership or priority, etc.]); the documents were previously submitted with Applicant's prior notice of reliance at 55 TTABVUE 9-11.

2. Applicant May Refile Stricken Exhibits for Declarations Already of Record

Some exhibits submitted by the now-stricken notice of reliance are described as exhibits to a declaration located elsewhere in the trial evidence. To properly associate these exhibits with the testimony which authenticates the evidence, Applicant is allowed until **TEN (10) DAYS** from the date of this order to refile the previously submitted exhibit(s) as follows:¹⁰

Applicant may submit as one entry all exhibits to a declaration already of record titled "exhibits to [witness name] declaration located at ___ TTABVUE,"

OR

Applicant may refile the declaration already of record titled "Substitute declaration of [witness name] including exhibits for declaration located at ___ TTABVUE."

The filing, whether exhibits alone or declaration and exhibits, must include a cover page statement specifying where in the record the accompanying exhibits were submitted during Applicant's testimony period. For example, Applicant could state

¹⁰ This permission to refile exhibits designated as exhibits to specific testimony does not apply to exhibits to testimony stricken as an estoppel sanction in Section II(B) *infra*, namely the declarations of Mann May, Yanping Guo, Jianjun Liu, and Yabin Lei.

“Exhibit(s) ___ - ___ now attached to the ___ declaration were previously submitted at ___ TTABVUE ___-___.

Exhibits for multiple declarations should not be refiled together as one entry. Each entry should pertain to a single declaration.

As stated above, if Applicant fails to refile any exhibit submitted at 55 and 56 TTABVUE, whether with the substitute notice of reliance or as an exhibit to a declaration already of record, that exhibit remains stricken and will be given no consideration.

B. Estoppel Sanction

A motion to strike evidence as an estoppel sanction contends that a party failed to provide information, or provided an untimely supplement, and is barred by its own actions from using that information or witness at trial, unless the failure to disclose was substantially justified or is harmless. *See, e.g., General Mills Inc.*, 100 USPQ2d at 1593-94; TBMP § 527.01. With respect to whether information was required, each party to an inter partes proceeding must serve initial disclosures that identify “each individual likely to have discoverable information ... that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment.” Fed. R. Civ. P. 26(a)(1); *see also* Trademark Rules 2.116(a), 2.120(a)(1), and 2.120(a)(2)(ii), 37 C.F.R. §§ 2.116(a), 2.120(a)(1), and 2.120(a)(2)(ii). Additionally, a party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. *See Panda*

Travel, Inc. v. Resort Enters. Inc., 94 USPQ2d 1789, 1791 (TTAB 2009). Further, parties are required to supplement their initial disclosures and discovery responses “in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.” Fed. R. Civ. P. 26(e)(1)(A); *see also Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1241 (TTAB 2012). The Board’s rules also require the service of pretrial disclosures. *See* Trademark Rule 2.121(e), 37 C.F.R. § 2.121(e). Pretrial disclosures must “disclose the name and, if not previously provided, the telephone number and address of each witness from whom [the disclosing party] intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as [] occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.” *Id.*

As stated *supra*, a party that fails to provide information or identify a witness as required by Rule 26(a) or (e), may, upon motion or objection by its adversary, be precluded by the estoppel sanction from using that information or witness at trial, “unless the failure was substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1); *see also Great Seats, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011).

The Board looks to the following five factors (herein the “*Great Seats* factors”) to determine whether the failure to disclose was substantially justified or harmless: 1)

the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) the importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence. *See Great Seats, Inc.*, 100 USPQ2d at 1327 (citations omitted).

1. Testimony Declarations

Opposer asks the Board to strike the testimony declarations of five declarants, namely Cheng Song, Jianjun Liu, Mann May, Yabin Lei, and Yanping Guo,"¹¹ on the basis that "they were not identified in any of Applicant's discovery disclosures or responses as having discoverable information." 57 TTABVUE 3, 7.

In response, Applicant does not contend it identified these witnesses during discovery or that Opposer was otherwise made aware the witnesses likely had discoverable information upon which Applicant might rely at trial. Rather, Applicant argues its pretrial disclosures sufficiently identified each of the witnesses and "there is no rule to prohibit a witness' trial testimony if he/she was not a witness in discovery as long as a proper pretrial disclosure was made." 58 TTABVUE 12.¹²

¹¹ Opposer should have included the full names of the witnesses it contends Applicant failed to identify during discovery inasmuch as Applicant submitted the testimony declarations of Jianjun Liu and Yu Liu, 57 TTABVUE 7 (note 3), and Opposer did not identify where in the record the declarations of the non-disclosed witnesses are located. However, inasmuch as Applicant disclosed Yu Liu as a witness in its initial disclosures, 62 TTABVUE 24, the Board construes Opposer's motion to strike as applicable to witness Jianjun Liu.

