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

Proceeding	91238706
Party	Plaintiff Xiang Yin He Chang Tuan Inc.
Correspondence Address	WILLIAM T ANASTASIO APL LAW GROUP 1876 NJ-27 STE 203 EDISON, NJ 08817 UNITED STATES Email: apl.lawgroup@gmail.com, wmanastasio@aol.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	H. Danny Kao, PhD, JD
Filer's email	dkao@kaolawus.com
Signature	/H. Danny Kao/
Date	02/26/2018
Attachments	AMENDED OPPOSITION Final - 180226.pdf(1150403 bytes)

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposition No. 91238706
Application Serial Nos. 87566170 and 87538374

Xiang Yin He Chang Tuan Inc.
Opposer

Vs.

Edison Chinese Chorus Inc.
Applicant

AMENDED OPPOSITION

The original opposition and resulting motion to dismiss raised such significant origination and ownership issues that the Opposer then engaged new counsel to investigate. That investigation resulted in the identification of the creator and first user of the marks, Ms. Qian Tan, and a declaration stating the correct facts on these issues, therefore creating new and bona fide grounds of opposition, as stated below. A motion to amend the opposition to add these new grounds has been filed herewith. Exhibit 1.

Standing: Opposer, who uses the marks in interstate commerce to designate its Chinese choral group, has now been assigned the marks by Ms. Tan, who created and owned them. Tan Assignment, Exhibit 2. Opposer would be damaged by the registrations of the marks because they cause confusion, mistake and deception

within the choral group listening public and within the group of potential singers who wish to join a choral group. Opposer uses the marks with rights to do so while Applicant uses the marks without permission and in the same area but in a different Chinese choral group, causing confusion, mistake and with deception.

Factual Background: The founders of a choral group split from the group and took their marks, the marks in issue, with them. The marks had been created by a founder's wife, Ms. Tan, who permitted the founders to use them in their original group and then the new group. Tan Declaration, Exhibit 3. The group that they left still exists and is the Applicant. The Applicant was aware of these facts yet it attempted to take the marks and confuse and deceive the public as to the origin of its chorus group, willfully submitting false ownership and false first use assertions to the USPTO to obtain the registrations. This is an amended opposition seeking in effect to return the marks to their rightful owner and place them where she intends.

Priority of use: Ms. Tan, who created the marks, used the marks in interstate commerce with the chorus in February of 2002 (e.g., in New Jersey and New York) before Applicant alleges it used them as its first use on October 2004. Tan Declaration. E.g., *Rolex Watch U.S.A., Inc. v. Madison Watch Co.*, 211 USPQ 352 (TTAB 1981) (proprietary right is a right residing in owner of mark).

Likely to cause confusion, mistake or to deceive: Trademark Act § 2(d). 15 U.S.C. § 1052(d). Ms. Tan, who created the marks, permitted them to be used with a

different Chinese chorus group that had split with the Applicant's chorus group under contentious conditions. Tan Declaration. Both groups using the same marks in, for example, the same areas of New Jersey and New York, to designate Chinese choral groups, will obviously cause confusion and mistake with the listening public and new singers seeking to join a choral group. Applicant, who is aware of these facts from the history of the group, as told by Ms. Tan, is knowingly causing confusion, mistake and deception. Tan Declaration. *See, e.g., Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004).

Applicant is not and was not the owner: Ms. Tan, who created the marks owned the marks and never transferred them to Applicant. Ms. Tan has applied her own trademarks (Serial Numbers: 87811480 and 87811521). Tan Declaration. *See, e.g., Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1304-07 (TTAB 2015) (facts inconsistent with individual former band member's claim that he was the owner the mark).

Applicant is misrepresenting the source of the group: Ms. Tan, who created the marks, permitted them to be used with a different Chinese chorus group that had split with the Applicant's chorus group under contentious conditions. Tan Declaration. Applicant's knowing the history of the marks establishes its intentional misrepresentation of the source of the chorus group. *See Bayer Consumer Care AG v.*

Belmora LLC, 90 USPQ2d 1587 (TTAB 2009) (motion to dismiss misrepresentation of source claim denied), *on final decision*, 110 USPQ2d 1623 (TTAB 2014) (petition granted on claim of misrepresentation), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), vacated and remanded 819 F.3d 697 (4th Cir. 2016) (affirming TTAB); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (pleading of misrepresentation of source must be supported by allegations of blatant misuse of the mark by respondent in a manner calculated to trade on the goodwill and reputation of petitioner); *The E.E. Dickinson Co. v. The T.N. Dickinson Co.*, 221 USPQ 713 (TTAB 1984) (petitioner allowed to go forward on claim of misrepresentation of source).

