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

Proceeding no.	91238706
Party	Plaintiff Xiang Yin He Chang Tuan Inc.
Correspondence address	H DANY KAO KAO & ASSOCIATES PC 38-08 UNION STREET SUITE 12E FLUSHING, NY 11354 UNITED STATES Primary email: dkao@kaolawus.com Secondary email(s): drhoads@rhoadslegal.com 516-305-3717
Submission	Appeal or Cross-Appeal of Final Board Decision
Notice of appeal to	U.S. Court of Appeals for the Federal Circuit
Certificate of service	The undersigned hereby certifies that a copy of this submission has been served upon all parties, at their address of record by Email on this date.
Filer's name	H Danny Kao
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Signature	/H Danny Kao/
Date	04/24/2023
Attachments	230424 - Notice of Appeal final - Appeal of TTAB Decision to Federal Circuit_Attachment1.pdf(538326 bytes)

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

Xiang Yin He Chang Tuan Inc.
Appellant,
v.
Edison Chinese Chorus Inc.
AKA Xiang Yin Chorus
Appellee.

NOTICE OF APPEAL
TTAB Opposition No. 91238706

**NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT**

Xiang Yin He Chang Tuan Inc., (Opposer in Opposition No. 91238706) hereby serve notice of its appeal to the Court of Appeals for the Federal Circuit from the decision of the Trademark Trial and Appeal Board dated February 21, 2023. A true and correct copy of the decision in the above-named opposition proceeding is attached hereto.

Respectfully submitted,

/H. Danny Kao/
H. Danny Kao, PhD, Esq.
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Attorney for Appellant

Dated: April 24, 2023

Certificate of Service

I hereby certify that on this 24th day of April, 2023, I caused a true copy of the foregoing Notice of Appeal to be served by USPS Express mail as follows:

Upon counsel for Edison Chinese Chorus by email and express mail:
Cheng Q. Song, PhD, Esq. chengqsong@gmail.com

Song Law Firm
1 Windy Hill Road
Green Brook, NJ 08812

Upon the U.S. Patent and Trademark Office, by express mail, with a copy to the Trademark Trial and Appeal Board, via ESTTA:

Director of the United States Patent & Trademark Office
Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

/H. Danny Kao/
H. Danny Kao, PhD, Esq.

Certificate of Mailing

I hereby certify that this Notice of Appeal is being deposited with the U.S. Postal Service as Express Mail in an envelope addressed to:

Director of the United States Patent & Trademark Office
Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

/H. Danny Kao/
H. Danny Kao, PhD, Esq.
Attorney for Appellant
Xiang Yin He Chang Tuan Inc.,

April 24, 2023

This Opinion is not a
Precedent of the TTAB

Mailed: February 21, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Xiang Yin He Chang Tuan Inc.

v.

*Edison Chinese Chorus Inc.,
AKA Xiang Yin Chorus¹*

Opposition No. 91238706

H. Danny Kao, of Kao & Associates, PC,
for Xiang Yin He Chang Tuan Inc.

Cheng Q. Song, Esq.,
for Edison Chinese Chorus Inc.

Before Zervas, Dunn and Hudis,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Edison Chinese Chorus Inc. (“Applicant”) seeks to register the following two marks on the Principal Register:

¹ Applicant is identified as a “non-profit corporation” of New Jersey composed of Da Ping Fan, Ya Bin Lei, and Yu Liu. We assume that each individual listed as composing the Applicant has a position equivalent to corporate officer. Application Serial No. 87538374, involved herein, states that Edison Chinese Chorus Inc., is “AKA” as “Xiang Yin He Chang Tuan.”

(1)

乡音合唱团

for
“entertainment services in the nature of live vocal performances by [a] chorus” in International Class 41;² and

(2)

鄉立合唱團

for “entertainment services in the nature of live vocal performances,” also in International Class 41.³

Notwithstanding the differences in the first and last characters, each trademark application states that the applied-for mark consists of the five Chinese characters that transliterate to “Xiang Yin He Chang Tuan” which in English means “chorus of homeland voices.” Color is not claimed as a feature of either mark. We refer collectively to the above two marks as “the Marks.”

Xiang Yin He Chang Tuan Inc. (“Opposer”), a non-profit organization of New Jersey,⁴ opposes registration of the Marks, alleging in its third amended Notice of

² Application Serial No. 87566170, filed August 11, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use and first use in commerce on October 2, 2004.

³ Application Serial No. 87538374, filed July 21, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use and first use in commerce on October 2, 2004.

⁴ 1 TTABVUE 1.

Citations to the record or briefs in this opinion include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE”

Opposition, (i) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its prior common law use of the same marks for the same services; (ii) Applicant's non-ownership of the applied-for marks under Trademark Act Section 1(a), 15 U.S.C. § 1051(a); (iii) misrepresentation of source under Trademark Act Section 14(3), 15 U.S.C. § 1064(3); and (iv) fraud.⁵

In its brief, Opposer raises claims of abandonment of the mark which is the subject of application Serial No. 87566170 and mere descriptiveness, two claims which do not appear in its third amended Notice of Opposition. Applicant does not object to the fact that these claims were not pleaded and in fact, discusses them in its brief. We therefore find that the parties have tried Opposer's claims of abandonment and mere descriptiveness in addition to the claims set forth in the third amended Notice of Opposition. *See* Fed. R. Civ. P. 15(b)(2); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 314 (2022).

Applicant, in its answer, denied the salient allegations of the third amended Notice of Opposition and asserted as affirmative defenses estoppel, fraud and abandonment due to nonuse from 2001 to 2017.⁶ Because Applicant did not discuss

corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry.

⁵ 20 TTABVUE.

⁶ 26 TTABVUE. Applicant also raised the purported affirmative defense of failure to state a claim upon which relief can be granted. *Id.* The Board has stated on several occasions, this is not a true affirmative defense. *See, e.g., John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) ("The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim.").

the affirmative defenses of estoppel, fraud and abandonment in its trial brief, Applicant has forfeited them and we do not further discuss them. *See Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (affirmative defenses deemed waived where no mention of them in trial brief); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 (TTAB 2007) (where applicant did not argue the affirmative defense of equitable estoppel in her brief, the affirmative defense was given no consideration).

With the exception of fraud, Opposer, as plaintiff in this proceeding, must prove its claims by a preponderance of the evidence. *See Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (“The burden of proof rests with the opposer ... to produce sufficient evidence to support the ultimate conclusion of [non-ownership] and likelihood of confusion.”); *Sanyo Watch Co. v. Sanyo Elec. Co.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982) (“As the opposer in this proceeding, appellant bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the burden of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not countered, negates appellee’s right to a registration.”); *see also Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1302 (TTAB 2015) (“It is [Opposer’s] burden as plaintiff in the proceeding to establish prior ownership by a preponderance of the evidence.” (citing *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997)). A claim of fraud, however, must be established with

clear and convincing evidence. *Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d 1361, 1365 (TTAB 2014).

For the reasons set forth below, we deny all of Opposer's claims.

I. Trial Record

In addition to the pleadings, the trial record automatically includes the file history of the involved applications pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

1. Opposer's Submissions

- Opposer's Notice of Reliance (52 TTABVue 1-471) submitting:

Exhibit A – a Chinese poem along with a certified English translation thereof.

Exhibit B – application files for pending application Serial Nos. 87811480 and 87811521, now assigned to Opposer, and listing Quin Tan (alleged creator and alleged former owner of the Marks) as the applicant for the same two marks at issue here.

Exhibit C – a trademark assignment of the opposed marks in Chinese and a certified English translation thereof.

Exhibit D – Quin Tan's February 26, 2018 declaration in Chinese along with a certified English translation thereof.

Exhibit E – a photograph.

Exhibit F – a list of names and phone numbers.

Exhibit G – a list of concert performances.

Exhibit H – printouts of what appears to be webpages, but not containing a URL or a date of access.

Exhibit I – a program brochure.

Exhibits J – M – additional program brochures.

Exhibit N – a document titled "Public Records Filing for New Business Entity for New Jersey."

Exhibit O – a document titled "The Chinese Chorus (Xiang Yin) Bylaws."

- Exhibit P – the April 26, 2020 declaration of Bin Lv⁷ (Applicant’s former creative director and Opposer’s current creative director and President), with exhibits.
- Exhibit Q – A document titled “Expert Report of Bin Lv” dated September 30, 2020, under oath, and exhibits.⁸
- Exhibit R - file wrapper for Applicant’s opposed Application Serial No. 87566170.
- Exhibit S - file wrapper for Applicant’s opposed Application Serial No. 87538374.
- Exhibit T – Opposer’s Fed. R. Civ. P. 30(b)(6) notice of deposition to Applicant.
- Exhibit U – the Fed. R. Civ. P. 30(b)(6) deposition transcript of Applicant’s witness Daping Fan, member of Applicant’s choral group, and President of Applicant from April 2014 to May 2015, and from February 2017 onwards.⁹
- Exhibit V – discovery deposition transcript of Mr. Lv dated October 26, 2020 and exhibits.
- Exhibit W – Opposer’s trial deposition notice for Mr. Wen (Ms. Tan’s husband and former member and officer of Applicant, and member of Opposer), Mr. Lv and Henyi Aixinjeuluo (Mr. Lv’s wife, and “a famous painter”¹⁰).
- Exhibit AA – “Opposer’s First Amendment to Opposer’s Discovery Responses.”

Some of the documents listed above are also deposition exhibits or were also submitted by Applicant.

⁷ Mr. Lv is also known as Mr. Lu, Jian She Lu and Bin Lu. We refer to him as Mr. Lv because the parties do so. Mr. Lv signed “Opposer’s First Amendment to Opposer’s Discovery Responses” as “President.” 52 TTABVUE 420.

⁸ For the most part, Mr. Lv testifies to facts in this document, not opinions. It does contain one opinion, “the best translation and meaning for these trademarks is ‘Chorus of Homeland Voices’ and it is a reference to particular, authentic and high quality Chinese folk songs The trademarks are associated with the particular Chinese folk music that I am an expert in and that I have taught, directed and performed with the chorus groups I have been associated with.” Lv. Expert Rep., 53 TTABVUE 22. Because Mr. Lv’s opinion is not material to our resolution of this case, we treat the “Expert Report” as containing factual testimony.

⁹ Fan Decl. ¶ 3, 54 TTABVUE 10.

¹⁰ Lv Disc. Depo. Exh. V, 52 TTABVUE 383. Ms. Aixinjueluo was President of Opposer in 2017. Aixinjueluo Trial Depo., 53 TTABVUE 272-74 (Exh. Y).

- Trial testimony for Opposer and exhibits (53 TTABVUE 1-566),¹¹ namely:

Exhibit X – Mr. Wen’s January 26, 2021 testimony deposition (53 TTABVUE 2-62) with the same Exhibits A-E, H, I, K-Q and AA, listed above.

Exhibit Y – Ms. Aixinjueluo’s January 26, 2021 testimony deposition (53 TTABVUE 257- 285) with no exhibits.

Exhibit Z – Mr. Lv’s January 26, 2021 testimony deposition (53 TTABVUE 286-334) with the same Exhibits B, C, E, H, P, and V, listed above.

- Opposer’s rebuttal Notice of Reliance (76 TTABVUE 1-299) submitting:

Exhibit AA, Opposer’s First Amendment to Opposer Discovery Responses.

Exhibit AB - Applicant Reply to Opposer’s First Set of Request for Documents.

Exhibit AC - Applicant Reply to Opposer’s Second Set of Request for Documents.

Exhibit AD – Applicant’s reply to Opposer correspondence regarding its document requests.

Exhibit AE - Applicant Reply to Third Set of Request for Documents.

Exhibit AF - Applicant Reply to Opposer’s First Set of Interrogatories.

