

This Opinion is Not a
Precedent of the TTAB

Mailed: September 2, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Shanghai Zhenglang Technology Co., Ltd.

v.

Superbox, Inc.
—————

Opposition No. 91251457
—————

Shan Zhu of Shan Zhu Law Group, P.C.,
for Shanghai Zhenglang Technology Co., Ltd.

Stephen R. Barrese of Dilworth & Barrese LLP,
for Superbox, Inc.
—————

Before Lykos, Shaw and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Applicant, Superbox, Inc., seeks registration on the Principal Register of the standard character mark JEWEL HUNTER for “recorded computer game software; downloadable smart phone application software for playing electronic games; computer game programmes [sic] downloadable via the Internet; downloadable music files; downloadable digital photograph; electronic publications, downloadable,

namely, magazines and books in the field of gaming and music” in International Class 9.¹

Shanghai Zhenglang Technology Co., Ltd. (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Opposer’s alleged prior common law rights in the mark JEWEL HUNTER for an online “game app.” In the notice of opposition, Opposer pleads use of the mark JEWEL HUNTER in the United States since January 31, 2015, and that its mark is “very famous” in the United States and China.²

In its answer, Applicant denies the salient allegations in the notice of opposition and pleads an affirmative defense of abandonment, which it argues in its brief.³

The case is fully briefed. Opposer, as plaintiff in this proceeding, bears the burden of establishing its entitlement to a statutory cause of action and claim by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104,

¹ Application Serial No. 88139836, filed October 2, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of a bona fide intent to use the mark in commerce.

² Notice of Opposition, 1 TTABVUE 3, 5, ¶¶ 1, 6.

³ Applicant pleads six additional affirmative defenses that it waived by failing to argue them in its brief, *see, e.g., 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); and two “affirmative defenses” that are mere amplifications of its denials. 4 TTABVUE.

1107 (TTAB 2007). For the reasons explained below, we dismiss the opposition.

I. Evidentiary Issues

A. Timeliness of Opposer's Evidence

Before summarizing the record in this case, we address the issue of whether Opposer's three purported testimony declarations and attached exhibits thereto of its President, Ruihua Ji, and a notice of reliance are timely.⁴

Parties may not take testimony depositions or present evidence outside their assigned trial periods, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a); *see, e.g., Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 (TTAB 2020) (“a party may introduce testimony and evidence only during its assigned testimony period”).

As reset by the Board's order of August 31, 2020, Opposer's trial period was set to close on October 30, 2020. During its trial period, on October 15, 2020, Opposer concurrently filed a motion to reopen discovery along with the testimony declaration of its president, Ruihua Ji (“First Ji Declaration”)⁵ and a notice of reliance.⁶ On

⁴ In its brief, Opposer lists as part of the record the purported declaration of Mr. Ji attached to Opposer's motion for summary judgment, filed July 9, 2021. 23 TTABVUE 7-10. Opposer's motion for summary judgment was untimely and given no consideration. 24 TTABVUE 3-5. Even if the motion had been considered, evidence submitted in connection with summary judgment briefing is of record only for consideration of the summary judgment motion. To be considered at final hearing, any such evidence must be properly introduced during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981). Accordingly, we give no consideration to Mr. Ji's declaration attached to Opposer's motion for summary judgment.

⁵ 14 TTABVUE.

⁶ 15 TTABVUE.

October 16, 2020, the Board issued an order retroactively suspending proceedings “as of the filing date” of Opposer’s motion to reopen, i.e. October 15, 2021.⁷ The Board did not address the effect, if any, of the retroactive suspension on the timeliness of the First Ji Declaration and notice of reliance. Given this ambiguity, and because Applicant did not object to Opposer’s identification of the First Ji Declaration and notice of reliance as “evidence of record” in Opposer’s trial brief, we find that the First Ji Declaration and Opposer’s notice of reliance are timely and properly of record.

On July 12, 2021, the Board reset dates in the proceeding resetting Opposer’s 30-day trial period to close on September 2, 2021 and Opposer’s 15-day rebuttal trial period to close on December 16, 2021.⁸ On September 9, 2021, after the close of its trial period, Opposer filed the second testimony declaration of its president, Mr. Ji (“Second Ji Declaration”). The Second Ji Declaration is untimely and does not include proof of service, but Applicant did not object on either of these grounds and, in its brief, expressly treats the second Ji Declaration as part of the record.⁹ Accordingly, we too treat the Second Ji Declaration as part of the record. *See Int’l Dairy Foods Assoc. v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period and submitted by opposers as trial testimony considered to have been properly submitted because applicants did not object to them as untimely, and, in fact, treated them as part of the record by raising

⁷ 16 TTABVUE 2.

⁸ 24 TTABVUE 9-10.

⁹ Applicant’s Brief, 33 TTABVUE 7.

substantive objections against them), *aff'd*, 575 F. Supp. 3d 627, 2021 (E.D. Va. 2021), *appeal docketed*, No. 22-1041 (4th Cir. Jan. 11, 2022).

