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PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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jv

December 20, 2024

Opposition No. 91276953

May Flower International, Inc.

v.

Amoy Food Limited

**Before Lykos, Thurmon, and Myles,
Administrative Trademark Judges.**

By the Board:


This proceeding comes before the Board for consideration of (i) Applicant's motion for summary judgment (filed August 3, 2024), and (ii) Opposer's cross-motion (filed September 23, 2024) to suspend proceedings pending the disposition of a civil action.¹ The motion for summary judgment is fully briefed, and the motion to suspend is contested.


The Board has considered the parties' briefs and arguments, presumes the parties' familiarity with the factual bases for their filings, and addresses the record only to

¹ Opposer filed a combined response to Applicant's motion for summary judgment and a cross-motion to suspend proceedings pending disposition of a civil action.

the extent it deems warranted. *See Guess? IP Holder LP v. Knowlux LLC*, Can. No. 92060707, 2015 TTAB LEXIS 482, at *5 (TTAB 2015).²

I. Background

Applicant seeks registration on the Principal Register for the mark  for use with “[b]akery products; [m]oon cakes” in International Class 30 based on intent to use pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).³

On June 24, 2022, Opposer filed a notice of opposition opposing registration of Applicant’s mark on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In support of its entitlement to a statutory cause of action and ground for opposition, Opposer pleads prior use of the mark  with moon cakes and ownership of a pending application therefor in connection with

² The citation form in this order is in a form provided in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This order cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this order employs citation to the Lexis database. Practitioners should also adhere to the practice set forth in TBMP § 101.03.

³ Application Serial No. 90757571 filed June 7, 2021. The mark is described as: “The mark consists of a stylized banner featuring a rectangle with the stylized word ‘AMOIY’ on it and a stylized shield design with two Chinese characters stacked one above the other to the left of the word ‘AMOIY’”. The non-Latin characters in the mark transliterate to “TAO TAI” and this means “to sift, big” in English.

“moon cakes” in International Class 30 based on use in commerce pursuant to Trademark Act Section 1(a), 15 U.S.C. § 1051(a).⁴ 1 TTABVUE 4.⁵

In its August 2, 2022 answer, Applicant admits several allegations, including: Opposer filed its pleaded application, details about Applicant and its involved application, the marks are confusingly similar, and the goods of the parties are similar. 5 TTABVUE 2-3. Applicant otherwise denies the salient allegations in the notice of opposition and asserts putative affirmative defenses of failure to state a claim, unclean hands, and estoppel. *Id.* at 4-5.

II. Opposer’s Cross-Motion to Suspend

The Board turns first to Opposer’s cross-motion to suspend proceedings pending a civil action filed in the United States District Court for the Eastern District of New York between Opposer and Applicant and other third parties, *May Flower Int’l, Inc. v. Amoy Food Limited, et al.*, Case No. 1:24-cv-4909 (“Civil Action”). Opposer filed a copy of the complaint in the Civil Action with its cross-motion. 31 TTABVUE 70-90. The complaint alleges fraud, violations of the Racketeer Influenced and Corrupt Organizations Act (RICO), 18 U.S.C. § 1962(c), and conspiracy, 18 U.S.C. § 1962(d),

⁴ Application Serial No. 97466977 filed June 20, 2022. The mark is described as: “The mark consists of a stylized banner with two [C]hinese characters in vertical arrangement and a word ‘AMOY’ on the right of it. The wording ‘AMOY’ has no meaning in a foreign language. The non-Latin characters in the mark transliterate to ‘TAO’ ‘DA’ and this means ‘SEA WAVES’ ‘BIG’ in English.”

⁵ Citations to the record in this order are to TTABVUE, the Board’s electronic docketing system. *See Turdin v. Trilobite, Ltd.*, Conc. Use No. 94002505, 2014 TTAB LEXIS 17, at *6 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. The parties should cite to the record using TTABVUE throughout this proceeding. *Id.*

based on allegations that Applicant made misrepresentations about mooncakes sold to Opposer and allegations that the defendants worked together to defraud and extort Opposer. 31 TTABVUE at 80-90. The Board has not received a copy of any answer to the complaint.