¹² Applicant also argues Opposer's motion to strike its testimony declarations on the basis the witnesses were not previously disclosed should be denied because Opposer itself failed to disclose "7 new trial witnesses." 58 TTABVUE 4. Applicant's obligation to follow the rules stands independent of the actions of the adverse party. Applicant's perfunctory argument in no way can be considered a motion to strike Opposer's witnesses.

Applicant's arguments are not well taken. Although a party is not required to disclose all potential witnesses it may use at trial in its initial disclosures, *see Byer California v. Clothing for Modern Times, Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010), a party is nevertheless obligated to supplement those disclosures "in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing." Fed. R. Civ. P. 26(e)(1)(A); *see also Spier Wines (PTY) Ltd.*, 105 USPQ2d at 1241; *Great Seats Inc.*, 100 USPQ2d at 1326.

Accordingly, the Board addresses whether the failure to disclose these witnesses should bar consideration of their testimony, or whether the failure was substantially justified or is harmless.

(a) Witnesses Liu, May, Guo, and Lei

There is no evidence that Mr. Liu, Ms. May or Ms. Guo were identified in Applicant's initial disclosures or elsewhere during discovery. Nor does Applicant contend it only recently learned of these witnesses. Accordingly, the Board finds Applicant's disclosure of Mr. Liu, Ms. May, and Ms. Guo as witnesses for the first time in its pretrial disclosures resulted in unfair surprise to Opposer.

With respect to Mr. Yabin Lei the record demonstrates that Opposer served a notice to take Mr. Lei's deposition prior to the close of discovery. 62 TTABVUE 20 (¶ 2). However, Opposer withdrew the deposition notice based on Applicant's

representation that “Mr. Ya Bin Lei¹³ is no longer associated with Applicant and Applicant has been unable to reach him.” *Id.* (¶ 3). Once circumstances changed and Applicant located Mr. Lei, Applicant had a duty to timely notify Opposer to correct its prior representation regarding its inability to reach the witness. *See* Fed. R. Civ. P. 26(e)(1)(A); TBMP § 408.03. There is no evidence in the record that Applicant so notified Opposer. Accordingly, the Board finds Applicant’s disclosure of Mr. Lei in its pretrial disclosures after previously representing it had been unable to reach the witness resulted in unfair surprise to Opposer.

In considering the additional *Great Seats* factors, the Board finds Applicant’s failure to previously disclose Mr. Liu, Ms. May, Ms. Guo, and to notify Opposer that Applicant had reached Mr. Lei, was not harmless or justified inasmuch as it deprived Opposer of the opportunity to take the discovery deposition of these witnesses. *See Byer*, 95 USPQ2d at 1179 (lack of opportunity to take a discovery deposition of a witnesses weighs against allowing his testimony). Moreover, this case has been pending since January 3, 2018, 1 TTABVUE, and discovery closed October 30, 2020. 47 TTABVUE 8. Reopening discovery at this late date, after Opposer’s trial period has closed, would be extremely disruptive. *Cf. Spier (PTY) Wines Ltd.*, 105 USPQ2d at 1246 (reopening of discovery period to allow depositions on written questions would be significantly disruptive to the proceeding). Accordingly, these factors favor Opposer.

¹³ Notwithstanding the different presentation of Ya Bin and Yabin, neither party contends the names refer to two different people.

Regarding the importance of the evidence, Applicant's pretrial disclosures state that the subject matter of these witnesses' testimony may include the history of Applicant and the ownership and use of Applicant's involved marks, 56 TTABVUE 18-20, which may be important. Nevertheless, the Board notes Applicant identified several other witnesses who may testify on the same subject matter. *See, e.g., id.* at 16-18 (Jian Tang, Min Li, Yu Liu, Oi Mo, and Chia-Chia Tsui). Further, Applicant failed to provide any reason as to why it did not supplement its initial disclosures to identify Ms. May, Ms. Guo, or Mr. Liu, or notify Opposer that it had located Mr. Lei prior to disclosing the witnesses in its pretrial disclosures.