On November 15, 2021, Opposer filed a third testimony declaration of its president, Mr. Ji (“Third Ji Declaration”). The Third Ji Declaration is untimely as it was filed after the close of Opposer’s trial period and before the opening of Opposer’s rebuttal trial period, and it does not include proof of service. Applicant did not object to the Third Ji Declaration on either of these bases but also did not expressly treat the declaration as part of the record as it did the Second Ji Declaration. Accordingly, the Third Ji Declaration is not properly of record and we give it no consideration. *Calypso Tech., Inc. v. Calypso Capital Mgmt.*, 100 USPQ2d 1213, 1216-17 (TTAB 2011) (where parties improperly introduce or submit non-conforming evidence, such evidence “will not be considered even if the adverse party does not specifically object to it, as long as the adverse party does not specifically treat it as of record such that we can say it has been stipulated into the record.”).

B. Whether the Ji Declarations Constitute Testimony

Trademark Rule 2.123(a)(1), 37 C.F.R. § 2.123(a)(1), provides that witness testimony may be submitted in the form of a sworn affidavit or an unsworn declaration under Trademark Rule 2.20. *See e.g., M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Tech. & Trade Marks Ltd.*, 2019 USPQ2d 149090, at *2 (TTAB 2019). Trademark Rule 2.20, in turn, provides that “[i]nstead of an oath, affidavit, or sworn statement, the language of 28 U.S.C. 1746, or the following declaration language, may be used”:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

37 C.F.R. § 2.20.

The First and Second Ji Declarations are not under oath and do not use the language in Trademark Rule 2.20 set out above. Accordingly, we consider whether the First and Second Ji Declarations comply with the requirements of 28 U.S.C. § 1746.

The purported declarations were executed in Shanghai, China. Under 28 U.S.C. § 1746, the following language may be used for unsworn declarations executed outside the United States:

I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

Both the First and Second Ji Declarations begin with the statement “I, Ruihua Ji, declare under penalty of perjury the following to be true” and conclude with the following: “The above statements were translated to me in my preliminary language, Mandarin. I fully understand and under penalty of perjury, the above statements are true and correct.”¹⁰

Neither declaration specifies that the statements are made under penalty of perjury “under the laws of the United States of America,” as required under 28 U.S.C.

¹⁰ 14 TTABVUE 3-4; 25 TTABVUE 3, 7.

§ 1746 for declarations executed outside the United States. The Board has explained that the language “under the laws of the United States” is a critical element of a declaration under 28 U.S.C. § 1746 executed outside the United States:

The purpose of requiring a person outside the United States to execute the document under penalty of perjury under the laws of the United States is to impress upon him the seriousness of the obligation to tell the truth and the possibility of prosecution for perjury if he fails to tell the truth. When a person executes a document outside the United States, a recitation that it is made under penalty of perjury without reference to which country’s perjury laws will be applied provides no assurance of truthfulness because the penalty of perjury may be nonexistent or trivial in the place where the person signed the document.

M/S R.M. Dhariwal, 2019 USPQ2d 149090, at *2 (quoting *Jack v. Trans World Airlines*, 854 F. Supp. 654, 658 n.3 (N.D. Cal 1994)).

Because the First and Second Ji Declarations do not comply with the requirements for declaration testimony, they cannot be considered. *See id.* at *3.

C. Evidence Attached to Applicant’s Brief

Applicant attached new evidence to its brief.¹¹ As explained above, under Trademark Rule 2.121(a), the time for parties to introduce evidence is during trial, not briefing, unless otherwise stipulated by the parties approved by the Board, motion granted by the Board, or by order of the Board. *See, e.g., Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008) (“[W]hile exhibits to

¹¹ Opposer attached to its brief Applicant’s initial disclosures and interrogatory responses. Opposer relies on these documents not as evidence but for purposes of objecting to Applicant’s reliance on evidence of third-party use on the ground that Applicant failed to produce such evidence during discovery.

We need not address Opposer’s objection because we do not rely on Applicant’s evidence of third-party use in reaching our decision.

briefs are not explicitly prohibited by the Trademark Rules, the Board will usually ignore them, because they comprise either untimely evidence or unnecessary copies of timely evidence.”). Here, there is no stipulation, granted motion or Board order allowing submission of evidence in this manner and Opposer, in its rebuttal brief, specifically argues that “[t]he facts and arguments presented in the brief must be based on the evidence offered at trial.... A brief may not be used as a vehicle for the introduction of evidence.”¹² Accordingly, we give the newly submitted evidence attached to Applicant’s brief no consideration.¹³

II. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed application. In addition, the record includes Opposer’s notice of reliance¹⁴ and the following evidence that Applicant introduced:

- The November 1, 2021 Trial Declaration of Applicant’s Director, Seung yul Jang, and accompanying exhibits;¹⁵ and

¹² Opposer’s Rebuttal Brief, 34 TTABVUE 5.

¹³ Similarly, we do not consider Opposer’s interrogatory responses incorporated into the text of Applicant’s brief because this evidence was not introduced during trial. *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at *2 (TTAB 2019) (inserted screenshots and hypertext link within the text of reply brief, if not previously and properly introduced into the record, not considered).