Applicant committed fraud in the procurement of its registrations: The Applicant knew (Applicant was “there” as an entity at the time) that Ms. Tan created and owned the marks and that Applicant could not truthfully claim ownership or any rights in the marks. The Applicant knew that Ms. Tan used the marks first and that Applicant could not claim a first use. The Applicant was reminded of these material and false facts that it had submitted with the original applications in the original opposition but it failed to correct the record, thereby obtaining and maintaining the registration by knowingly submitting this false and highly material information to successfully procure the registrations with a willful intent to deceive. Tan Declaration. *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361 (TTAB 2014) (claim of fraud sustained); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1509 (TTAB 2008) (false claim of use of mark). If Applicant’s intent

only can be inferred before the original opposition, once Applicant did nothing to correct the record after the opposition was filed by the group rightfully using the marks, and Applicant's motion to dismiss was filed, actual evidence of intent should be found.

Conclusion: The opposition should be amended and the new grounds admitted. The new grounds establish that the opposition should be granted and Applicants' registrations denied.

By: /s/ H. Danny Kao

H. Danny Kao, PhD, JD
Attorney for the Opposer
Dated: February 28, 2018

Certificate of Service

I hereby certify that a true and complete copy of the foregoing MOTION TO AMEND OPPOSITION has been served on Cheng Q. Song, Counsel for the Opposer, by forwarding said copy on February 26, 2018, visa email to chengqsong@gmail.com.

Signature: /s/H. Danny Kao

Date: February 26, 2018

Exhibit 1

IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

Opposition No. 91238706

Application Serial Nos. 87566170 and 87538374

Xiang Yin He Chang Tuan Inc.

Opposer

Vs.

Edison Chinese Chorus In

c.

Applicant

MOTION TO AMEND OPPOSITION

Comes now the Opposer, Xiang Yin He Chang Tuan Inc. (“Xiang Yin”), by counsel, H. Danny Kao, filing a motion to amend the opposition.

Opposer file two oppositions dated January 3, 2018 for two published trademark applications, 87566170 (‘170) and 87538374 (‘374). Opposer retained us to further evaluate the true owners of the trademarks-in-suit. The Applicant of ‘170 and ‘374 Edison Chinese Chorus Inc. (“Edison”) has committed a fraudulent presentation claiming that they are the owner of the first use of these two marks.

After further evaluation, the counsel learned the true owner of these two trademarks-in-suit are Ms. Qian Tan, see Tan Declaration. Ms. Tan has filed her own trademark applications (Serial Numbers 87811480 and 87811521). Ms. Tan has assigned her trademark right to the Opposer, Xiang Yin He Chang Tuan, Inc. See Tan Assignment. Now

comes to the Opposer filing a motion to amend her opposition to the registration of '170 and '374 trademark applications.

Ms. Tan's husband was the leader of the Edison. The Edison was established in February 2001. Ms. Tang was never a member of Edison but her husband was the founder and leader of Edison. Back in February 2001, the group was seeking a name. Ms. Tan proposed Xiang Yin He Chang Tuan to be used by Edison. The marks were used in the commerce as early as February 2002, pre-dated the Applicant alleges claimed first use of October 2, 2004. The reason is that the Applicant is not the true owner and does not know who the true owner is.

The mark is owned by Ms. Tan and has never assigned or transferred her right to Edison. MS Tan allowed Edison used this name because her husband was leading the group. In January 2017, Ms. Tang's husband was ousted by Edison and joined Xiang Yin He Chang Tuan, Inc. with Mr. Bin Lv (the original music director of Edison back in 2001 also ousted by Edison in 2017).

Xiang Yin has obtained assignment from the true owner of the trademarks. Tan Assignment. The Opposer now comes to this Board to amend its opposition and pray for the Board to grant this motion.

By: /s/ H. Danny Kao

H. Danny Kao, PhD, JD
Attorney for the Opposer
Dated: February 26, 2018

Certificate of Service

I hereby certify that a true and complete copy of the foregoing MOTION TO AMEND OPPOSITION has been served on Cheng Q. Song, Counsel for the Opposer, by forwarding said copy on February 26, 2018, visa email to chengqsong@gmail.com.

Signature: /s/H. Danny Kao

Date: February 26, 2018

Exhibit 2

商标转让协议

本商标转让协议 ("协议") 由 Qian Tan ("转让人"), 地址: 23 Calvert Ave, East Edison, NJ 08820 和 Xiang Yin He Chang Tuan Inc. ("受让人"), 新泽西注册公司, 地址: 209 Walnut Drive, Morganville, NJ 07751 签署, 于 2018 年 2 月 26 日 ("生效日期")

1. 商标

商标名称: "乡音合唱团" 和 "乡音和唱团" (简体和繁体)
申请号: 乡音合唱团 (申请号待定) 和 乡音和唱团 (申请号待定)
申请日期: 都为 2018 年 2 月 26 日
首次使用: 2002 年 2 月 10 日
商品 / 服务描述: 以现场合唱团的表演形式提供娱乐服务

2. 合约交换对价. 商标转让的对价为 10 美元, 由受让人于 2018 年 2 月 26 日支付给转让人。

3. 全部协议. 本协议构成转让人和受让人之间的全部协议内容。

4. 修改和放弃. 本协议的任何修订和修改须以书面形式, 并经双方签字同意。

以资证明, 双方于上述日期签署本协议

转让人:

由: Qian Tan
姓名: Qian Tan
职位: 个人

受让人: JIAN SHE LU

由: Hengyi Aixinjue
姓名: Jianshe Lu (Bin Lv)
职位: 负责人
组织: Xiang Yin He Chang Tuan Inc.