On balance, the Board finds that Applicant's failure to identify Mann May, Yanping Guo, and Jianjun Liu and advise that Yabin Lei had been reached until its pretrial disclosures was neither harmless nor justified. *See, e.g., Great Seats, Inc.*, 100 USPQ2d at 1328. Accordingly, Opposer's motion to strike Applicant's testimony declarations of Mann May, Yanping Guo, Jianjun Liu, and Yabin Lei is **GRANTED**.

(b) Witness Cheng Song

With respect to Mr. Song, the Board notes he is Applicant's attorney in this proceeding. Although Applicant does not dispute it did not identify Mr. Song as a witness prior to service of its pretrial disclosures, Applicant's pretrial disclosures demonstrate that the purpose of his testimony is to authenticate documents filed and served by Opposer and Applicant in this proceeding. 56 TTABVUE 15.¹⁴ As an

¹⁴ Moreover, the only exhibit referenced in Mr. Song's declaration, 54 TTABVUE 1-5, to which Opposer objects on the basis it was not previously disclosed is Exhibit 14. However, as discussed in Section II(B)(2) *infra*, Opposer has failed to demonstrate that any of the exhibits to which it objects were requested by Opposer during discovery.

authenticating witness, there was no failure to disclose Mr. Song. *See Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1102 (TTAB 2018) (“authentication testimony for documents does not add substantively to the evidence”). In view of the foregoing, Opposer’s motion to strike the testimony declaration of Mr. Cheng Song on the basis that he was not previously disclosed as a witness is **DENIED**.

2. Trial Exhibits

Opposer seeks to strike 23 of Applicant’s Exhibits (Nos. 14, 16, 18, 21-36, 38, 40, and 42-43) on the basis that the documents therein were not previously disclosed during discovery (in addition to the previous basis that the notice of reliance is defective). Opposer alleges:

Applicant had no legitimate basis for withholding the Trial Exhibits and thus they are inadmissible as untimely. In addition, Applicant’s discovery responses are demonstrably not reliable, as it must be acknowledged that withholding 23 exhibits, more than half of Applicant’s total, evidences a party that did not act in good faith and did not comply with its discovery obligations, seeking to ambush its opponent.

57 TTABVUE 8.¹⁵

As set forth above, the estoppel sanction is applied where the movant shows that information was required under the rules, whether as a disclosure or because it was requested in discovery, and was not disclosed or produced.

Here, Opposer failed to support its motion with copies of the relevant disclosures or discovery requests. Moreover, Opposer’s motion failed to identify any specific

¹⁵ Applicant’s motion states the attached Exhibit B “is a chart analyzing each of Applicant’s 44 Trial Exhibits and its admissibility.” 57 TTABVUE 8. The chart does not refer to specific discovery requests but repeats the vague allegation that “[t]his document was not produced by either party in discovery.” 57 TTABVUE 25.

requests which Opposer contends required the prior production of each of the 23 Exhibits at issue.¹⁶ Additionally, although Opposer argues “it requested the withheld information in Applicant’s 23 new Trial Exhibits and related declarations in discovery from Mr. Fan,” in support thereof, Opposer references only the topics in its 30(b)(6) deposition notice. 57 TTABVUE 5 (note 2), 40-48. Opposer does not state and the deposition notice did not include a request that Applicant produce documents in connection with the deposition. *Id.* at 42-48. Accordingly, Applicant was not obligated to produce any documents in connection with the noticed deposition. *See Fed. R. Civ. P.* 30(b)(2) (The notice to a party deponent may be accompanied by a request under Rule 34 to produce documents and tangible things at the deposition.). In view of the foregoing, Opposer’s motion to strike Exhibits 14, 16, 18, 21-36, 38, 40, and 42-43 on the basis that Applicant failed to produce the documents therein during discovery is **DENIED.**

C. “Tainted” Testimony Declarations

Opposer seeks to strike Applicant’s testimony declarations of properly disclosed witnesses on the basis that the “very large amount of substantive information that was withheld from Opposer [] taints the remaining [] Trial Declarations because

¹⁶ Opposer’s contention in reply that Applicant submitted Opposer’s requests in response to the motion “in the first part of Applicant’s exhibits,” 62 TTABVUE 7, ignores that Opposer was obligated to submit the requests in support of its moving brief. *See Johnston Pump/General Valve, Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) (“The presentation of one’s arguments and authority should be presented thoroughly in the motion or the opposition brief thereto”). Moreover, it appears Opposer is referring Applicant’s requests rather than those of Opposer. 62 TTABVUE 7-8 (referring to the referenced requests as “Applicant’s requests”).

such a large amount of new information informed and otherwise influenced their testimony.” 57 TTABVUE 7.