The March 25, 2022 cross-examinations of Applicant’s witnesses who are chorus members and who provided declarations, namely,

- Exhibit AG - Chia-Chi Tsui (76 TTABVUE 75-95; 77 TTABVUE 2-22) and exhibits.
- Exhibit AH - Daping Fan (76 TTABVUE 100-134; 77 TTABVUE 27-61) and exhibits.
- Exhibit AI - Jian Tang (76 TTABVUE 141-161; 77 TTABVUE 68-88) and exhibits.
- Exhibit AJ - Yu Liu (76 TTABVUE 167-209; 77 TTABVUE 94-136) and exhibits.
- Exhibit AK - Min Li (76 TTABVUE 217-241; 77 TTABVUE 144-168) and exhibits.
- Exhibit AL - Qi Mo (76 TTABVUE 246-266; 77 TTABVUE 173-193) and exhibits.

¹¹ Applicant objected to certain testimony of Opposer’s witnesses, but did not maintain those objections in its brief. An objecting party must renew its objection in its brief or it may be waived. *McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559, *13 (TTAB 2021). We consider the objections to have been waived by Applicant.

- Exhibit AM - Yuejin Li (76 TTABVUE 270-294; 77 TTABVUE 197-221) and exhibits.¹²

Opposer also resubmitted Exhibit C, a copy of the February 26, 2018 Trademark Assignment Agreement, with its rebuttal Notice of Reliance.

We briefly address below some evidentiary and procedural issues with Opposer's evidence.

- i. We give no consideration to Opposer's filings on August 18, 2022 (located at 79-81 TTABVUE and not discussed above) which Opposer submitted (with no explanation) **after** it submitted its Brief and **after** the expiration of Opposer's May 9 – 24, 2022 reply period as set by the Board in its April 9, 2022 Order. *See* Trademark Rule 2.121(a), 35 U.S.C. § 2.121(a) (“No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.”).
- ii. Opposer filed its “Notice of Reliance Regarding Rebuttal Evidence.” (76 TTABVUE) on April 23, 2022, **before** the commencement of Opposer's rebuttal period (*see* April 9, 2022 Order). Despite Opposer's failure to follow Trademark Rule 2.121(a), we have not excluded Opposer's submissions because Applicant has not raised an objection to the rebuttal Notice of Reliance.
- iii. Opposer submitted a “Plaintiff's Notice of Reliance” on January 27, 2021 (at 51 TTABVUE) and a “Plaintiff's Notice of Reliance” on January 28, 2021 at (52

¹² Yuejin Li was President of Applicant from February 3, 2001 to about February 2003. Li Decl. ¶ 3, 54 TTABVUE 37.

TTABVUE). The submissions with each Notice of Reliance appear to be the same. Opposer does not mention the contents of 51 TTABVUE in its appeal brief, and Opposer has not explained why it submitted the Notice of Reliance at 52 TTABVUE. We have considered Opposer's submissions at both 51 and 52 TTABVUE, and refer to the submissions at 52 TTABVUE as the "original Notice of Reliance."

- iv. Opposer submitted trial deposition transcripts of numerous witnesses under a Notice of Reliance. The Trademark Rules do not provide for the submission of trial testimony by Notice of Reliance. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 704.02 (2022). Despite Opposer's non-conforming submission, we have not excluded such transcripts. *See WeaponX Perf. Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037, 1037-38 n.12 (TTAB 2018) (Board denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to a Notice of Reliance).
- v. Opposer submitted "Opposer's First Amendment to Opposer's Discovery Response" (pertaining both to Applicant's requests for admissions and interrogatories) as Exhibit AA to its original Notice of Reliance.¹³ A party may

¹³ Opposer submitted this document – which was verified by Mr. Lv – three times, once during the trial deposition of Mr. Wen, 53 TTABVUE. Mr. Wen's entire testimony regarding Exhibit AA is:

Q. Have you reviewed this Exhibit AA?

MR. SONG: Objection. Lacks personal knowledge.

A. Yes.

Q. Please identify anything that is not correct or which you do not agree with the Exhibit AA?

A. Nothing I disagree. Everything is correct.

not ordinarily rely on its own answers to an adversary's interrogatories. Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5) ("an answer to an interrogatory ... may be submitted and made part of the record only by the receiving or inquiring party."); *see also Beecham Inc. v. Helene Curtis Indus., Inc.*, 189 USPQ 647, 647 (TTAB 1976) (ordinarily a party may not rely upon his own answers to his adversary's interrogatories since said answers would be self-serving in character). Thus, Opposer's submission of Exhibit AA with its original Notice of Reliance was improper.

Trademark Rule 2.120(k)(5), 37 C.F.R. § 120(d)(5), provides, however:

[I]f fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice

Mr. Wen has not authenticated the exhibit as Opposer's verified interrogatory answers (they were verified by Mr. Lv, President of Opposer). Also, Mr. Wen has not testified that he has any familiarity with the preparation or contents of the document. *See Fed. R. Evid. 602* ("A witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter."). His testimony is that he does not disagree with the contents of the document; Mr. Wen did not testify that he was in a position to corroborate the contents of the document. Too often, witnesses are asked during deposition simply to read what is in exhibits, without being asked important questions necessary to establish the foundation for introduction of the exhibit or its probative value, knowledge of the subjects discussed in the exhibit, or even being asked if the exhibit accurately reflects what the witness knows.

Opposer again submitted “Opposer’s First Amendment to Opposer’s Discovery Response” with its rebuttal Notice of Reliance, stating,

Applicant submitted as evidence Opposer’s earlier and unamended discovery responses, which creates an incomplete and misleading record. Permitting and considering these amended discovery responses presents the complete record and Opposer’s actual positions after discovery.¹⁴

We thus consider “Opposer’s First Amendment to Opposer’s Discovery Response” submitted with the rebuttal Notice of Reliance and the identical copy which Opposer submitted with its original Notice of Reliance.¹⁵

- vi. Opposer submitted the following testimony, which was taken **prior** to the scheduled trial periods, with its original Notice of Reliance; (i) Mr. Lv’s

¹⁴ 76 TTABVUE 9.

¹⁵ A party’s submission of its own interrogatory responses may have limited probative value. *See e.g., Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1151 (TTAB 2016) (citing Charles A. Wright, Arthur R. Miller et al., 8B FED. PRAC. & PROC. CIV. § 2180 (3d ed.) (“Older cases said that a party could not ordinarily introduce his or her own answers to an opponent’s interrogatories, since they would be self-serving statements. ... But a more correct explanation would be that a party’s own statements are hearsay when offered by the party to prove the truth of the matter asserted, and that they fall within no recognized hearsay exception.”)); *Fidelity & Deposit Co. of Md. v. Hudson United Bank*, 653 F.2d 766, 777 (3rd Cir. 1981) (trier of fact has discretion as to weight to give to an interrogatory response). Applicant’s interrogatory responses, offered on its own behalf, are not equivalent to oral testimony, and therefore are not conclusive on the question of priority. *Tzu Wei Chen Food Co., Ltd., v. Chia-chi Ents., Inc.*, 73 F.3d 379, 38 USPQ2d 1932, 1935-37 (Fed. Cir. 1995) (table decision) (finding evidence insufficient to establish priority, noting lack of direct evidence and that interrogatory responses are not treated as conclusive admissions but evidential admissions by the courts, which entitles them to less than conclusive weight to support an inference of prior use).

Because Applicant relies on Opposer’s unamended interrogatory responses and requests for admissions, Opposer submitted “Opposer’s First Amendment to Opposer’s Discovery Response” after Applicant’s submission, and Applicant has not raised any objection to “Opposer’s First Amendment to Opposer’s Discovery Responses,” we do not consider Opposer’s responses as hearsay but rather for the truth of any assertions made therein.

April 26, 2020 declaration;¹⁶ (ii) Ms. Tan's February 26, 2018 declaration;¹⁷ (iii) Mr. Lv's September 30, 2020 discovery deposition;¹⁸ and (iv) Mr. Lv's October 26, 2020 discovery deposition.¹⁹ Despite not being in conformance with Trademark Rules 2.121(a) and 2.122 regarding the taking and submission of testimony, we consider their testimony because they were also submitted as exhibits to Messrs. Wen and Lv's trial testimony depositions,²⁰ and Applicant also submitted,²¹ and references in its brief, Ms. Tan's declaration.²² *Cf. Of*

¹⁶ 53 TTABVUE 195-216; 52 TTABVUE 166-172; 52 TTABVUE 442-447.

¹⁷ 52 TTABVUE 371-451.

¹⁸ 53 TTABVUE 217-240; 52 TTABVUE 188-196.

¹⁹ 53 TTABVUE 443-500; 52 TTABVUE 371-428.

²⁰ Mr. Lv's testimony regarding Exh V to his trial deposition, which is Mr. Lv's discovery deposition transcript, and which Opposer also submitted with its initial Notice of Reliance as Exh. V, is as follows:

Q. I want you to go to Exhibit V like Victor?
A. Yes, I found it.
Q. On the first page, did you see your name on it?
A. My name in English; right?
Q. That's correct?
A. Let me look for it. I don't see my name on it.
Q. Can you see the first page in the middle on the right side?
A. Yes, I can see that.
Q. Do you know what is this document?
A. I don't know. This document is in English, I don't understand.

53 TTABVUE 301-02. This transcript, as an exhibit to Mr. Lv's trial deposition, has virtually no probative value in view of Mr. Lv's failure to authenticate it and the lack of foundation for the transcript. Because Applicant has not objected to it, "we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations." *Spotify AB v. U.S. Software Inc.*, 2022 USPQ2d 37, at *6 (TTAB 2022) (quoting *Hunt Control Sys. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011)).

²¹ 66 TTABVUE 26.

²² 83 TTABVUE 6.

Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (overruling objection to premature taking of trial testimony because objection was not seasonably made),

2. Applicant's submissions

- Testimonial declarations of the following individuals who are chorus members, all with exhibits listed separately below:²³

- a. Cheng Song (54 TTABVUE);²⁴
- b. Chia-Chi Tsui (54 TTABVUE 7-9);
- c. Daping Fan (54 TTABVUE 10-14);
- d. Jian Tang (54 TTABVUE 15-18);
- e. Min Li (54 TTABVUE 24-26);
- f. Qi Mo (54 TTABVUE 27-29);
- g. Yu Liu (54 TTABVUE 34-36); and
- h. Yuejin Li (54 TTABVUE 37-40).

- Applicant's Substitute Notice of Reliance (65 TTABVUE) filed in accordance with the Board's February 20, 2022 Order (63 TTABVUE), submitting Applicant's Exhibit Nos. 10, 11, 12, 14, 38 and 43. (Applicant's Exhibit No. 10 is "Opposer's Replies to Applicant's First Set of Interrogatories to Opposer,"

²³ In its February 20, 2022 Order, the Board struck the testimony declarations of Applicant's witnesses named Jianjun Liu, Mann May, Yanping Guo and Yabin Lei. 63 TTABVUE 14.

²⁴ Mr. Song, who is also Applicant's attorney, submitted Opposer's pleadings with his declaration. See 55 TTABVUE 83-91. The pleadings need not have been submitted because they are automatically of record. *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at*2 (TTAB 2020).

Exhibit No. 11 is “Opposer’s Replies to Applicant’s Third Set of Requests for Admissions,” and Exhibit No. 12 is “Opposer’s Replies to Applicant’s Fourth Set of Requests for Admissions.”).

- Applicant’s Trial Exhibits, namely, Applicant’s translated Trial Exhibit Nos. 24, 27-31 and 43 (64 TTABVUE 1-45); exhibits to the Cheng Song declaration, Applicant Trial Exhibit Nos. 1-14, 41 and 44 (66 TTABVUE 1-184); exhibits to the Daping Fan declaration, Applicant Trial Exhibit Nos. 15-34 (67 TTABVUE 1-120); exhibits to the Jian Tang declaration, Applicant Trial Exhibit Nos. 35, 36, 42 (68 TTABVUE 1-56); exhibit to the Min Li declaration, Applicant Trial Exhibit No. 37 (69 TTABVUE 1-9); exhibits to the Yu Liu declaration, Applicant Trial Exhibit Nos. 38 and 39 (70 TTABVUE 1-45); exhibits to the Yuejin Li declaration, Applicant Trial Exhibit Nos. 15-21 and 41 (71 TTABVUE 1-66); and “Opposer’s Notice That It Has Elected To Take Oral Cross-Examination of Seven of Applicant’s Declarants” (72 TTABVUE 1-3).²⁵

II. Opposer’s Evidentiary Objections

Opposer’s evidentiary objections fall into two groups – objections to Applicant’s exhibits and objections to Applicant’s declarations. Applicant did not respond to Opposer’s objections.