The Board's policy is to suspend proceedings when one or both parties are involved in a civil action that may have a bearing on the Board proceedings. *See* Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a); *see also, e.g., General Motors Corp. v. Cadillac Club Fashions Inc.*, Can. No. 91018418, 1992 TTAB LEXIS 7, at *12 (TTAB 1992). The decision to suspend is within the Board's discretion. Trademark Rule 2.117(a); TBMP § 510.02. The civil action need not be dispositive of the Board proceedings but only needs to have a bearing on the issues before the Board. *See New Orleans Saints LLC v. Who Dat? Inc.*, Opp. No. 91198708, 2011 TTAB LEXIS 208, at *7 (TTAB 2011).

Following a careful review of the record, the Board finds that suspension of this proceeding pending disposition of the Civil Action is not appropriate and would not serve the interests of judicial economy. Opposer renews many of its unpersuasive arguments from its previous cross-motion to suspend for a state court proceeding, 24 TTABVUE, including that the key issues in the Civil Action are whether the mooncakes Applicant provided to Opposer were manufactured by a third party in China and why Applicant filed its application under Section 1(b). 31 TTABVUE 8. Again, Opposer sets forth no arguments as to why Applicant's filing of its application under Section 1(b) is relevant to this proceeding or how the Civil Action could have any bearing on that issue. The filing of an intent-to-use application under Section

1(b) is not an admission of nonuse or otherwise inconsistent with actual use of a mark. *See Corp. Document Servs. Inc. v. I.C.E.D. Mgmt. Inc.*, Opp. No. 91102651, 1998 TTAB LEXIS 367, at *6-7 (TTAB 1998). Similarly, Opposer sets forth no arguments as to why whether Applicant manufactured the mooncakes delivered to Opposer itself or had a third party manufacture the mooncakes has any bearing on the likelihood of confusion claim. The Civil Action does not involve any trademark claims, and the District Court's resolution of the fraud, RICO, and conspiracy claims would not be dispositive of nor have any bearing on the likelihood of confusion claim at issue in this proceeding.

Accordingly, Opposer's motion to suspend is **denied**. The parties are ordered to file with the Board copies of any answer and counterclaims or amended pleadings from the Civil Action within **TWENTY DAYS** of when the pleadings close in the Civil Action.

III. Applicant's Motion for Summary Judgment

The Board turns next to Applicant's motion for summary judgment on the issues of entitlement to a statutory cause of action, priority, and Applicant's affirmative defenses of unclean hands and estoppel.

A. Preliminary Matter

Before turning to the merits of the summary judgment motion, the Board has reviewed Applicant's affirmative defenses of unclean hands and estoppel. Applicant's affirmative defense of unclean hands is based on allegations that Opposer knows that it is a mere distributor of Applicant's goods and that "Opposer has attempted to unlawfully assert its ownership over Applicant's mark." 5 TTABVUE 4. An

affirmative defense is an assertion that, if true, will defeat the plaintiff's claim, even if all of the allegations in the complaint are true. *See H.D. Lee Co., Inc. v. Maidenform Inc.*, Opp. No. 91168309, 2008 TTAB LEXIS 21, at *10 (TTAB 2008) (quoting BLACK'S LAW DICTIONARY, p. 430 (7th ed. 1999)). Here, Applicant's defense alleges that Opposer does not have any proprietary rights in the mark, which is an element of Opposer's claim of likelihood of confusion that it must affirmatively prove in order to prevail. The allegations therefore go to whether Opposer will be able to prove its claims and are not a true affirmative defense.

Nevertheless, the putative defense provides further notice and amplification of Applicant's denial of Opposer's claim of priority and likelihood of confusion and is therefore permissible. *See Mars Generation, Inc. v. Carson*, Opp. No. 91224726, 2021 TTAB LEXIS 386, at *4 (TTAB 2021). We therefore do not strike the allegations, but they will not be considered as an affirmative defense. Applicant's motion for summary judgment on this putative defense is therefore considered solely to the extent that it relates to Opposer's claim of priority.⁶