To the extent Opposer argues all 12 declarations should be stricken based on Applicant’s purported failure to produce Exhibits 14, 16, 18, 21-36, 38, 40, and 42-43 prior to trial, Opposer did not establish there was a failure to produce requested information. To the extent Opposer argues the testimony declarations themselves include new information not previously disclosed during discovery, Opposer again failed to point to any discovery request seeking the information purportedly withheld. Accordingly, Opposer’s motion to strike Applicant’s testimony declarations of properly disclosed witnesses on the basis they contain or are reliant upon new information not previously provided to Opposer is **DENIED**.

D. Testimony Not Based on Personal Knowledge

Opposer further objects to each of Applicant’s testimony declarations on the basis they are “not based on personal knowledge.” 57 TTABVUE 5. A witness may testify to a matter if evidence is introduced that is sufficient to support a finding that the witness has personal knowledge of the matter. *See* Fed. R. Evid. 602. Evidence to prove personal knowledge may consist of the witness’ own testimony. *See Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1932 (TTAB 2006) (“Regarding the testimony at 175, [Opposer’s CEO] Mr. Groumout is not competent to testify about the alleged licensing activities of [third party] Jaguar, and his testimony about his personal knowledge of a product allegedly licensed by Jaguar will not be given any weight.”); *Interstate Brands Corp. v. McKee Foods Corp.*, 53

USPQ2d 1910, 1911 n.4 (TTAB 2000) (“the fact that Mr. Osman is an advertising manager provides sufficient foundation for his testimony” introducing exhibits showing mark used in third party television shows.).

Here, Opposer failed to support its objection with the necessary facts. With the exception of declarants Song and Fan, Opposer argues only that “[e]ach declaration states that different events did not happen, such as Ms. Tang asserting her rights in the trademarks, or what Mr. Bin Lu did or did not do” and that the declarants “cannot know that information.” 57 TTABVUE 5-6. However, Opposer does not specify that statements about Ms. Tang or Mr. Bin Lu appear in a particular declaration. In fact, Opposer failed to identify any specific declaration or testimony therein it contends is not based on personal knowledge. In view thereof, Opposer’s motion to strike the declarations of Chia-Chi Tsui, Daping Fan, Jian Tang, Min Li, Qi Mo, and Yuejin Li based on the declarant’s lack of personal knowledge is **DENIED**.

With respect to the Fan declaration, Opposer argues that Mr. Fan, Applicant’s President, cannot “authenticate and support exhibits” referenced therein as being “in his files” because he joined Applicant in 2011 and “lacks any personal knowledge of the critical events.” 57 TTABVUE 5. With respect to the Song declaration, Opposer argues similarly that Mr. Song “lacks any personal knowledge of the events in issue” because he joined Applicant in the summer of 2017, after “virtually all of the events in question happened.” *Id.* However, Opposer does not specify where in the 400 pages attached to Applicant’s notice of reliance the referenced exhibits are located, what the exhibits are comprised of, or how the timing of the declarant’s association with

Applicant precludes him from properly authenticating each such exhibit.¹⁷ In view of the foregoing, Opposer's motion to strike the Fan and Song declarations based on the declarant's lack of personal knowledge is **DENIED** without prejudice to Opposer's ability to renew its objections in its trial brief to the extent warranted. *See, e.g., Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007).¹⁸

E. Untranslated Documents

Opposer objects to Exhibits 24, 27-31, 39, and 42-43 on the basis that they are written in Chinese and Applicant failed to provide a translation thereof. 57 TTABVUE 4.

In response, Applicant argues Exhibit 39 is an email that was sent in English "which was distributed to members together with its Chinese version," 58 TTABVUE 11, and that it provided a translation for Exhibit 42. *Id.* Applicant appears to argue that a translation is not required for the remaining documents because they are "songs and newspaper advertisement which were provided only to show its Chinese characters as Trademarks." *Id.*

¹⁷ Opposer's Exhibit B fails to provide any further support for Opposer's argument inasmuch as it does not specify where in the record the referenced exhibits are located and fails to provide any further specifics as to the nature of the documents therein or manner in which Mr. Song or Mr. Fan's foundation is deficient. Rather, Exhibit B states only that the declarations of Cheng Song and Daping Fan are "not admissible." 57 TTABVUE 20-35.