Turning first to Opposer’s objections to Applicant’s exhibits, Opposer maintains it requested various documents from Applicant during the discovery period, and

²⁵ Other submissions by Applicant were stricken by the Board in its February 20, 2022 Order. 63 TTABVUE.

Applicant never produced them, but Applicant revealed it had such exhibits when it submitted them with its Notice of Reliance. Opposer included Applicant's responses to its document requests with its rebuttal Notice of Reliance, which included Opposer's discovery requests.²⁶ What Opposer seeks is essentially an estoppel sanction concerning those exhibits.

Because Applicant did not respond to Opposer's objections, or contest Opposer's assertion that it sought such documents, we grant Opposer's motion to exclude the exhibits that are the subject of its motion. Applicant's Exhibit Nos. 14-19, 21-36, 38,²⁷ 42 and 43 are thus stricken.

Next, with regard to Opposer's objections to the testimony of Applicant's witnesses, namely Chia-Chi Tsui, Daping Fan, Jian Tang, Min Li, Qui Mo, Yu Liu,

²⁶ 76 TTABVUE 27-70.

²⁷ Exhibit 38 is the February 24, 2017 sworn "Certification of Jian She L[v]." The Certification was submitted in a civil action initiated by Mr. Lv and his spouse Ms. Alxinjueluo against Applicant's former president, Yu Liu, and "John and Jane Does" in the Chancery Division of the Superior Court of New Jersey, Middlesex County, filed on February 24, 2017. 70 TTABVUE 4-20. Trademark Rule 2.122(f), 37 C.F.R. § 2.122(f), provides:

By order of the Trademark Trial and Appeal Board, on motion, testimony taken in ... a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

The Board has construed the term "testimony" as used in Trademark Rule 2.122(f) as meaning only trial testimony (i.e. an oral testimony deposition or testimony affidavit or declaration) or a discovery deposition that was used, by agreement of the parties, as trial testimony in the other proceeding. *See Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1035 n.8 (TTAB 2010); TBMP § 530. For these reasons, even if Applicant had contested Opposer's motion to strike, it is unlikely that we would have considered Exhibit 38.

Yuejin Li, such objections go to the weight of the testimony rather than the admissibility of the declarations themselves. We therefore deny Opposer's objections to the testimony of Applicant's witnesses and give each witness' testimony the probative value it merits, mindful of Opposer's objections thereto. *See Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) ("Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this case, including any inherent limitations, which precludes the need to strike the challenged testimony and evidence if the objection is well-taken."); *Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1793 (TTAB 2009) ("[t]o the extent an objection has not been specifically addressed above, we have considered the evidence, keeping in mind the objections, and have accorded the testimony and evidence whatever probative value they merit.").

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as "standing" by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in

damage proximately caused by the registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022); *Corcamore*, 2020 USPQ2d 11277, at *4; *see also Empresa Cubana*, 111 USPQ2d at 1062.

The burden rests on Opposer to establish its statutory entitlement to oppose and to prove its claim by a preponderance of the evidence. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *see also B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015) (“The party opposing registration bears the burden of proof, see [Trademark Rule] § 2.116(b) [15 U.S.C. § 2.116(b)], and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b)”).

Opposer pleaded that it uses the marks “to designate aspects of the services provided by its Chinese choral group”; and that it has been assigned the marks and applications for the marks.²⁸

Opposer’s entitlement is established through use of the two opposed marks for choral services as demonstrated by the testimony of Messrs. Wen and Lv, who testify that Opposer has been using the Marks in connection with choral services.²⁹ *See, e.g.,*

²⁸ 20 TTABVUE 3.

²⁹ *See* (i) Wen Test. Depo., 53 TTABVUE 9-10 (Q. Does your current chorus group, Xiang Yin, use any trademark to describe the type of music performance? A. One using simplified Chinese, the second one is in traditional Chinese Xiang Yin Chorus group.); (ii) Lv Test. Depo., 53 TTABVUE 300 (“So are you continuing using Xiang Yin Se Chen Tuan [sic] name since 2017? A. Yes.”); and (iii) Opposer’s verified response to Applicant’s Interrog. No. 17, 65 TTABVUE 12:

Interrog. No. 17: Identify and describe when Opposer started to use “乡音合唱团” as its trademark.

Reply No. 17: Opposer continues using the Trademark since April 2017 to the present. For example, there were at least 15

Double Coin Holdings Ltd. v. Tru Dev., 2019 USPQ2d 377409, at *4 (TTAB 2019) (standing established by testimony, with exhibits, of use of a confusingly similar mark); *Grand Canyon W. Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1502 (TTAB 2008) (standing established by testimony as to prior use of similar mark).

In addition, Opposer's pending trademark applications for the same marks as Applicant's marks have been suspended by the assigned examining attorney pending resolution of Applicant's subject applications.³⁰ Opposer therefore has another reason to believe that it would be damaged by registration of the Marks, and has another basis to pursue this Opposition. *See RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1807-08 (TTAB 2018) ("Opposer's evidence that its pending trademark application has been suspended pending resolution of Applicant's application ... demonstrates that Opposer has a reasonable belief that it would be damaged by registration of Applicant's mark, thus establishing its standing.").

The record establishes that Opposer has a real interest in this proceeding and is not a mere intermeddler.³¹ Applicant does not dispute Opposer's entitlement to a statutory cause of action.

public performances since April 2017 to June 2019 by Opposer using the Trademark. This included a large performance on 3/24/2018 at Princeton Meadow Church Great Auditorium.

³⁰ 52 TTABVUE 30-100, including a USPTO "Confirmation Receipt" of assignment of application Serial Nos. 87811480 and 87811521 from Ms. Tan to Opposer (52 TTABVUE 100).

³¹ "Once [entitlement to a statutory cause of action] is established ..., [O]pposer is entitled to rely on any of the grounds set forth in ... the ... [Trademark] Act which negate [A]pplicant's right to its subject registration." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012).

IV. Background

The parties disagree on a lot and agree on very little. We summarize below each party's version of the events that led to the dispute we must resolve.

Opposer maintains that a single vocal group in Edison, New Jersey, named the Edison Chinese School Vocal Group ("Vocal Group") existed in 1999. Its leaders were Mr. Lv (who was also a teacher) and Mr. Wen. Mr. Wen was one of Mr. Lv's students and was a singer in the Vocal Group. As mentioned, Mr. Wen was, and is, married to Ms. Tan. Opposer describes Ms. Tan as "highly knowledgeable concerning Chinese folk and traditional music," and states that she "actively encourages and promotes the expression of Chinese folk and traditional music ... [and] has particular knowledge, expertise and influence in the expression of traditional Chinese culture."³²

According to Opposer, one of Mr. Lv's students proposed forming a formal chorus in the year 2001.³³ Ms. Tan then – solo (i.e., by herself) – created the Marks to identify the chorus. Mr. Lv and Mr. Wen then asked Ms. Tan whether they could use the marks in connection with the chorus.³⁴ Ms. Tan agreed and granted an oral license to use the Marks.³⁵

³² Opposer's First Amendment To Opposer's Discovery Responses, ¶¶ 4 and 5, 76 TTABVUE 15.

³³ Opposer's Resp. to Applicant's Interrog. No. 1, 55 TTABVUE 115.

³⁴ Wen Depo. 53 TTABVUE 21, 37-38; Lv Trial Depo. 53 TTABVUE 314.

³⁵ According to Mr. Wen, 53 TTABVUE 17-18:

Q. Can you describe the event on February 3rd, in February of 2001, when your wife create[d] the name?

Applicant's version of the facts is grounded in chorus member Tang Jian's testimony, who states that Applicant was established on February 3, 2001 by a group of music lovers.³⁶ On or about February 17, 2001, Applicant's members voted on three out of 11 potential Chinese names for the chorus, listed below:

合唱社 ("Yellow Land Chorus" in English), 2 爱迪生华人合唱团 ("Edison Chinese Chorus"

in English); and 3. 乡音合唱团 ("Xiang Yin Chorus" in English) and as a result, the members

The members selected the third option, 乡音合唱团, the mark of application Serial No. 87566170, as the Chinese name for the chorus.³⁷

About a year later, it was decided that the chorus should be a non-profit corporation. On April 1, 2002, Applicant, a non-profit corporation, "which had no Bylaws, written or otherwise," "was created and was registered as an entity"³⁸ The "Public Records Filing For New Business Entity," are signed by Yuenjin Li as "President," and identifies Yuejin Li, Yuanqi Wen and Qihang Zhang as

A. So at that time there were several performances in the Chinese school. These performances were well received by the audience. They were about Chinese culture and Chinese folk song. So we decided to establish a chorus. By establishing a chorus we needed a name and members suggested many names and finally Ms. Tan came up with that name and everybody agreed.

³⁶ Tang Jian Decl. ¶ 5, 54 TTABVUE 18.

³⁷ Fan Decl. ¶ 7, 54 TTABVUE 11; May Decl. ¶ 5, 54 TTABVUE 21. We construe this to mean that Applicant chose "Xiang Yin Chorus" which is the transliteral version of the Chinese characters displayed by both marks, rather than as meaning that Applicant's members chose the mark of application Serial No. 87566170.

³⁸ Opposer's Resp. to Applicant's Req. for Admission No. 6, 65 TTABVUE 7; Wen Test. Depo. Exh. N, 53 TTABVUE 185.

“management” of the entity.³⁹ “Mr. Wen was listed as one of the three initial Board of Trustees on the corporation formation application on [April 1, 2002] of that entity.”⁴⁰

Many of the members of the Vocal Group joined and formed Applicant on April 1, 2002.⁴¹ Mr. Lv testified he was the artistic director and the music director of Applicant;⁴² both choruses thus had Mr. Lv leading them as their artistic and musical directors.⁴³ Mr. Wen was president of Applicant, the Edison Chinese Chorus Group, from 2010 to 2011.⁴⁴

The chorus was in harmony for about fifteen years and continued singing and performing using the Marks. However, in 2017, relations with Mr. Wen and Mr. Lv hit a sour note, resulting in their departure from the chorus and, eventually, the birth

³⁹ Wen Test. Depo. Exh. N, 53 TTABVUE 185.

⁴⁰ Opposer’s Resp. to Applicant’s Interrog. 1, 65 TTABVUE 9.

⁴¹ Opposer’s First Amendment to Opposer’s Discovery Responses, 76 TTABVUE 19.

⁴² Mr. Lv testified:

Q. You say the vocal group you have to before February 2001 there is a vocal group. Is that what you described?

After February 2001 there was; right?

A. Yes.

Q. Then you say in April of 2002 there is the Edison Chinese Chorus?

A. Yes.

Q. Are you in the Edison Chinese Chorus?

A. Yes, I was in there.

Q. What is your position in that chorus?

A. I was the artistic director and the music director.

Lv Test. Depo., 53 TTABVUE 298.

⁴³ Wen Test. Depo., 53 TTABVUE 26-29, 31-33; Lv Decl., 53 TTABVUE 198-200; Lv. Test. Depo. 53 TTABVUE 298; Aixinjueluo Test. Depo., 53 TTABVUE 264.