⁶ In its motion for summary judgment, Applicant also argues that Opposer "should be precluded from relying upon its App. Serial No. 97466977" and its purported common law rights based on its false statements to the USPTO when it filed its pleaded application. 25 TTABVUE 18. Opposer's application has been suspended and remains pending and, therefore, cannot be the subject of a Board proceeding. *See Home Juice Co. v. Runclin Cos. Inc.*, Can. No. 92014533, 1986 TTAB LEXIS 22, at *5 n.7 (TTAB 1986). In any event, Opposer's pleaded pending application was filed after Applicant's and it therefore cannot be used to establish priority. Additionally, where an unclean hands defense "relates to a plaintiff's acquisition, or attempt to acquire, a registration, the unclean hands defense goes only to the plaintiff's ability to rely on [a] pleaded registration, not to its common law rights." *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, Opp. No. 91110043, 2001 TTAB LEXIS 562, at *19 (TTAB 2001). Opposer does not have a pleaded registration and, therefore, the doctrine of unclean hands is inapplicable to Opposer's likelihood of confusion claim.

With respect to Applicant's pleaded defense of estoppel, in its answer, Applicant alleges that Applicant is the owner of the mark, that it "permitted" Opposer to sell Applicant's mooncakes under its mark, and that Opposer did so with full knowledge that Applicant retained ownership of the mark. 5 TTABVUE 4-5. In its summary judgment motion, Applicant moves for summary judgment on the defense of estoppel based on the alleged agreement with Opposer, but also moves for summary judgment on the defense of estoppel by acquiescence based on Opposer's "delay" in asserting its claim. 25 TTABVUE 19. Although acquiescence is a form of estoppel, the defense of acquiescence was not pleaded in Applicant's answer and a party may not obtain summary judgment on an unpleaded claim or defense. *See* Fed. R. Civ. P. 56(a); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, Opp. No. 91190886, 2010 TTAB LEXIS 228, at *9 (TTAB 2010). Accordingly, the motion is **denied** to the extent Applicant moves on the affirmative defense of acquiescence. Moreover, the equitable defense of acquiescence is severely limited in an opposition proceeding, as the defense typically starts to run from the time of knowledge of the application for registration (i.e., the publication date), not from the knowledge of the party's use of the mark. *See Nat'l Cable TV Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991) ("In an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark."). The defense of acquiescence is therefore unavailable.

B. Summary Judgment Standard

Summary judgment is an appropriate method for disposing of cases in which there are no genuine disputes as to material facts, thus allowing resolution as a matter of

law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *see also Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 1563 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *See Opryland USA Inc v. Great Am. Music Show Inc.*, 970 F.2d 847, 850 (Fed. Cir. 1992); *Olde Tyme Foods Inc v. Roundy's Inc.*, 961 F.2d 200, 202 (Fed. Cir. 1992).

Where the nonmoving party will bear the burden of proof at trial on a dispositive issue, the moving party may discharge its burden by showing that there is an absence of evidence to support the nonmoving party's case. *Celotex Corp.*, 477 U.S. at 325; *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 1565 (Fed. Cir. 1991). However, the burden of the nonmoving party to respond arises only if summary judgment is properly supported. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 160-61 (1970). If the evidence produced in support of the summary judgment motion does not meet this burden, "summary judgment must be denied even if no opposing evidentiary matter is presented." *Id.* (quoting Fed. R. Civ. P. 56 advisory committee notes to the 1963 amendments).

The evidence of record on summary judgment must be viewed in the light most favorable to the nonmoving party, and all justifiable inferences must be drawn from the undisputed facts in favor of the nonmoving party. *See Lloyd's Food Prods. Inc. v.*

Eli's Inc., 987 F.2d 766, 767 (Fed. Cir. 1993); *Opryland USA*, 970 F.2d at 850; *Bad Boys Bail Bonds, Inc. v. Yowell*, Conc. Use No. 94002552, 2015 TTAB LEXIS 262, at *14 (TTAB 2015).