¹⁸ Notwithstanding the Board's order above, Applicant is again reminded that documents produced by an opposing party during discovery must be properly made of record to be considered at trial. An affidavit or declaration of a party's counsel attesting to receipt of the other parties' documents in response to a request for production of documents is insufficient to make the produced documents of record. *See* TBMP § 704.11 (discussing methods by which a party may properly make of record documents obtained through discovery in response to a request for production of documents).

To the extent Applicant argues a translation is not required in view of the purpose for which the documents are being offered, Applicant is incorrect. *See Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS,"* 95 USPQ2d 1567, 1570 n.3 (TTAB 2010) (if a party intends to rely at trial on business records in a foreign language, it must provide a translation); *Hard Rock Cafe Licensing Corp. v. Elsea,* 48 USPQ2d 1400, 1405 (TTAB 1998) (printed publications in a language other than English found to be unintelligible and therefore lacking in foundation and inadmissible). Similarly, to the extent Applicant seeks to rely on the Chinese version of the email in Exhibit 39, a translation is required. *See id.* Accordingly, Opposer's motion to strike Exhibits 24, 27-31, 39, 42-43 on the basis that a translation was not provided is **GRANTED** as to Exhibits 24, 27-31, the "Chinese version" of the email in Exhibit 39, and Exhibit 43.

Inasmuch as Applicant submitted a translation and certification thereof for Exhibit 42 which states "the above translation [] is a complete (except the last paragraph) and accurate English translation," 56 TTABVUE 93, Opposer's motion to strike Exhibit 42 based on the absence of a translation is **DENIED**. The extent to which the Board will consider the document in view of the incomplete translation will be determined at final decision.

However, the Board finds the failure to provide a translation for Exhibits 24, 27-31, 39, and 43 is a procedural defect that can be cured. *Cf. Moke Am. LLC v. Moke USA, LLC,* 2020 USPQ2d 10400 *14 (TTAB 2020) (failure to lay proper foundation constituted a procedural defect). Accordingly, to the extent Exhibits 24, 27-31, 39, and

43 may be properly resubmitted in accordance with the Board's rules and Section II(A)(2) *supra*, Applicant is allowed **TEN (10) DAYS** to submit a translation thereof with each such exhibit.

F. Incomplete Exhibits

Opposer argues in its brief that “many of the exhibits [] are incomplete or mixtures of documents, and thus no [sic] authentic or otherwise admissible,” 57 TTABVUE 9, without specifying which of the exhibits are subject to the objection. In its attached Exhibit B, Opposer objects to Exhibits 5, 9-12, 39-41 on the basis they are missing portions or amendments. However, Opposer again failed to state where in the 400 pages attached to Applicant's notice of reliance each such exhibit is located, and for certain exhibits, failed to state specifically what is missing from the exhibit. *See, e.g., id.* at 21 (stating only that Exhibit 5 is missing “the attachments said to be included.”).¹⁹ In view of the foregoing, to the extent Opposer seeks to strike Applicant's exhibits on the basis they are incomplete, the motion is **DENIED**.

G. Substantive Objections Are Deferred

To the extent Opposer argues the 12 testimony declarations should be stricken because they were drafted by someone other than the declarant, 57 TTABVUE 5, the argument is pure speculation. At most, the argument goes to the probative value to

¹⁹ The Board notes the document set forth at Exhibit 5, 55 TTABVUE 69-73 (Opposer's motion to amend), did not include an exhibit when originally filed with the Board. *See* 8 TTABVUE. Further, to the extent Opposer seeks to strike its Interrogatory responses submitted by Applicant on the basis that it served amended responses, Opposer's recourse is to submit its amended responses during its rebuttal period, to the extent such submission would comply with Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5).

be afforded the testimony declarations, which the Board considers at final hearing. *See* TBMP § 707.03(c)(2).

To the extent Opposer seeks to strike any of the testimony declarations on the basis the testimony is conclusory, 57 TTABVUE 5, or attorney argument, *id.* at 18, such a determination necessarily requires a review of the substance of the witnesses' declarations. Accordingly, Opposer's motion to strike the remaining testimony declarations on the substantive basis they are conclusory or attorney argument is **DEFERRED** until final decision. *See Weyerhaeuser Co.*, 24 USPQ2d at 1233 ("The Board does not read testimony and consider substantive objections to evidence."); *M-Tek Inc. v. CVP Sys Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (Board will not rule on objections pertaining to admissibility prior to final decision).