⁴⁴ Wen Test. Depo., 53 TTABVUE 46.

of Opposer. Mr. Wen, testifying for Opposer, explained that “[b]ecause after 2017 Edison Chinese Group did not follow the regulations, that is, perform Chinese traditional folk songs, so Mrs. Tan allowed Lv Bin to use the trademark in Xiang Yin Chorus because they continued to follow the regulations.”⁴⁵ Mr. Liu testified for Applicant that “Mr. Jianshe Lu (Bin Lv or Bin Lu) was fire[d] as Applicant’s music director by a membership meeting held on or about February 25, 2017 as a result of his incompetent [sic] and bad temper.”⁴⁶ Not only Mr. Lv and Mr. Wen left Applicant – other members of the chorus also left to form Opposer.⁴⁷ Mr. Lv testified:⁴⁸

Q. When did you leave that group?

A. Should be February of 2017.

Q. So after you leave that group in 2017, did you join another group?

A. I joined Xiang Yin Chorus.

Q. That’s the Opposer in the action; is that right?

A. Correct.

Q. So when do you start using Xiang Yin Se Chen Tuan [sic] after you leave the Edison Chinese Chorus?

A. That was for the last Chinese Edison Chorus I started using Xiang Yin Chorus as performance.

Q. Which year you start using the Xiang Yin Chorus after you leave Edison Chinese Chorus?

⁴⁵ Wen Test. Depo., 53 TTABVUE 22.

⁴⁶ Yu Liu Decl. ¶ 13, 54 TTABVUE 35.

⁴⁷ Lv. Decl. ¶ 18, 53 TTABVUE 426; Opposer’s First Amendment to Opposer’s Discovery Responses, 53 TTABVUE 245.

⁴⁸ Lv Test. Depo., 53 TTABVUE 298.

A. What year? After I left in 2017 I started using it.

Q. So are you continuing using Xiang Yin Se Chen Tuan [sic] name since 2017?

A. Yes.

Opposer was formally incorporated in 2017.⁴⁹ The “Incorporators” were “Jianshe Lu, Heng Li Aixinjueluo and Mo Liu.⁵⁰ The certificate of incorporation identifies April 28, 2017 as the effective date of the entity.⁵¹

Ms. Tan states in her declaration, “In February of 2017, my husband Yuanqi Wen and Mr. Jianshe Lu (Bin Lv) parted way[s] from the chorus and formed a new one. **I allowed them** [to] continue using ‘Xiang Yin He Chang Tuan’ at their new chorus group.”⁵² (emphasis added). Opposer, in its brief, however, puts it differently, stating, “Ms. Tan then **transferred the trademarks** to the Opposer when Mr. Wen and Mr. Bin Lu left the Applicant in 2017.”⁵³ (emphasis added).

⁴⁹ Opposer’s Resp. to Applicant’s Interrog. No. 1, 66 TTABVUE 114; “Certificate of Inc., (Non Profit) Xiang Yin He Chang Tuan Inc.” (65 TTABVUE 26-27). The same names appear under the heading “Signatures” in the Certificate. *Id.* at 70.

⁵⁰ “New Jersey Dept. of the Treasury Division of Revenue and Enterprise Services[,] Certificate of Inc.” 66 TTABVUE 142.

⁵¹ *Id.*

⁵² Tan Decl. at ¶ 4, Wen Test. Depo. Exh. C, 53 TTABVUE 145.

⁵³ Opposer’s brief, 78 TTABVUE 13; *see also* 78 TTABVUE 15, stating, “Ms. Tan used the trademarks continuously and without abandoning them from February 3, 2001 until she transferred them to Opposer on February 26, 2018 by assignment.”

An assignment of the Marks by Ms. Tan to Opposer is in the record.⁵⁴ Opposer claims ownership of both of the Marks based on a written assignment of the Marks from Ms. Tan in February, 2018.⁵⁵

V. Ownership of the Marks

As mentioned, Opposer claims Applicant was not the owner of the marks when it applied for registration of each of the Marks.⁵⁶ Opposer separately alleges a likelihood of confusion under Section 2(d), based primarily on the fact that Opposer, not Applicant, owns the Marks. “With regard to the Section 2(d) claim ... when both parties are relying upon activities the two conducted in concert with one another, each in an attempt to establish prior rights in a mark over the other, the dispute centers on ownership of the mark.” *Wonderbread 5*, 115 USPQ2d at 1301-02; *Nahshin v. Prod. Source Int’l LLC*, 107 USPQ2d 1257, 1258 (TTAB 2013) (“Although the proceeding was brought on the ground of priority/likelihood of confusion, the actual issue in this matter is ownership of the mark NIC-OUT/NIC OUT in the United States, as the cigarette filters that respondent sells under the mark NIC OUT are the same filters that petitioner arranged to have manufactured under the mark NIC-

⁵⁴ Wen Test. Decl. Exh. C, 53 TTABVUE 142-43.

⁵⁵ See Opposer’s Resp. to Applicant’s Interrog. No. 1. (“Ms. Tan created the Trademark and ... assigned it to Opposer in February of 2018.”), 66 TTABVUE 114.

⁵⁶ Specifically, Opposer claims that Applicant was not the owner of the marks 鄉音合唱團 and 乡音合唱团 when its filed its applications on July 21, 2017 and August 11, 2017, respectively.

OUT.”). “It is [Opposer’s] burden as plaintiff in the proceeding to establish prior ownership by a preponderance of the evidence.” *Wonderbread 5*, 115 USPQ2d at 1302.

Under Trademark Act Section 1(a), only the owner of a mark is entitled to apply for federal registration. 15 U.S.C. § 1051(a) (“The owner of a trademark used in commerce may request registration of its trademark.”); *see e.g., Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1335-36 (Fed. Cir. 1988) (application void because Applicant did not own the mark when he filed the use-based application); *In re Wella A.G.*, 787 F.2d 1549, 229 USPQ 274, 277 (Fed. Cir. 1986) (C.J. Nies concurring) (“Under section 1 of the Lanham Act, only the owner of a mark is entitled to apply for registration.”); *Wonderbread 5*, 115 USPQ2d at 1303.

The owner of a mark is the entity that controls the nature and quality of the goods or services sold under the mark. *See Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1421 (TTAB 2016); *In re Wella A.G.*, 229 USPQ at 278-79 (C.J. Nies concurring), “the one entity which controls the nature and quality of the goods sold under the mark is the owner.”). Ownership “must be determined on a case by case basis dependent on the particular facts adduced in each case.” *In re Briggs*, 229 USPQ 76, 77 (TTAB 1986).

As noted at the beginning of this opinion, the Marks have the same transliteration and the same meaning, and appear to be used interchangeably. Applicant’s asserted first use date for each mark is the same, October 2, 2004. Much of the evidence in this proceeding is testimony. Whether in support of Opposer or Applicant, the person testifying does not distinguish between the two marks, but rather refers to them by

name, which, of course, is the same. We therefore follow the parties lead and consider testimony that refers or pertains to “Xiang Yin He Chang Tuan” and “chorus of homeland voices” to refer to both opposed marks.

1. The Parties’ Arguments

Opposer argues “there is no valid dispute that Ms. Tan created the marks and at the time, Mr. Bin Lu was the music director of more than one chorus, and Applicant had yet to be formed”; Ms. Tan, as the owner, “has established quality control over ... the choral performances through Mr. Bin Lu and Mr. Wen and the performance quality and quantity have been relatively steady”; “[t]he Federal Circuit Court of Appeals has construed the statutory requirement of ‘control’ to mean ‘such control as is practicable under all the circumstances of the case’” (citing *Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 906 F.2d 1568, 15 USPQ2d1359, 1363 (Fed. Cir. 1990)); “[s]ufficient control by a licensor may exist despite the absence of any formal arrangements for policing the quality of the goods sold or services rendered under the mark by its licensee(s), ... [and a]n informal, rather than formal, system of quality control may suffice”; and “[t]his holds true especially where the licensor and licensee have a close working relationship, such as a familial relationship.”⁵⁷ Opposer also points out that “the two trademarks were created and first used by another entity that is not Applicant,” and “Applicant had no knowledge

⁵⁷ Opposer’s brief; 78 TTABVUE 29-30.

of where the trademarks came from more than 20 years ago and did nothing to investigate,” referring to Mr. Fan’s testimony (at 52 TTABVUE 308-70).⁵⁸

Opposer’s position is best summed up in its response to Applicant’s Interrogatory 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; and (c) 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 February of 2018, in the form of an assignment. At all times Ms. Tan has exerted control over the Trademark’s [sic] use in terms of quality and as a designation or origin in part through her husband, Mr. Wen, and Mr. Lv, who were leaders of all of the chorus groups of which they were members, including from 2001 to the present.⁵⁹

Turning to Applicant’s arguments, Applicant maintains “[i]t is a made-up story that there was another user of the Trademarks called Edison Chinese School Vocal Class”;⁶⁰ the Vocal Group and Ms. Tan never used the Marks; that Ms. Tan was never an owner, an officer or member of Applicant; and that,

According to the bylaws of Applicant, each member, including its President, has only one vote. Ms. Tan even not a member of Applicant, she did not participate in any decision[-]making process, such as chorus performance programs, etc. Therefore, Ms. Tan did not have a plausible fact to show that she could exercise her control by herself or through her husband on Applicant or its performance

⁵⁸ *Id.*, 26 TTABVUE 31.

⁵⁹ 66 TTABVUE 115.

⁶⁰ Applicant’s brief, 83 TTABVUE 16.

programs during any time period from 2001 to 2017 since Ms. Tan had no vote and Mr. Wen had only one vote while Applicant had at least 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.⁶¹

Even if Ms. Tan had licensed to Mr. Lv, says Applicant, she would have lost her ownership because Mr. Lv was not an authorized representative of Applicant, and Ms. Tan had no control over Applicant or its performance programs in view of Opposer's claim that she never licensed the Marks to Applicant.⁶²

2. Analysis – Ownership Claim

Because Opposer contends that Ms. Tan created the marks in 2001, and owned, licensed, and otherwise granted rights to use the Marks from 2001 until she assigned them to Opposer, we consider (i) whether Ms. Tan created the Marks; (ii) whether Ms. Tan orally licensed the Marks, (iii) to whom she licensed the Marks; and (iv) because a “licensor must control the quality of goods [or services] produced under [or in connection with] the mark by its licensee,” *Sock It To Me, Inc. v. Fan*, 2020 USPQ2d 10611, *4 (TTAB 2020) (citing *Visa, U.S.A., Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371, 216 USPQ 649, 653 (Fed. Cir. 1982)), whether Ms. Tan had the ability to, and actually did, control the quality of the use of the Marks.

⁶¹ *Id.*, 83 TTABVUE 14.

⁶² *Id.*, 83 TTABVUE 17-18.

a. Creation of Marks

Mr. Wen and Mr. Lv, and their spouses, have stated in sworn testimony that Ms. Tan created the Marks and granted an oral license to use the Marks. As discussed above, Mr. Wen and Mr. Lv have prominent roles with Opposer. No other witnesses have testified that Ms. Tan created the Marks or that there was an oral license to use the Marks.

The selection of the Marks, however, appears to have been done casually by those present at the time of the selection. Ms. Aixinjuelou testified:

Q. So you mentioned several names, potential names so the proposer different from Ms. Tan from different people; correct?

A. Correct. Other people proposed.

Q. Anybody who proposed these names put some kind of restriction of use of these names?

A. There were some other names proposed, but many people just disliked those names. At the end people liked the name that Ms. Tan proposed, Xiang Yin.