¹⁴ The documents submitted under Opposer’s notice of reliance, purportedly to show Applicant’s lack of use of its applied-for mark are superfluous. Opposer merely introduced the application form and a response to suspension inquiry, both from the file history for Applicant’s involved application (15 TTABVUE 4-21), which is automatically of record in this proceeding by operation of Trademark Rule 2.122(b).

¹⁵ The Jang Declaration uses the same “under the penalty of perjury” language used in the Ji Declarations but does not specify where Mr. Jang was located when he signed the

- A notice of reliance on “Applicant’s active foreign trademark registrations” and “screenshots obtained through an Internet search for the terms ‘JEWEL’ and ‘HUNTER’ which are publicly available.”¹⁶

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020), *cert. denied*, 142 U.S. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020).

Opposer argues that Applicant “did not challenge [Opposer’s entitlement] to oppose the registration of [the] JEWEL HUNTER trademark. Thus, the Broad [sic]

declaration. Such information is not required under 28 U.S.C. § 1746. *M/S R.M. Dhariwal*, 2019 USPQ2d 149090, at *3, n.12. Accordingly, there is no basis for finding that the Jang Declaration fails to comply with 28 U.S.C. § 1746. We hasten to add, however, that even if we had not considered the Jang Declaration, we would reach the same final decision.

¹⁶ The documents introduced under Applicant’s notice of reliance appear to be identical to the exhibits to the Jang Declaration. It was unnecessary to introduce these documents twice.

should conclude [Applicant] has waived such a defense.”¹⁷ Lack of entitlement, however, is not an affirmative defense that is waived if not raised by the defendant. Rather, it is an essential element of the plaintiff’s claim that the plaintiff must prove as part of its case. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Blackhorse v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011) (“Standing is an element of petitioners’ claim. Petitioners must prove standing as part of their case.”); *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 504 (TTAB 1985) (“[A]n essential element of proof in any opposition or cancellation proceeding is that the opposer or petitioner possess a ‘real interest’ in the proceeding.”).

Here, the record lacks proof of Opposer’s real interest in the proceeding and its reasonable belief of damage. As explained above, we cannot consider the Ji Declarations because the first two declarations were improperly executed and the third declaration was untimely.¹⁸ Applicant did not make any admissions in its

¹⁷Opposer’s Rebuttal Brief, 34 TTABVUE 4.

¹⁸ Even if we were to consider the exhibits to the First and Second Ji Declarations that are self-authenticating (i.e. those Internet printouts bearing legible URL addresses and dates), they are not sufficient to establish Opposer’s entitlement. Because they constitute hearsay, Internet printouts may be considered only for what they show on their face and not for the truth of their contents unless the contents are accepted as fact by the opposing party. *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018) (Absent testimony from a competent witness, Internet evidence is hearsay. But “to the extent that a party has accepted as fact any portion of [the] Internet evidence submitted by the adverse party, we deem such portions of the submitted Internet evidence stipulated into the record for the truth of any matters asserted therein.”) (citing Fed. R. Civ. P. 801(c)); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010) (“The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face. However, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed.”); *see also Spiritline Cruises LLC v. Tour Mgmt. Srvs., Inc.*, 2020 USPQ2d 48324, at *3 (TTAB 2020) (explaining that if a party wishes

answer or introduce any evidence demonstrating Opposer's entitlement to bring a statutory cause of action.

Opposer "cannot rest on mere allegations in its complaint or arguments in its brief to prove [entitlement]." *WeaponX*, 126 USPQ2d at 1039 (citing *Lipton Indus.*, 188 USPQ at 188); *see also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) ("Attorney argument is no substitute for evidence) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)); *In re Simulations Publ'ns, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) ("Statements in a brief cannot take the place of evidence").

Accordingly, Opposer has failed to establish that it is entitled to oppose Applicant's application.

IV. Conclusion

Opposer has not proven that it is entitled to bring this statutory cause of action. The notice of opposition must be denied on this ground alone. *See Lumiere Prods., Inc. v. Int'l Tel. & Tel. Corp.*, 227 USPQ 892, 893 (TTAB 1985).

Decision: The opposition is dismissed.

to rely on Wayback Machine evidence not just for what it shows on its face but to establish that the webpages submitted were displayed on various dates in the past, (i.e. the truth of the capture of the archive date), witness testimony must be offered to authenticate the printouts and lay the foundation that the webpage printouts are business records).

Applicant accepts as fact only a portion of Exhibit A to the Second Ji Declaration: "According to the Exhibit A of Declaration Ruihua Ji dated September 8, 2021, there has been no update [to the JEWEL HUNTER game app] between February 1, 2015 and May 30, 2019." 33 TTABVUE 7. Even accepting this portion, or even all of Exhibit A, to the Second Ji Declaration as true, would not establish Opposer's entitlement because the exhibit makes no reference to Opposer. Rather the exhibit lists the JEWEL HUNTER game app as "Offered By PhoneMaster." 25 TTABVUE 9-20.