C. Entitlement to a Statutory Cause of Action

On summary judgment, Applicant must establish that there is no genuine dispute of material fact that Opposer lacks entitlement to a statutory cause of action, which is required for all plaintiffs in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1372 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). In its notice of opposition, Opposer alleged ownership of a pending application for its pleaded mark. 1 TTABVUE 4. And in response to the motion for summary judgment, Opposer attached an Office Action refusing registration thereof that also noted Applicant's subject application as one that, if registered, may result in Opposer's mark being "refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s)." 31 TTABVUE 23. This evidence raises a genuine dispute of material fact that Opposer lacks the requisite entitlement to bring a statutory cause of action. *See, e.g., Weatherford/Lamb, Inc. v. C&J Energy Servs.*, Can. No. 92050101, 2010 TTAB LEXIS 404, at *9-10 (TTAB 2010) (finding "no question that petitioner has standing to bring this petition for cancellation" where the petitioner made of record the Office Action suspending its pleaded application pending the possible refusal under Section 2(d)).

Accordingly, Applicant's motion for summary judgment is **denied** on entitlement to a statutory cause of action.

D. Priority

In order to prevail in its motion for summary judgment, Applicant must establish that there is no genuine dispute of material fact that Applicant's constructive use date is prior to Opposer's proprietary rights in its pleaded mark. *See Kemi Organics, LLC v. Gupta*, Can. No. 92065613, 2018 TTAB LEXIS 149, at *10 (TTAB 2018).

In support of its motion, Applicant argues that it "has always acted as the producer or source of AMOY mooncake products while retaining ownership rights in the mark," and that Opposer "was then engaged to act as a tertiary level distributor." 25 TTABVUE 3. Applicant further argues that Opposer's sales of the AMOY-branded mooncakes on June 1, 2021, while acting as Applicant's U.S. distributor, did not create for Opposer proprietary rights in the mark. *Id.* at 12. Rather, Applicant argues that Opposer's sale and distribution of the AMOY mooncakes "inured to the benefit" of Applicant as the producer and brand owner. *Id.* at 15.

Opposer's response includes a declaration of Opposer's General Manager, Min Liu. 31 TTABVUE 15-17. The declaration states that Ms. Liu was "involved in the adoption" of Opposer's pleaded mark, and that it was on her "advice and suggestion" that Opposer's pleaded mark was adopted and used on the mooncake products. *Id.* at 16-17 (¶¶ 6, 9).

Upon careful consideration of the parties' arguments and evidence, and drawing all reasonable inferences in favor of Opposer as the nonmoving party, the Board finds

that, at a minimum, there is a genuine dispute of material fact as to whether the sale of AMOY moon cakes on June 1, 2021 established Opposer's prior proprietary rights in its pleaded mark.

Accordingly, Applicant's motion for summary judgment is **denied** on priority.

E. Estoppel

Applicant also moves for summary judgment on its pleaded defense that Opposer's claim is barred by the doctrine of equitable estoppel based on the distribution contract entered into between the parties.

Upon careful consideration of the parties' arguments and evidence, and drawing all reasonable inferences in favor of Opposer as the nonmoving party, the Board finds that, at a minimum, there is a genuine dispute of material fact as to whether Opposer expressly or by clear implication consented to Applicant's registration of its mark.

Accordingly, Applicant's motion for summary judgment is **denied** on the defense of estoppel.⁷

IV. Proceeding Schedule

⁷ The fact that we have identified certain genuine disputes of material fact as sufficient bases for denying Applicant's summary judgment motion should not be construed as a finding that such disputes are necessarily the only disputes that remain for trial. Additionally, the parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, Opp. No. 91081072, 1993 TTAB LEXIS 22, at *2 n.2 (TTAB 1993). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. *See, e.g., Micro Motion Inc. v. Danfoss A/S*, Opp. No. 91093658, 1998 TTAB LEXIS 460, at *2 n.2 (TTAB 1998).

The parties are precluded from filing any further summary judgment motions in this proceeding.

The proceeding is resumed. The proceeding schedule is reset as set forth below.

Plaintiff's Pretrial Disclosures Due	1/10/2025
Plaintiff's 30-day Trial Period Ends	2/24/2025
Defendant's Pretrial Disclosures Due	3/11/2025
Defendant's 30-day Trial Period Ends	4/25/2025
Plaintiff's Rebuttal Disclosures Due	5/10/2025
Plaintiff's 15-day Rebuttal Period Ends	6/9/2025
Plaintiff's Opening Brief Due	8/8/2025
Defendant's Brief Due	9/7/2025
Plaintiff's Reply Brief Due	9/22/2025
Request for Oral Hearing (optional) Due	10/2/2025

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121-2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).