Q. My question was did anybody put a limitation on the use of these names?

A. I don't know. The name were the proposed, but not used so there was no limitation.⁶³

Applicant's verified Response to Opposer's Interrogatory No. 6, which Opposer submitted, states:

[T]here was a meeting dated on or about February 3, 2001. Applicant invited all to have a brainstorming session to find a suitable Chinese name for the Chorus, and in a membership meeting dated on or about February 17, 2001,

⁶³ Aixinjuelou Trial Test. 53 TTABVUE 270-71.

members proposed over 10 potential names but voted on three potential names: 1. 黄土地合唱团; 2. 爱迪生华人合唱团; and 3. 乡音合唱团. The members voted and selected the third one, 乡音合唱团, as the Chinese name for the Chorus. Ms. Tan did not attend the meeting since she was not a member of the Chorus so that she had no voting right. It was the intention and understanding of contributors in the brainstorming session to suggest a Chinese name to Applicant, Edison Chinese Chorus, for its use in the interstate commerce without any obligation to anyone if his/her “brainchild” was selected by Applicant. Exhibit RI7-3 shows the potential names under consideration at that time.⁶⁴

Also, Mr. Fan stated in his declaration:

I never heard anyone claimed any right to any of the proposed Chinese names for Applicant including the one use in the current trademark in this case before the instant litigation. ... Therefore, the oral license from Ms. Tan to Applicant is totally made-up story months after the filing of the original Notice of Opposition.⁶⁵

⁶⁴ 76 TTABVUE 64.

⁶⁵ Fan Decl. ¶ 6, 54 TTABVUE 10-11. Mr. Fan also stated in his Fed. R. Civ. P. 30(b)(6) deposition, 52 TTABVUE 326-27:

Q. You talked about the ideas of three service marks being created in a meeting. Do you know who came up with the third one that was later adopted?

A. The people not really care about propose that and I think the person propose that, maybe they just confusing. They not really -- they just hope the chorus have the name. So everybody, to my understand, I saw the -- some paper. They say that they have like 11 different name options and then they choose three to vote. The third one is one of them that select by the members in that meeting.

Q. Is your answer you don't know who suggested the third service mark that was at the meeting?

Opposer, the party which bears the burden of persuasion in this proceeding, relies only on the testimony of interested persons associated with Opposer or their spouses, without a scrap of supporting documentary evidence.⁶⁶ Opposer has not offered the testimony of any neutral witness or pointed to any document (other than Ms. Tan's declaration) which suggests that Ms. Tan conceived of the Marks. Applicant has offered testimony disputing Ms. Tan's claim that she was the creator of the marks.

b. Use of Marks by Ms. Tan or Licensee

Assuming Ms. Tan conceived of the marks, there is no evidence that Ms. Tan personally used the Marks. "Mere invention, creation, or discussion of a trademark does not create ... rights." *Hydro-Dynamics Inc. v. George Putnam & Co., Inc.*, 811

A. Yeah, but -- I didn't know. But I heard, I heard say they said that someone, not our members, that they think about -- they propose this, yeah.

Q. But you don't know who that person is, once again?

A. I heard Mr. Bin Lv's wife. She is not the member so probably is the one who proposed the name in the meeting.

Q. But you don't know for a fact?

A. Probably she didn't -- say it again.

Q. Sorry. You don't know for a fact who came up with the name and who proposed it; is that correct?

A. I don't know the fact. It's just hearsay.

⁶⁶ "While it is certainly preferable for a party's testimony to be supported by corroborating documents, the lack of documentary evidence is not fatal." *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011). "[O]ral testimony should be clear, consistent, convincing, and uncontradicted." *Id.* (citations omitted). Applicant's witnesses' testimony contradicts Opposer's witnesses' testimony and renders that testimony unreliable.

F.2d 1470, 1 USPQ2d 1772, 1774 (Fed. Cir. 1987) (quoting J. Gilson, TRADEMARK PROTECTION AND PRACTICE § 3.03), cited in *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 n.4 (TTAB 2014). “[I]t is not the act of inventing a trademark which creates ... rights.” *Reflange Inc. v. R-Con Int’l*, 17 USPQ2d 1125, 1130 (TTAB 1990). “The aphorism ‘No trade, no trademark’ is well established in the law. ... That is, trademark rights are not secured by the mere conception of an idea of using a word, name or design on a product [or service].” *Hamilton Burr Publ’g Co. v. E.W. Communs., Inc.*, 216 USPQ 802, 805 (TTAB 1982), cited in *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, *3, n. 35 (TTAB 2019).

“[T]he right to a particular mark grows out of its use, not its mere adoption ...” *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043-44 (Fed. Cir. 2015) (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97, 39 S. Ct. 48, 63 L. Ed. 141 (1918)). “The fact that a party first conceived the mark and discussed it with others in the organization in anticipation of and in preparation for a subsequent use in trade does not constitute an ‘open’ use and therefore does not establish priority as of the date of these discussions.” *La Maur Inc. v. Int’l Pharm. Corp.*, 199 USPQ 612, 616-17 (TTAB 1978). *See also* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:11 (5th ed. December 2022 update) (“Trademark priority is not granted to the person who was first to conceive of the idea of using a given symbol as a mark.”).

Nonuse by the creator of a mark, however, is not fatal to a claim of ownership – one who conceives of a mark may enter into an oral, controlled license of the mark

without having used the mark. In *Fallon v. Brown Innovation, LLC*, 2022 USPQ2d 606 (TTAB 2021), the Board addressed a claim of common law priority by plaintiff James Fallon, President and CEO of his licensee, Apnea Corporation. Even though Mr. Fallon had not used the mark personally, the Board found that Mr. Fallon had prior common law rights to the involved mark, explaining:

[I]t is recognized that use of a mark by a licensee pursuant to a controlled licensing agreement is a use which may properly inure to a licensor/owner for purposes of trademark registration, even though the licensor may never have used the mark itself [*Pneutek, Inc. v. Scherr*, 211 USPQ 824 (TTAB 1981)]

[*In re Raven Marine*, 217 USPQ 68, 70 (TTAB 1983)]. Further, although the record does not include a written license agreement, Opposer need not produce one to establish that a license between the parties exists because an oral license may suffice. *Id.* (“[I]t is also clear that controlled licensing agreements may be recognized whether oral or written in form”).

Id. at *6; see also *Turner v. HMH Publ’g Co.*, 380 F.2d 224, 154 USPQ 330, 334 (5th Cir. 1967) (“Ownership rights in a trademark or service mark may be acquired and maintained through the use of the mark by a controlled licensee even when the only use of the mark has been made by the licensee.”).

Opposer explains in its “First Amendment to Opposer’s Discovery Responses”:

Ms. Tan granted an oral license for Mr. Wen and Mr. Bin Lv to use the trademarks with the Vocal Group and then, later, with the Applicant when Mr. Wen and Mr. Bin Lv became associated with Applicant when it was formed in 2002. In addition to these three individuals, Ms. Henyi Aixinjueluo was a witness to this license. There are also nonmembers of the chorus who were aware of and can testify to this license, including Ms. Lin Lu, Mr. Rong

Wang, Mr. Ming Zhang, Mr. Yuchi Li, and Mr. Kaixu Yuan.⁶⁷

Opposer did not offer any testimony from Ms. Lin Lu, Mr. Rong Wang, Mr. Ming Zhang, Mr. Yuchi Li or Mr. Kaixu Yuan regarding the grant of an oral license. Other than Ms. Tan's declaration (which is self-serving given her relationship with her husband, Mr. Wen), Opposer did not offer any documentary evidence reflecting an oral license by Ms. Tan.

On cross-examination, Ms. Aixinjueluo stated:

Q. You mentioned several names Zhang Ming and Lin Lu, etcetera.

Is [sic] any of these people readily available to testify on your behalf, on the Opposer's behalf?

A. Some yes, some no. Some of the people are not in the U.S. now.

Q. What kind of testimony they will do? Is that the -- Ms. Tan create that name or we are talking about the license agreement?

A. I mean they knew about it. As you asked me who knew, so I provided some names. I'm not sure if they're willing to testify on that. So actually there were many other people who knew it, but suddenly I cannot think of all the names.

Q. When you say they knew it, knew what? Could you give me the contents of what they knew?

A. They knew that Ms. Tan allows Lv Bin to use the name as long as he is the leader of the performance and they knew that Ms. Tan allows Lv Bin to use the name. Ms. Tan authorized Lv Bin to use the name.⁶⁸

⁶⁷ ¶ 11, 76 TTABVUE 16.

⁶⁸ Aixinjueluo Test. Dep., 53 TTABVUE 270-71.

Applicant offered the testimony of several witness who had been affiliated with Applicant for “a long time” and who testified that they never heard anyone claiming any right to the Marks until after this proceeding commenced. *See, e.g.*, Lian Decl. ¶ 8 (“No one ever claimed any right to any of the recommended Chinese names including the one use as the current trademark in this case from Feb. 2001 to 2017”) and ¶ 15 (54 TTABVUE 38-38); *see also* Tsui Decl. ¶¶ 3 and 6 (54 TTABVUE 7-8); Fan Decl. ¶¶ 5 and 15 (54 TTABVUE 19, 12); Liu Decl. ¶¶ 4 and 7 (54 TTABVUE 19-20); Min Li Decl. ¶¶ 4 and 8 (54 TTABVUE 24-25). Mr. Fan – who was president of Applicant from 2001 - 2006 – stated in his Fed. R. Civ. P. 30(b)(6) deposition:

Q. And isn't it correct you've never seen a license agreement giving the Applicant rights in the two service marks we've been discussing, correct?

A. Yes, I never see that. I think they just try to make up story to oppose our, the trademark application.

Q. And you've never heard of an oral assignment or license of rights in the service marks to Applicant; isn't that correct?

A. No, never heard. When I talk to people in the chorus they are laughing for this. It's just a joke.⁶⁹

We recognize that each of the declarants have an interest in this proceeding, being, or having been, officers or associated with each party for some time, or a spouse of an officer. There is no corroboration by a disinterested party. In addition, there is no documentary evidence reflecting a license, any terms of the alleged license such as

⁶⁹ Fan Depo., 52 TTABVUE 326-27.

its duration or exclusivity, Ms. Tan's participation in any chorus meetings, or any activities undertaken by Ms. Tan in support of the chorus.

c. Identity of Licensee

There is also conflicting evidence as to the identity(ies) of the licensee(s), a critical term in any license. In its interrogatory responses, Opposer states, "Ms. Tan gave her permission, license and otherwise grant to use the Trademark to her husband, Mr. Wen, and Mr. Lv, to lead high-quality chorus performances, in which her husband was the founder and a leader of the chorus group."⁷⁰ This suggests that the alleged license was granted to Mr. Wen and Mr. Lv, not to Applicant.

In its brief, Opposer states that the Marks "were orally licensed to the choral groups that were associated with Mr. Bin Lu and this specific type of choral music."⁷¹ From this argument, it appears that the Marks were licensed only to the choral groups, not Mr. Wen and Mr. Lv.

Opposer's response to Applicant's Interrog. No. 12 further confuses the issue. It states:

Ms. Tan gave her permission, license and otherwise grant to use the Trademark to her husband, Mr. Wen, and Mr. Lv, to lead high-quality chorus performances, in which her husband was the founder and leader of the chorus group. This was, in 2001, to the Edison Chinese School Vocal Group, and in 2002 to the Edison Chinese Chorus Group, until Mr. Lv and Mr. Wen left that group and the group could no longer use the Trademark as a truthful

⁷⁰ Opposer's Resp. to Applicant's Interrog. No. 11, 65 TTABVUE 11.

⁷¹ Opposer's brief, 78 TTABVUE 26. Opposer cites to Wen Trial Test., 53 TTABVUE 15-16, 21-22, 26, 49; Aixinjeulou Trial Test., 53 TTABVUE 262-65, 267-71; and Lv Trial Test., 53 TTABVUE 199-201, 218-23, 315-18, 464,477-80, 48-489.

designation of origin, lacking Mr. Lv and his skills and leadership and the hometown sound.⁷²

This interrogatory response suggests that the alleged license was not only granted to Mr. Wen and Mr. Lv, but also to the entities they were involved with, which includes Applicant and Applicant's predecessor, the Edison Chinese Voice Group.

Ms. Aixinjeulou, Mr. Lv's wife, sings a different tune. After mentioning in her testimony deposition that others knew of the license Ms. Tan allegedly granted, she testified, "[t]hey knew that Ms. Tan allows Lv Bin to use the name as long as he is the leader of the performance and they knew that Ms. Tan allows Lv Bin to use the name. Ms. Tan authorized Lv Bin to use the name."⁷³ Mr. Lv's wife said nothing about a license to Mr. Wen or to Applicant or to the Edison Chinese Voice Group. We understand her testimony to be that her license was granted only to Mr. Lv individually.