Trademark Assignment Agreement

This Trademark Assignment Agreement (this "Agreement") is entered into as of the February 26, 2018 (the Effective Date") by and between Qian Tan (the "Assignor"), an individual residing at 23 Calvert Ave, East Edison, NJ 08820 and Xiang Yin He Chang Tuan Inc. (the "Assignee"), a New Jersey Corporation located at 209 Walnut Drive, Morganville, NJ 07751.

1. Mark.

Mark name: 乡音合唱团 and 鄉音和唱團 (these are simplified Chinese and traditional Chinese)

Application Numbers: 乡音合唱团 (Application Serial No. To Be Filed) and
鄉音和唱團 (Application Serial No. To Be Filed)

Date of Application: both on February 26th, 2018

First use: February 10, 2002

Description of Goods/Services: Entertainment services in the nature of live vocal performances by Chorus.

- 2. Consideration.** Assignee shall pay Assignor the sum of \$10, payable on February 26, 2018 in consideration for assignment of the Mark.
- 3. Entire Agreement.** This Agreement constitutes the entire agreement between Assignor and Assignee.
- 4. Modification and Waiver.** This Agreement may be amended or modified only by a written agreement signed by both of the parties.

IN WITNESS WHEREOF, the parties hereto have executed this Agreement as of the date first written above.

Assignor:

By: /s/Qian Tan

Name: Qian Tan

Title: Personal

Assignee:

By: /s/Jianshe Lu /s/Hengyi Aizingjueluo

Name: Jianshe Lu (Bin Lv)

Title: President

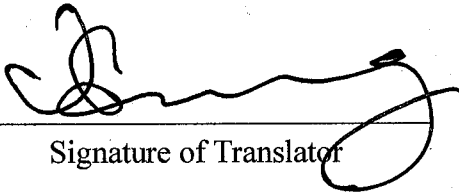
Organization: Xiang Yin He Chang Tuan Inc.

Certificate of Translation

STATE OF NEW YORK,
COUNTY OF QUEENS, ss.:

I, Vivian Huang, a translator of proven expertise in translating Chinese into English, do hereby certify that the foregoing is, to the best of my knowledge and ability, a true and complete and accurate English translation of the original Chinese document.

Date: February 26, 2018



Signature of Translator

Vivian Huang

Print Name

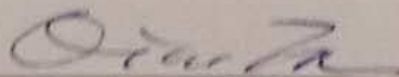
Exhibit 3

DECLARATION OF QIAN TAN

I, the undersigned, Qian Tan, declare under penalty of perjury that the forgoing is true and correct.

1. In Feb. 2001, Mr. Jianshe Lu (Bin Lv) and my husband Yuanqi Wen and some other people decided to found a chorus.
2001年2月, Jianshe Lu (Bin Lv), 我的先生 Yuanqi Wen 以及其他人决定成立一个合唱团。
2. The chorus needed a good name to get start. I proposed "Xiang Yin He Chang Tuan" in Chinese as the name of the chorus.
合唱团需要取一个好名字。我提出将合唱团的名称取为“乡音合唱团”。
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.
我允许“乡音合唱团”这个名字由 Jianshe Lu (Bin Lv) 先生领导的合唱团使用, 因为我的先生也是该合唱团的领队。
4. In February of 2017, my husband Yuanqi Wen and Mr. Jianshe Lu (Bin Lv) parted way from the chorus and formed a new one. I allowed them continue using "Xiang Yin He Chang Tuan" at their new chorus group.
2017年2月, 我的先生 Yuanqi Wen 和 Jianshe Lu (Bin Lv) 先生与原来的合唱团分道扬镳并成立了一个新的合唱团。所以, 我允许这个新合唱团继续使用“乡音合唱团”这个名字。

Executed on February 26, 2018.



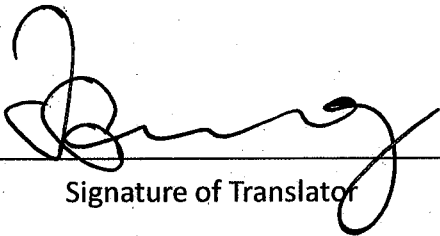
Qian Tan
Declarant

Certificate of Translation

STATE OF NEW YORK,
COUNTY OF QUEENS, ss.:

I, Vivian Huang, a translator of proven expertise in translating Chinese into English, do hereby certify that the foregoing is, to the best of my knowledge and ability, a true and complete and accurate English translation of the original Chinese document.

Date: February 26, 2018



Signature of Translator

Vivian Huang

Print Name