

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

CME

Mailed: May 13, 2016

Opposition No. 92062714

*Diamond Hong, Inc. &  
H&C Trading Co. Inc.*

v.

*Zheng Cai d/b/a Tai Chi Green Tea Inc.*

**Christen M. English, Interlocutory Attorney:**

On May 11, 2016, pursuant to the Board's order of April 8, 2016, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1) and (a)(2). Kenneth Cang Li appeared on behalf of Petitioner, Respondent appeared *pro se*,<sup>1</sup> and the assigned Interlocutory Attorney, Christen English, participated on behalf of the Board.

The Board advised Respondent that it is generally recommended that parties retain an experienced trademark practitioner to represent them in Board proceedings. The Board also indicated that Respondent will be required to comply with all applicable rules and procedures regardless of whether Respondent retains counsel to represent him in this proceeding. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

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<sup>1</sup> Information for parties' representing themselves was provided in the Board's order of January 5, 2015.

During the teleconference, the parties agreed to accept formal service of papers by email pursuant to Trademark Rule 2.119(b)(6). Petitioner's email address for service is kennethcli@hotmail.com and Respondent's email address for service is zanecai@yahoo.com.

The parties have not discussed settlement, but counsel for Petitioner indicated that he will discuss the possibility of settlement with his client. The Board strongly encourages the parties to work together to resolve this proceeding, if possible.

The Board addressed the pleadings during the discovery conference noting that Opposer has sufficiently alleged its standing and a claim for priority and likelihood of confusion.<sup>2</sup> The Board, however, noted that the copies of the certificates of registration for Petitioner's pleaded registrations attached to the petition for cancellation do not show the current status and title of Petitioner's pleaded registrations. Accordingly, Petitioner's pleaded registrations are not of record in this proceeding. *See* Trademark Rule 2.122(d); TBMP § 317 (2015).

The ESTTA cover sheet to the petition for cancellation also indicates that Petitioner intended to allege a claim of fraud and that Respondent's mark is deceptive pursuant to Section 2(a) of the Trademark Act. As discussed during the teleconference, Petitioner has not adequately pleaded the elements of a claim for deceptiveness, namely, that: (1) the applied for mark consists of or contains a term that misdescribes the character, quality, function, composition or use of the goods;

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<sup>2</sup> The petition for cancellation references Sections 32 and 43 of the Trademark Act, 15 U.S.C. §§ 1114 and 1125. The Board explained to Petitioner that these sections of the Trademark Act are not applicable to this proceeding. Rather, Petitioner's claim of priority and likelihood of confusion will be considered pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

(2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods. *See, e.g. In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009 (TTAB 2006). As discussed during the conference, the facts of this case do not appear to present a claim for deceptiveness.

Petitioner also has not adequately pleaded a claim of fraud. Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a specific false, material representation of fact in connection with an application to register, with the intent of obtaining a registration to which he is otherwise not entitled. *See In re Bose Corp.*, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010). A claim of fraud must set forth all elements of the claim with a heightened degree of particularity in compliance with Fed. R. Civ. P. 9(b). *See Asian and W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478-79 (TTAB 2009). In addition, intent to deceive the USPTO is a specific element of a fraud claim, and must be sufficiently pleaded. *In re Bose*, 91 USPQ2d at 1939-1941; *Asian and W. Classics*, 92 USPQ2d at 1479.

Petitioner is allowed until **June 6, 2016** to file an amended complaint that includes an adequately pleaded claim of fraud. Respondent is allowed until **June 26, 2016** to file an answer to any amended complaint. As discussed during the teleconference, in answering any amended complaint, Respondent "should not argue the merits of the allegations in a complaint but rather should state, as to each of the

allegations contained in the complaint, that the allegation is either admitted or denied” or that he does not have sufficient information to admit or deny the allegation. Trademark Trial and Appeal Board Manual (“TBMP”) § 311.02 (2015). It may be helpful for Respondent to review Section 311 of the TBMP prior to filing an answer to any amended complaint.