Ms. Tan's February 26, 2018 declaration (first submitted with a pre-trial motion) does not shed any light. The four-paragraph declaration states in relevant part:

3. I allowed this "Xiang Yin He Chang Tuan" to be used just for the chorus directed by Mr. Jianshe Lu (Bin Lv) because my husband was also the leader of the chorus.

4. In February of 2017, my husband Yuanqi Wen and Mr. Jianshe Lu (Bin Lv) parted way [sic] from the chorus and formed a new one. I allowed them [to] continue using "Xiang Yin He Chang Tuan" at their new chorus group.⁷⁴

⁷² 65 TTABVUE 11.

⁷³ Aixinjeulou Trial Depo., 53 TTABVUE 272.

⁷⁴ 66 TTABVUE 72. Even though the parties submitted testimony from numerous witnesses at trial, there was no trial testimony from Ms. Tan, a key figure in this matter. Opposer

From the forgoing testimony, we find the evidence to be inconclusive as to the identity of the alleged licensee(s). To be clear, we will not assume the licensee(s) was or were Mr. Lv and/or Mr. Wen because there is no evidence that Ms. Tan informed her alleged licensee that it – or they or he – could not further use the Marks when Messrs. Wen and Lv discontinued working with Applicant. In fact, if Ms. Tan licensed the Marks to Applicant, there is no evidence in the record that she terminated the license when Messrs. Wen and Lv stopped working with Applicant.

d. Control over nature and quality of services

We turn next to the question of whether Ms. Tan controlled the nature and quality of the services offered under the Marks. To avoid abandonment through “naked licensing,” a licensor must “exercise sufficient control to guarantee the quality of the goods [or services] sold to the public under the mark.” *Woodstock’s Enters. Inc. (California) v. Woodstock’s Enters. Inc. (Oregon)*, 43 USPQ2d 1440, 1446 (TTAB 1997), *aff’d*, 152 F.3d 942 (Fed. Cir. 1998) (“The rationale behind quality control is that the public has a right to expect a consistent quality of goods or services associated with a trademark or service mark.”); *see also Taco Cabana Int’l Inc., v. Two Pesos Inc.*, 932 F.2d 1113, 19 USPQ2d 1253, 1259 (5th Cir. 1991), *aff’d*, 505 U.S. 763, 23 USPQ2d 1081 (1993) (“The purpose of the quality-control requirement is to prevent

repurposed Ms. Tan’s declaration which it filed with a motion earlier in this proceeding. *See* 52 TTABVUE 106.

the public deception that would ensue from variant quality standards under the same mark[.]”).⁷⁵

The licensor’s quality control efforts need not be comprehensive or extensive. *Woodstock’s Enters.*, 43 USPQ2d at 1446. Nor do quality control provisions need to be formal or set out in a written agreement. *Id.* at 1446-48 (“It is settled ... that a license may be implied”; finding a license despite no formal, written agreement or formal system of quality control); *Univ. Book Store v. Univ. of Wis. Bd. of Regents*, 33 USPQ2d 1385, 1396 (TTAB 1994) (implied, royalty-free license); *John Anthony, Inc. v. Fashions by John Anthony*, 209 USPQ 517, 525 (TTAB 1980) (oral license); *Winnebago Indus. Inc. v. Oliver & Winston Inc.*, 207 USPQ 335, 341 (TTAB 1980) (informal quality control sufficient). “The Federal Circuit Court of Appeals has construed the statutory requirement of ‘control’ to mean ‘such control as is practicable under all the circumstances of the case.’” *Sock It To Me*, 2020 USPQ2d at *14 (citing *Midwest Plastic Fabricators*, 15 USPQ2d at 1363). “That is a question of fact.” *Sock It To Me*, 2020 USPQ2d at *14 (citing *Midwest Plastic Fabricators*, 15 USPQ2d at 1359).

According to Opposer, “at all times Ms. Tan has exerted control over the Trademark’s use in terms of quality and as a designation or origin in part through her husband, Mr. Wen, and Mr. Lv, who were leaders of all of the chorus groups of

⁷⁵ Any use of a mark by a licensee inures to the benefit of the licensor as the owner of the mark. *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1035 (TTAB 2017) (“It is well-settled that use of a mark by a licensee inures to the benefit of the trademark owner.”).

which they were members, including from 2001 to the present.”⁷⁶ As Opposer explains:

4. Ms. Tan is highly knowledgeable concerning Chinese folk and traditional music. Ms. Tan’s uncle is Shuzhen Tan, who is the deputy dean of the Shanghai Conservatory of Music, and a famous violin player and educator, with a position of high prestige in the Chinese music industry.

5. Ms. Tan actively encourages and promotes the expression of Chinese folk and traditional music and other examples of traditional Chinese culture (e.g., painting, poetry) in various ways. Ms. Tan has particular knowledge, expertise and influence in the expression of traditional Chinese culture.⁷⁷

There are no details, however, about how Ms. Tan gained her knowledge. There is no information about Ms. Tan’s studies and prior work experience in the music field, her membership in any chorus, or any accolades or exposure she received, bearing on her “knowledge, expertise and influence on the expression of traditional Chinese culture.” The fact that Ms. Tan has an uncle who is a deputy dean of the Shanghai Conservatory of Music, and a famous violin player and educator, does not provide Ms. Tan with the knowledge and ability to control the nature and quality of productions offered by a chorus. The lack of information in the record bearing on Ms. Tan’s ability to control the nature and quality of services offered by a chorus stands in stark contrast with the extensive information we have regarding Mr. Lv’s education, experience and awards.⁷⁸

⁷⁶ Opposer’s Resp. to Applicant’s Interrog. No. 1, 66 TTABVUE 115.

⁷⁷ Opposer’s First Amendment to Opposer’s Discovery Responses, ¶¶ 4 and 5, 76 TTABVUE 15.

⁷⁸ See, e.g., Lv “Expert Report” ¶¶ 3 and 4, 53 TTABVUE 218-19.

In addition, the record is extremely thin regarding Ms. Tan’s actual involvement with the Edison Chinese School Vocal Group, Applicant and Opposer. The testimony made of record provides that (i) Ms. Tan “was not an official member of the chorus, but she has been supporting the chorus by serving it”;⁷⁹ (ii) when the chorus was established “Ms. Tan, during each small or big performance she would create the addressing speech and she would support the stage from the back and from the front”;⁸⁰ (iii) “[s]he is also the overseer of the performance”; (iv) “[s]he is responsible for marketing and she is also [Mr. Lv’s] representative”;⁸¹ and (v) “Ms. Tan was very involved with our performances and insured that the content and the quality of our performances that were associated with ‘Xiang Yin He Chang Tuan’ were authentic and of the highest quality.”⁸²

In response to Applicant’s interrogatories, Opposer states:

- “Ms. Tan held no formal position with the Applicant, except as the influential wife of founder Mr. Wen and as the friend and supporter of Mr. Lv, who were the leaders of the choral groups associated with what became Applicant as it is currently comprised”;⁸³
- Ms. Tan was very involved with the Vocal Group, Applicant and Opposer performances and insured that the content and the quality of the performances that were associated with her trademarks and “Xiang Yin He Chang Tuan” were authentic and of the highest quality. She did this in part in each of these choruses through her close relationships with both her husband, Mr. Wen, who was a

⁷⁹ Wen Test. Depo, 53 TTABVUE 32.

⁸⁰ *Id.*, 53 TTABVUE 18.

⁸¹ Lv Test. Depo., 53 TTABVUE 295.

⁸² Lv Decl. ¶ 15, 53 TTABVUE 199.

⁸³ Opposer’s Resp. to Applicant’s Interrog. No. 8, 65 TTABVUE 10.

member of the groups, and through the artistic and musical director of the groups, Mr. Bin Lv.⁸⁴

- “Ms. Tan was involved with and applied the use of the trademarks, which is representative of many other examples, is the March 16, 2013 concert that commemorated the 100th anniversary of the birth of Luobin Wang. Luobin Wang was a famous Chinese songwriter that wrote songs based upon the music of various ethnic minorities in western China, which is pertinent to and consistent with the meaning of the name and the associated trademarks. Mr. Bin Lv worked closely with Ms. Tan on this performance. Ms. Tan was involved with the idea for the performance, selected the form of the performance, and the selection of the songs and the style of the performance. Mr. Bin Lv discussed all of this with Ms. Tan and was in constant communication with her [sic]”;⁸⁵ and

- “[W]hen Mr. Wen and Mr. Bin Lv left the Applicant, Ms. Tan transferred the trademarks to Opposer because Applicant wanted to move in a different direction and no longer had the expertise and the same desire to perform the Chinese folk and traditional songs in the manner that is associated with the trademarks. Only Opposer does that.”⁸⁶

The evidence Opposer relies upon is vague, from interested witnesses, not supported by any documents, and not specific as to particular events over the many years that Applicant used the marks with Messrs. Wen and Lv’s involvement. It consequently fails to establish that Ms. Tan exercised control over Applicant’s use of the Marks. “[S]upporting the chorus by serving it”; “creat[ing] the addressing speech and ... support[ing] the stage from the back and from the front”; being “the overseer

⁸⁴ Opposer’s First Amendment to Opposer’s Discovery Responses ¶¶ 6 and 14, 76 TTABVUE 15 and 17.

⁸⁵ *Id.* at ¶ 15, 76 TTABVUE 17.

⁸⁶ *Id.* at ¶ 16, 76 TTABVUE 17; *see also* Lv Decl. ¶ 25, 53 TTABVUE 223.

of the performance”; and the general statement that Ms. Tan “was very involved with ... performances and insured that the content and the quality of [the] performances ... associated with ‘Xiang Yin He Chang Tuan’ were authentic and of the highest quality,” provides no insight into what Ms. Tan’s contributions were.

While the evidence regarding Ms. Tan’s involvement in marketing and representing the creative director is more enlightening, the record is silent as to the extent of her involvement in such activities. Opposer has not submitted any documentary evidence reflecting any participation by Ms. Tan in the operation of the choruses, or in any chorus meetings or performances. Several of Applicant’s witnesses, who were chorus members, state that Ms. Tan was not involved in the operation of the chorus, and Opposer has conceded that “Mr. Bin L[v] was the musical/artistic director with explicit control.”⁸⁷ The statement, “Ms. Tan held no formal position with the Applicant, except as the influential wife of founder Mr. Wen and as the friend and supporter of Mr. Lv, who were the leaders of the choral groups associated with what became Applicant as it is currently comprised,”⁸⁸ appears to be most accurate – with the exception of Opposer’s characterization of Ms. Tan as “influential.”

Opposer argues that “[s]ufficient control by a licensor may exist despite the absence of any formal arrangements for policing the quality of the goods sold or services rendered under the mark by its licensee(s), ... [and a]n informal, rather than

⁸⁷ Reply Brief, 84 TTABVUE 10.

⁸⁸ Opposer’s Resp. to Applicant’s Interrog. No. 8, 65 TTABVUE 10.

formal, system of quality control may suffice”; and “[t]his holds true especially where the licensor and licensee have a close working relationship, such as a familial relationship.”⁸⁹ Indeed, *Sock It to Me*, 2020 USPQ2d 10611, at *5, cited by Applicant, says as much. *Supra*; see also *Paeteria La Michoacana, Inc v. Products Lacteos Tocumbo S.A. de C.V.*, 188 F. Supp. 3d 22, 93 (D.D.C. 2016) (where the licensees were members of a family, the licensor “satisfied the minimum level of control necessary to avoid abandonment through naked licensing [T]hey regard their business as being part of a family tradition that stretches back generations.”)). See also *Woodstock’s Enters.*, 43 USPQ2d at 1446.