Similarly, to the extent Opposer seeks to strike any of Applicant's trial exhibits on the basis they are conclusory, attorney argument, or hearsay, 57 TTABVUE 9, such objections are substantive. Accordingly, to the extent the exhibits are properly resubmitted by Applicant, the objections are also **DEFERRED** until final decision.

To the extent Opposer seeks to strike Exhibits 14, 17, 20 and 43 based on its contention that Applicant may not assert at trial a date of first use prior to that set forth in the involved Application absent a motion to amend the involved Application, 57 TTABVUE 4-5, the objection goes to the relevance of the documents and accordingly is **DEFERRED** until final decision.

To the extent Opposer wishes to maintain any of these substantive objections, it must renew the objections in its trial brief. *See, e.g., Wet Seal Inc.*, 82 USPQ2d at 1632.

III. Summary; Trial Dates Reset

Opposer's motion to strike is **GRANTED in part** to the extent that: (i) Applicant's notice of reliance and attached exhibits are **stricken** as deficient as to form; (ii) the testimony declarations of Mann May, Yanping Guo, Jianjun Liu, and Yabin Lei are **stricken**; and (iii) untranslated Exhibits 24, 27-31, the untranslated portion of Exhibit 39, and Exhibit 43 are **stricken**. Opposer's substantive objections to Applicant's evidence as conclusory, attorney argument, or hearsay are **deferred** until trial. Opposer should renew these substantive objections in its trial brief on the case to the extent warranted. *See* TBMP §§ 532, 707.02(c). Opposer's motion to strike is otherwise **DENIED**.

Applicant is allowed **TEN (10) DAYS** from the date of this order to resubmit its notice of reliance and exhibits, including translations of Exhibits 24, 27-31, 39, and 43,²⁰ in accordance with the Board's rules and the requirements set forth in Section II(A) and (E) supra, failing which the evidence will remain stricken.

²⁰ Exhibit 43 may only be refiled to the extent it was previously authenticated by a witness whose testimony has not been stricken, or it may be submitted by notice of reliance pursuant to Trademark Rule 2.122(e)(2) if obtained from the Internet during Applicant's testimony period and Applicant is able to set forth in the body of the resubmitted notice of reliance: (i) the date of access during its testimony period; and (ii) the source (URL) at which it was accessed during its testimony period. Applicant is reminded that Internet materials are of limited probative value inasmuch as they can only be used to demonstrate what the document(s) show on their face. *See, e.g., Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *2 (TTAB 2020) (Internet printouts and other materials properly

Inasmuch as Applicant's trial evidence was filed the day before its testimony period closed, 47 TTABVUE 8, Opposer is allowed **TWENTY (20) DAYS** from the date of this order in which to notify Applicant and the Board as to whether it elects to take oral cross-examination of any of Applicant's witnesses, in which case the Board may further suspend proceedings to allow for completion of the oral cross-examination.

Finally, in view of the inordinate number of motions filed in this case, pursuant to its inherent authority to manage the cases on its docket, the Board prohibits the parties from filing any further unconsented motions without first obtaining permission from the assigned interlocutory attorney. *See Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) ("Board possesses the inherent authority to control the disposition of cases on its docket").

Proceedings otherwise remain **SUSPENDED**. Absent notification by Opposer that it has elected to take oral cross-examination of any of Applicant's remaining witnesses in accordance with the Board's order supra, this proceeding will automatically resume **on March 14, 2022**, without further notice from the Board, upon the schedule set forth below.

Plaintiff's Rebuttal Disclosures Due	3/28/2022
Plaintiff's 15-day Rebuttal Period Ends	4/27/2022
Plaintiff's Opening Brief Due	6/26/2022
Defendant's Brief Due	7/26/2022

introduced under a notice of reliance without supporting testimony considered only for what they show on their face rather than for the truth of the matters asserted); TBMP § 704.08(b).

Plaintiff's Reply Brief Due	8/10/2022
Request for Oral Hearing (optional) Due	8/20/2022

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, 37 C.F.R. §§ 2.121-2.125. 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), 37 C.F.R. §§ 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), 37 C.F.R. § 2.129(a).