The Board next discussed ways to streamline this case by using Accelerated Case Resolution (“ACR”) or ACR-like efficiencies such as the possibility of taking testimony by declaration, subject to the right of either party to cross examine, if desired. Counsel for Petitioner indicated that he will discuss the possibility of ACR with his client. If the parties wish to further explore ACR, the following materials may be helpful:

1. General Description of ACR:

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf](http://www.uspto.gov/trademarks/process/appeal/Accelerated%20Case%20Resolution%20ACR%20notice%20from%20TTAB%20webpage%2012%2022%2011.pdf);

2. FAQs on ACR:

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution \(ACR\) FAQ updates 12 22 11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated%20Case%20Resolution%20ACR%20FAQ%20updates%2012%2022%2011.doc);

3. List of cases employing ACR-like efficiencies:

[http://www.uspto.gov/trademarks/process/appeal/ACR Case List \(10-23-12\).doc](http://www.uspto.gov/trademarks/process/appeal/ACR%20Case%20List%20(10-23-12).doc);  
and

4. TBMP Sections 528.05(a)(2), 702.04 and 705.

The Board’s standard protective order is applicable herein by operation of Trademark Rule 2.116(g) and available here:

<http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>

The parties are encouraged to acknowledge their obligations under the protective order in writing, and may utilize the following form:

<http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmnt.jsp>

The Board is available for future telephone conferences to resolve contested matters, address scheduling issues, assist the parties in developing stipulations of fact or negotiating an ACR plan, and to address other issues, as necessary, to move this case forward efficiently.

Finally, a party may not serve discovery requests or a motion for summary judgment until after the party has made initial disclosures.

Dates are reset as follows:

Time to File Amended Complaint	<b>6/6/2016</b>
Time to Answer	<b>6/26/2016</b>
Discovery Opens	<b>OPEN</b>
Initial Disclosures Due	<b>8/25/2016</b>
Expert Disclosures Due	<b>12/23/2016</b>
Discovery Closes	<b>1/22/2017</b>
Plaintiff's Pretrial Disclosures Due	<b>3/8/2017</b>
Plaintiff's 30-day Trial Period Ends	<b>4/22/2017</b>
Defendant's Pretrial Disclosures Due	<b>5/7/2017</b>
Defendant's 30-day Trial Period Ends	<b>6/21/2017</b>
Plaintiff's Rebuttal Disclosures Due	<b>7/6/2017</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>8/5/2017</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

***Information for Pro Se Parties***

Patent and Trademark Rule 11.14 permits an entity to represent itself, but it is strongly advisable for a party who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The United States Patent and Trademark Office (USPTO) cannot aid in the selection of an attorney. As the impartial decision maker, the Board may not provide legal advice; it may provide information solely as to procedure.

Any party who does not retain counsel should be familiar with the authorities governing this proceeding, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP), and the Trademark Rules of Practice (37 C.F.R. Part 2), both accessible directly from the Board's web page: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Also on the Board's web page are links to ESTTA, the Board's electronic filing system<sup>3</sup> at <http://estta.uspto.gov>, and TTABVUE, for case status and prosecution history at <http://ttabvue.uspto.gov/ttabvue>.

Trademark Rules 2.119(a) and (b) require that every paper filed in the USPTO in a proceeding before the Board must be served upon the attorney for the other

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<sup>3</sup> The Board strongly encourages parties to file all papers through ESTTA, which operates in real time and provides a tracking number that the filing has been received. For assistance in using ESTTA, call 571-272-8500.

party, or on the party if there is no attorney. Proof of service must be made before the paper will be considered by the Board. Accordingly, copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

**I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (name and address of opposing counsel or party).**

**Signature** \_\_\_\_\_

**Date** \_\_\_\_\_

Strict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

This *inter partes* proceeding is similar to a civil action in a federal district court. The parties file pleadings and a range of possible motions. This proceeding includes designated times for disclosures, discovery (discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, to ascertain the facts underlying an adversary's case), a trial period, and the filing of briefs. The Board does not preside at the taking of testimony; all testimony is taken

out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.

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