In *Sock It To Me*, the Board addressed a situation where the applicant, an individual residing in China, allegedly did not own the involved mark when she filed her application because the mark was used in the United States by an entity named JY Instyle. The Board stated:

Applicant maintains that “while the Applicant herself did not use the mark in commerce,” she granted a license for the SOCK IT UP mark to JY Instyle, a related company whose use of the mark inures to her benefit. She explains that: she has been in the sock industry in the People’s Republic of China for over a decade; JY Instyle is a family business owned and operated by her son and daughter-in-law, Junxia Yao; JY Instyle’s head of Creative Design, Xochitl Avila, commonly used the phrase “suck it up” while at work; when the idea of using SOCK IT UP as a brand was presented to Applicant, Applicant selected it; due to the familial relationship Applicant shares with JY Instyle, a relationship that involves daily communication between Applicant and Junxia Yao, Applicant granted JY Instyle an oral license to use the SOCK IT UP mark on socks in January 2015; that month, JY Instyle commenced use of

⁸⁹ Opposer’s brief, 78 TTABVUE 29-30.

the mark, which is often displayed prominently in conjunction with the JY Instyle mark.

Id. at *3.

The Board found that an implied license existed and that the applicant/licensor (an individual) was the owner of the mark, stating:

Applicant has established quality control over the source of manufacturing and type of fabrics used to make socks bearing the mark, and her daughter-in-law inspects the goods to ensure that they consistently comply with these standards. Sales have increased steadily over the years, and there is no evidence of a decline in quality. *See Stockpot Inc. v. Stock Pot Rest. Inc.*, 220 USPQ 52, 60-61 (TTAB 1983) (“the gross receipts and income from the restaurant operation showed an increase and there is no evidence whatsoever to indicate that there was any decline in quality.”), *aff’d*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984). These measures are, in our view, sufficient to maintain consistent control over the quality of the goods.

In sum, Applicant, as licensor, has maintained sufficient control over the nature and quality of the goods marketed by her licensee under the mark.

Id. at *6.

In the present case, however, there is no indication that Ms. Tan, Mr. Lv and Mr. Wen were involved in a family business or had an ownership interest in any chorus. Mr. Wen was “an assistant of Mr. Bin Lv”⁹⁰ and “Mr. Bin L[v] was the musical/artistic director with explicit control.”⁹¹ There is no indication that Ms. Tan had any significant experience comparable to that of the successful applicant in *Sock It To Me* (with over a decade in the sock industry). There is no indication as to the frequency

⁹⁰ Wen Test. Depo., 53 TTABVUE 45.

⁹¹ Reply Brief, 84 TTABVUE 10.

of communications between Ms. Tan and others regarding the chorus. Also, Ms. Tan and Mr. Lv, “the musical/artistic director with explicit control,” have no family relationship – Ms. Tan is married to Mr. Wen, not Mr. Lv. In sum, the facts bearing on Ms. Tan’s alleged control do not come near the level of control the applicant had in *Sock It To Me*.

3. Conclusion on Ownership

Even though a licensor’s quality control efforts need not be comprehensive or extensive, *Woodstock’s Enters.*, 43 USPQ2d at 1446, we find on the present record that Opposer has **not** established by a preponderance of the evidence that Ms. Tan was the owner of the Marks and licensed them to Applicant. In addition, Opposer has **not** established on this record that Applicant was **not** the owner of the Marks when Applicant filed its applications for registration of the Marks. In view thereof, we deny Opposer’s claims of non-ownership for failure to meet its requisite burden of proof as against the marks in both application Serial Nos. 87538374 and 87566170.

4. Analysis – Priority Claim⁹²

Where, as here, Opposer does not own a registration and is relying on common law rights in its mark, Opposer must establish by a preponderance of the evidence that it has used the Marks prior to the earliest date on which Applicant may rely for priority purposes.

⁹² Under Section 2(d) of the Trademark Act, a mark may not be registered if it “consists of or comprises a mark ... or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion....”

To establish prior common law rights, Opposer must prove by a preponderance of the evidence that its pleaded marks are distinctive, inherently or otherwise, and that it used the marks prior to Applicant's actual first use or constructive first use dates. *ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V.*, 2022 USPQ2d 887, at *14-15 (TTAB 2022) (citing *DeVivo v. Ortiz*, 2020 USPQ2d 10153 , at *3 (TTAB 2020); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (“[B]ecause unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is Opposer’s burden to demonstrate that it owns a trademark that was used prior to Applicant’s first use or constructive use of its mark and not abandoned.”) (citing *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008)). “In assessing whether Opposer has established priority, we consider the evidence of record as a whole. *ARSA Distributing*, 2022 USPQ2d at *15 (citing *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) ([O]ne should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.”)).⁹³

The record demonstrates Opposer conducted a concert at the Princeton Senior Center on April 30, 2017 under the name “Xiang Yin H Chang Tuan.”⁹⁴ See (i) Mr. Lv’s testimony at ¶ 19 of his declaration:

⁹³ The distinctiveness of the Marks is not in issue. See discussion, *infra*, regarding Opposer’s descriptiveness claim for marks and services identical to those for which Opposer alleges it has priority.

⁹⁴ Lv. Decl. ¶ 19, 53 TTABVUE 200 (“A list of the performances of various chorus groups for which I was the musical and artistic director is attached as Exhibit B to this declaration. Each of the groups used Ms. Tan’s name, “Xiang Yin He Chang Tuan,” and designs using the

A list of the performances of various chorus groups for which I was the musical and artistic director is attached as Exhibit B to this declaration. Each of the groups used Ms. Tan's name, "Xiang Yin He Chang Tuan," and designs using the name, with respect to vocal performances of Chinese folk music of the appropriate content and the highest quality.);⁹⁵ and

(ii) Exhibit B to Mr. Lv's declaration which identifies the following concerts:

2017 (led by Mr. Lv at Opposer)
2017-10-08 Chinese Moon Festival with Camel Group
2017-09-29 Chinese Museum at Princeton NJ
2017-09-28 Circle of Friends Adult Day Care at Springfield NJ
2017-08-20 New Jersey Chinese Festival at Edison NJ
2017-04-30 Princeton Senior Center

Exhibit B also lists performances by Applicant, including a performance on October 2, 2004, the first use in commerce date identified by Applicant in its applications for the Marks, at the Voices from the Homeland at "Nicholas Music Center" (Rutgers University).⁹⁶ Applicant has established October 2, 2004 as its earliest use date.

name, with respect to vocal performances of Chinese folk music of the appropriate content and the highest quality."); Lv. Decl. Exh. B, 53 TTABVUE 209-12; *see also* Applicant's "Response to Board Order/Inquiry," 66 TTABVUE 19-22. We rely on the dates on the list in view of Mr. Lv's testimony quoted above regarding this exhibit, and the fact that both parties introduced the list of performances into the record.

⁹⁵ Lv. Decl. ¶ 19, 53 TTABVUE 200.

⁹⁶ Under Section 7 of the Trademark Act, parties are entitled to rely upon the filing dates of applications underlying their pleaded and subject applications and registrations for purposes of establishing their constructive use dates. 15 U.S.C. § 1057(c); *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840, 1844 (TTAB 1995) (parties may rely on the constructive use (filing) dates for purposes of priority). In this case, Applicant's application filing dates are later than the first use date established by the evidence.

Opposer argues it has prior rights pursuant to an assignment of the marks by Ms. Tan.⁹⁷ There are three problems with this argument. First, as outlined above, Opposer has not persuaded us that Ms. Tan had any rights in the Marks. Second, Opposer maintains (for the first time in its brief) that the Marks are merely descriptive of choral services and has not attempted to show that Applicant has acquired distinctiveness in the Marks which it asserts it owns.⁹⁸ Third, Opposer relies on an assignment document that fails to effect a transfer of ownership rights to a mark.

Opposer relies on an assignment document bearing the date February 28, 2018, which purports to assign the Marks and Ms. Tan's applications for the Marks from Ms. Tan to Opposer. A glaring absence from the document is any mention of a transfer of goodwill. Section 10(a)(1) of the Trademark Act, 15 U.S.C. ¶ 1060(a)(1), states, "[a]

⁹⁷ Opposer's First Amendment to Opposer's Discovery Responses ¶ 12, 76 TTABVUE 17 ("Ms. Tan then transferred the trademarks to the Opposer when Mr. Wen and Mr. Bin Lv left the Applicant in 2017. Opposer is currently the owner of the trademarks via an assignment from Ms. Tan in 2018.").

⁹⁸ See *Otto Roth & Co. v. Univ. Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981) ("[I]t is equally clear that if an opposer's alleged means of trade designation is not distinctive -- does not identify source -- then there is no basis upon which to compare such a thing with the applicant's mark to determine whether confusion as to source is likely").

Under the rule of *Otto Roth*, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d at 1320, 209 USPQ at 43. The *Otto Roth* rule is applicable to trademark registration cancellation proceedings as well.

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990).

registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark.”

To constitute a valid assignment of a trademark, there must be a transfer of the goodwill to which the mark pertains. The rationale behind the required transfer of the goodwill is to ensure that consumers will not be misled from established associations with the mark and that the mark continues to be associated with the same or similar products after the assignment. *See VISA, U.S.A.*, 216 USPQ at 652.

“[I]n some valid mark transfers, [however,] the assignee was already using the mark prior to the transfer; such an assignee had its own goodwill in relation to the mark; therefore, the transfer merely perfected the assignee’s legal rights to the mark.” Louis Altmann and Malla Pollack, 4 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:39 (4th ed.) (citing *J. Atkins Holdings Ltd. v. English Discs., Inc.*, 729 F. Supp. 945, 14 USPQ2d 1301 (S.D. N.Y. 1990), *as amended*, (Feb. 27, 1990) (assignment by foreign manufacturer to U.S. distributor not in gross, because assignee had developed its own goodwill in the mark); and *Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.*, 841 F. Supp. 1339, 33 USPQ2d 1961 (E.D. N.Y. 1994)). Because Opposer does not argue that Opposer established goodwill prior to the date Ms. Tan allegedly assigned the Marks to Opposer, we do not explore that possibility.

In sum, because Opposer did not establish Ms. Tan was an owner of the Marks, or the attempted assignment successfully transferred any rights Ms. Tan had to Opposer, the earliest date that Opposer may rely on for priority purposes is the April 30, 2017 concert date at the Princeton Senior Center. This date is later than the first use date established by Applicant and claimed in its application, i.e., October 2, 2004. Opposer therefore has not established its priority.

5. Conclusion on priority and likelihood of confusion

Because it has not established its priority, Opposer's likelihood of confusion claim must fail, and is denied against both application Serial Nos. 87538374 and 87566170. *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1199 (TTAB 2017) ("Opposer did not establish a date of priority before Applicant's, an essential element of any claim under Trademark Act [Section 2d]. We need not reach the issue of likelihood of confusion because without proof of its priority, Opposer cannot prevail.").

VI. Misrepresentation of Source

"[M]isrepresentation of source is an available ground for opposition ... against a use-based application ... under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a)." *PepsiCo, Inc. v. Arriera Foods LLC*, 2022 USPQ2d 856, at *9 (TTAB 2022). "Misrepresentation of source refers to the blatant misuse of a mark, or conduct amounting to the deliberate passing-off of one's goods [or services] as those of another. That is, such a claim arises where the defendant ... uses a mark in a manner 'to deliberately pass off its goods [or services] as those of the plaintiff.'" *Id.* at *7-8 (citations omitted); *see also Osterreichischer Molkerei-und Kasereiverband Registrierte*

GmbH v. Marks and Spencer Ltd., 203 USPQ 793, 794 (TTAB 1979) (misrepresentation of source claim lies where a “mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used.”).

In order to prevail, [Opposer] must show that [Applicant] took steps to deliberately pass off its goods as those of [Opposer]. That is, [Opposer] must establish “blatant misuse of the mark by [Applicant] in a manner calculated to trade on the goodwill and reputation of [Opposer].” Thus, in reviewing the record, we look for evidence reflecting [Applicant’s] deliberate misrepresentation of the source of its product, “blatant misuse” of the mark, or conduct amounting to the deliberate passing-off of [Applicant’s] goods. Willful use of a confusingly similar mark is insufficient. (citations omitted).

Bayer Consumer Care AG v. Belmora LLC, 110 USPQ2d 1623, 1632 (TTAB 2014), *rev’d on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and remanded* 819 F.3d 697 (4th Cir. 2016), *cert denied*, 137 S. Ct. 1202 (2017), *aff’d on remand*, 338 F. Supp. 3d 1477 (E.D. Va. 2018), *district court decision vacated and remanded*, 2021 USPQ2d 126 (4th Cir. 2021) (Board decision upheld by 4th Circuit), *petition for rehearing en banc filed*, No. 18-2183, 18-2232 (4th Cir. March 2, 2021); *Belmora LLC v. Bayer Consumer Care AG*, 142 S. Ct. 483 (Nov. 15, 2021) (petition for writ of certiorari to the to the United States Court of Appeals for the Fourth Circuit denied).

Opposer’s misrepresentation of source claim as pleaded in its third Notice of Opposition is as follows:

24. Ms. Tan, who created and adopted the marks, permitted them to be used by the Founders, who ended their association with the Applicant’s chorus group. Applicant’s knowledge of the history of the marks

establishes its intentional misrepresentation of the source of the services that originated from the marks.

25. Applicant is using the marks today in order to create the false impression that Applicant's services come from the expertise, mission and high standards of the Opposer (e.g., Applicant lacks Opposer's expert in Chinese folk music) in performing Chinese folk music and expressing traditional Chinese culture.

26. Since their first use by Ms. Tan, Ms. Tan has used the marks continuously and without abandoning them, and now they are being used today by the Opposer, after they were assigned to Opposer by Ms. Tan. The marks have never been abandoned.⁹⁹

Opposer argues that Applicant filed two trademark applications in bad faith; that Applicant's concerts – unlike Opposer's concerts – are “in a different direction, away from traditional and folk Chinese choral music and the meaning that is associated with the two trademarks, is evidence of a lack of good faith and a desire to deceive

⁹⁹ 20 TTABVUE 8-9. The Board's February 14, 2019 Order denying Applicant's motion to dismiss Opposer's Third Amended Notice of Opposition states, “Opposer has alleged specific acts by Applicant in the use of the involved mark that, if proven, would amount to an attempt to create the impression that Opposer is the source of Applicant's services at minimum in paragraphs 24-26 of the third amended notice of opposition.” (citing *McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 USPQ 45, 47 (TTAB 1985). In *PepsiCo, Inc. v. Arriera Foods LLC*, 2022 USPQ2d 856, at *13-14 (TTAB 2022), however, the Board stated,

a plaintiff must plead the following three elements to set forth a viable claim for misrepresentation of source: (1) present use of the challenged mark by the defendant; (2) specific acts or conduct by the defendant that are deliberately aimed at passing off its goods as those of the plaintiff; see *id.*, and (3) the nature of the injury to plaintiff as a result of defendant's deliberate conduct (i.e. damage to reputation or lost sales). (citation omitted).

Opposer's pleading does not satisfy the *PepsiCo* pleading requirements. We do not disturb the Board's statement in the February 4, 2019 Order in view of our disposition of Opposer's claim.

singers and the listening public by Applicant.”¹⁰⁰ Opposer’s argument reflects a misunderstanding of a misrepresentation of source claim. Whether Applicant’s concerts are suitably loyal to traditional and folk Chinese choral music has nothing to do with specific acts or conduct by the Applicant that are deliberately aimed at passing off its services as those of Opposer. In fact, Opposer’s argument that Opposer’s concerts are true to traditional and folk Chinese choral music while Applicant’s concerts are not, suggests that Applicant is **not** deliberately passing-off its services for Opposer’s services. Opposer’s misrepresentation of source claim therefore is denied.

VII. **Fraud**

“Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled.” *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1501 (TTAB 2017) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009)). As mentioned early in this decision, a party alleging fraud in the procurement of a registration bears the heavy burden of proving fraud with clear and convincing evidence. *Nationstar Mortg.*, 112 USPQ2d at 1365. “There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *In re Bose*, 91 USPQ2d at 1939 (quoting

¹⁰⁰ 78 TTABVUE 24.

Smith Int'l, Inc. v. Olin Corp., 209 USPQ 1033, 1044 (TTAB 1981)). To carry this burden, the party alleging fraud must prove that:

- (1) the applicant made a false representation to the USPTO;
- (2) the false representation was material to the registrability of the mark;
- (3) the applicant had knowledge of the falsity of the representation; and
- (4) the applicant made the representation with intent to deceive the USPTO.

See In re Bose, 91 USPQ2d at 1941.

In conjunction with its fraud claim, Opposer initially argues:

Mr. Da Ping Fan, Applicant's President, and Mr. Cheng Q. Song, Applicant's attorney – materially lied to the USPTO in the prosecution of the two trademark registration applications at issue in this opposition proceeding with the intent to deceive the USPTO to grant the registrations. Applicant was aware of Opposer's claims to priority rights to the trademarks and Applicant hid that information from the USPTO. Applicant informed the USPTO of material and false information that there were no such claims.¹⁰¹

Later in its brief, Opposer backs off from its assertion that Messrs. Fan and Song had actual knowledge of Opposer's alleged prior rights because they "both relatively recently joined the chorus,"¹⁰² and argues they should have known of Opposer's alleged prior rights:

Despite being aware of Opposer's claims to the trademarks, Mr. Da Ping Fan and Mr. Cheng Q. Song, who had first come on the scene in 2011 and 2018, respectively, had no actual knowledge of where the trademarks came from and

¹⁰¹ Opposer's brief, 78 TTABVUE 33.

¹⁰² *Id.*, 78 TTABVUE 34.

did nothing to investigate. ... Instead, Applicant's President, Mr. Da Ping Fan, searched the USPTO files to see if Opposer had filed, and when he did not see a filing, instructed Applicant's attorney, Mr. Da Ping Fan to file without a valid basis. ... Mr. Cheng Q. Song followed orders without asking questions, knowing the controversy over the trademark rights.¹⁰³

We find that Opposer has not proved its claim for two reasons. First, Opposer has not established that it has ownership rights to the Marks. Applicant hence did not falsely assert to the USPTO that it owned the Marks in derogation of any of Opposer's rights. Second, Opposer has not established Messrs. Fan and Song had knowledge of ownership rights allegedly held by Opposer. Without such knowledge, they could not have had the requisite intent to deceive the USPTO.

Opposer's claim of fraud is also denied.

VIII. Abandonment of the Mark of Application Serial No. 87566170

Opposer argues:

Discovery demonstrated that Applicant and everyone associated with Applicant stopped using the trademark that is the subject matter of Application No. 87566170, relating to traditional Chinese characters, in 2017, more than three years ago, and Applicant has produced no evidence that it intends to start using the trademark. ...

This abandonment by Applicant is consistent with Applicant's move in a different direction in 2017 to force Mr. Bin Lu and his music out and perform less (or no) traditional and folk Chinese choral music and thereby seek a younger membership and audience.¹⁰⁴

¹⁰³ *Id.*

¹⁰⁴ 78 TTABVUE 35.

We have reviewed the deposition and declaration pages Opposer relies on in support of its abandonment claim, as set forth in its brief.¹⁰⁵ These pages make no reference to discontinuing the use of the mark of application Serial No. 87566170. At best, they allege that Applicant moved away from programs that exclusively feature traditional Chinese songs. Applicant's identified services, however, are not limited to Chinese choral performances. Thus, there is no abandonment so long as Applicant provides "entertainment services in the nature of live vocal performances by [a] chorus" in connection with the mark. In other words, Applicant has not abandoned the use of its mark even if Applicant's performances do not exclusively feature Chinese songs because its identification of services allows for use of the mark in connection with **any** type of choral performances. We therefore deny Opposer's claim (tried with Applicant's consent, as discussed earlier) of abandonment of the mark of application Serial No. 87566170.

IX. Mere Descriptiveness

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits registration of a mark that, when used on or in connection with an applicant's goods or services, is merely descriptive of them. A term is merely descriptive of goods or services if it conveys an immediate idea of a quality, characteristic, feature, function, purpose or use of the goods or services. 15 U.S.C. § 1052; *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103

¹⁰⁵ Opposer relies on the following; Wen Depo., 53 TTABVUE 9, 15-16, 22, 26, 49); Bin Lu Decl., 53 TTABVUE 199-201; Bin Lu Expert Rept., 53 TTABVUE 218-223; Bin Lv Disc. Depo., 53 TTABVUE 488-489; Aixinjeulou Depo., 53 TTABVUE 262-265.

USPQ2d 1753, 1755 (Fed. Cir. 2012) (“[A] mark is merely descriptive if it “conveys information regarding a function, or purpose, or use of the goods [or services].”) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978)). “A mark need not recite each feature of the relevant goods or services in detail to be descriptive, it need only describe a single feature or attribute.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). On the other hand, if a mark requires imagination, thought and perception to ascertain the nature of the goods or services, then the mark is suggestive. *DuoProSS Meditech*, 103 USPQ2d at 1755 (citing *In re Abcor Dev. Corp.*, 200 USPQ at 218).

Whether a term is merely descriptive is determined not in the abstract, but “in relation to the particular goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use.” *In re Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *In re Bayer A.G.*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1090 (Fed. Cir. 2005) (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) (“Whether a mark is merely descriptive or not is ‘determined from the viewpoint of the relevant purchasing public.’”)). The question is whether someone who knows the goods or services will understand the term to convey information about them. *DuoProSS Meditech*, 103 USPQ2d at 1757.

As set forth above, in both applications, Applicant states that the English translation of the Chinese characters is “chorus of homeland voices.” In its brief, Opposer maintains that the Marks are merely descriptive because:

During the deposition of Mr. Fan, Applicant’s President and Rule 30(b)(6) witness, Mr. Fan effectively admitted that the two trademarks were merely used by Applicant to describe a chorus of Chinese singers that sing any type of song. Applicant’s use of the two trademarks has none of the depth of meaning and designation of origin of the use of the trademarks that is used by Mr. Bin Lu, Ms. Qian Tan, and Opposer ... and Mr. Fan’s testimony on behalf of Applicant invalidates the two trademarks as merely descriptive with no secondary meaning. Applicant’s use of the two trademarks does not designate the origin of the services they provide but instead just provides a generic description of Chinese singers singing any type of song.

We take judicial notice of the following definitions of the terms “homeland” and “voice”:

Homeland:

- 1 : native land : FATHERLAND
- 2 : a state or area set aside to be a state for a people of a particular national, cultural, or racial origin.

Voice (in relevant part):

- (1): musical sound produced by the vocal folds and resonated by the cavities of head and throat ...
- (3): SINGER ...
- (6): the use of the voice (as in singing or acting).¹⁰⁶

¹⁰⁶ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries. For the definition of “homeland,” see <https://www.merriam-webster.com/dictionary/homeland>, accessed on January 27, 2023. For the definition of “voice,” see <https://www.merriam-webster.com/dictionary/voices> accessed on the same date.

The definition of “homeland” is not limited to China, or the Chinese native land. “Homeland” may refer to other native lands such as Japan, Germany or Russia. Opposer relies only on Mr. Fan’s testimony in support of its claim. His testimony does not refer to the meaning of the term “homeland.” On this record, in the absence of evidence that “homeland” identifies a musical genre recognized by consumers, we find the translation “chorus of homeland voices” is at best suggestive of vocal performance services. By relying only on Mr. Fan’s testimony, and ignoring the definitions of the terms that comprise the Marks, Opposer has not established that the translation “chorus of homeland voices” identifies, without imagination, thought, perception or conjecture, a feature or characteristic of the services identified in the opposed applications.

Opposer’s claim, tried by Applicant’s consent as earlier discussed, of mere descriptiveness is also denied.

Decision: The opposition is denied as to all asserted claims.