

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Saravana Bhavan USA, Inc.

v.

Madras Sarvana Bhavan, Inc.

Opposition No. 91153146 to Application
Serial No. 76316504 filed September 24, 2001

Julian W. Wells for Saravana Bhavan USA, Inc.

Laurence P. Colton for Madras Sarvana Bhavan, Inc.

Before Hanak, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Madras Sarvana Bhavan, Inc. (applicant) seeks to register in typed drawing form MADRAS SARAVANA BHAVAN for "restaurant services." The application was filed on September 24, 2001 with a claimed first use date of August 10, 2001. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use MADRAS apart from the mark in its entirety.

On September 13, 2002 Saravana Bhavan USA, Inc. (opposer) filed a Notice of Opposition alleging that it is

the owner of the service mark and trade name SARAVANA BHAVAN for restaurant services, and that said service mark and trade name are "well known by reputation in the United States." (Notice of Opposition paragraph 4). Citing Section 2(d) of the Trademark Act, opposer alleges that applicant's mark when used in connection with restaurant services is likely to cause confusion, mistake and deception vis-à-vis opposer's mark SARAVANA BHAVAN. (Notice of Opposition paragraph 7). In addition, citing Section 2(a) of the Trademark Act, opposer alleged that applicant's mark "falsely suggests a connection with [opposer's mark and name] SARAVANA BHAVAN, the famous restaurant chain in India and the United States." (Notice of Opposition paragraph 7).

Applicant filed an answer which denied the pertinent allegations of the Notice of Opposition. Opposer and applicant filed briefs. Neither party requested a hearing. The record in this case is set forth at page 8 of applicant's brief, and in its reply brief opposer in no way challenges applicant's description of the record.

At the outset, two matters need to be disposed of. First, in paragraph 7 of its Notice of Opposition opposer alleged that applicant's mark falsely suggests a connection with opposer's "SARAVANA BHAVAN, the famous restaurant

chain in India and the United States." In its brief and reply brief, opposer never argued its allegation pursuant to Trademark Act Section 2(a) that applicant's mark falsely suggests a connection with opposer. Accordingly, we will give no further consideration to opposer's false suggestion of a connection claim pursuant to Section 2(a) of the Trademark Act. Moreover, if we did, opposer's claim would fail on its merits, as we will discuss later.

Second, for the first time in its brief at page 15 opposer argues that "opposer's mark is so famous that it also warrants protection under the Anti-Dilution Statute," citing Section 43(c)(1) of the Trademark Act. However, because the issue of dilution was neither pled in the Notice of Opposition nor tried by the consent of the parties, we will give no further consideration to it. Moreover, even if we considered this claim, said claim lacks any merit because opposer has totally failed to prove that its service mark is famous in the United States even under the guidelines of Section 2(d), much less under the far stricter guidelines of the Federal Trademark Dilution Act of 1995, Section 43(c)(1) of the Trademark Act. See Toro Co. v. ToroHead Inc., 61 USPQ2d 1164, 1180 (TTAB 2001) ("Fame for dilution purposes is difficult to prove ... The party claiming dilution must demonstrate by the

evidence that its mark is truly famous."). See also Avery Dennison Corp. v. Sumpton, 189 F.3d 1868, 51 USPQ2d 1801, 1805 (9th Cir. 1999) ("The Federal Trademark Dilution Act of 1995 applies only to a very select class of marks - those with such powerful consumer associations that even non-competing uses can impinge upon their value.").

We will now consider the only claim of opposer which has been pled and argued, namely, that applicant's mark MADRAS SARAVANA BHAVAN for restaurant services is likely to cause confusion, mistake or deception pursuant to Section 2(d) of the Trademark Act vis-à-vis opposer's service mark and trade name SARAVANA BHAVAN for restaurant services. In order to make a successful claim pursuant to Section 2(d) of the Trademark Act, the party plaintiff must first establish that its rights in its mark or trade name are "superior to his opponent's [applicant's]." Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990). See also Otto Roth v. Universal Foods, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981).

The facts herein establish that as between opposer and applicant, applicant's rights in its mark MADRAS SARAVANA BHAVAN are superior to whatever rights opposer may have in its mark and name SARAVANA BHAVAN. Accordingly, opposer's Section 2(d) claim must fail.

To elaborate, even opposer concedes that applicant first used its mark MADRAS SARAVANA BHAVAN in connection with restaurant services in Atlanta in 2001. (Opposer's brief page 2). Opposer further concedes that it did not open "its first domestic restaurant in California with the name SARAVANA BHAVAN" until October 14, 2002. (Opposer's brief page 3, footnote 2 emphasis added). Thus, opposer's Section 2(d) claim must fail because whatever rights opposer has in the United States in its mark and name SARAVANA BHAVAN are inferior to applicant's rights in the United States in its mark MADRAS SARAVANA BHAVAN.

However, opposer argues that its mark SARAVANA BHAVAN had become famous in India prior to applicant's first use of MADRAS SARAVANA BHAVAN in the United States as a result of opposer's use of SARAVANA BHAVAN in India for more than twenty years. According to opposer, applicant was aware of opposer's use in India of its mark SARAVANA BHAVAN for restaurant services before applicant first used its mark MADRAS SARAVANA BHAVAN in Atlanta, Georgia in 2001.

Even assuming for the sake of argument that opposer's mark SARAVANA BHAVAN had become famous in India and that applicant was aware of opposer's mark SARAVANA BHAVAN before applicant adopted its mark MADRAS SARAVANA BHAVAN in the United States in 2001, nevertheless, opposer's Section

2(d) claim must fail because opposer has simply not established superior rights in its mark or trade name in the United States before applicant first used (and indeed applied to register) its mark in the United States.

Person's Co. Ltd. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990) ("Such foreign use has no effect on U.S. commerce and cannot form the basis for a holding that appellant has priority here. The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme.").

It is true that in Person's the Court stated that "there is some case law" supporting the contention that if a party plaintiff's mark has, as a result of extensive foreign use, become famous in the United States prior to the time that the party defendant knowingly adopted its mark in the United States, that the party plaintiff might under such circumstances enjoy superior rights in the United States. Person's, 14 USPQ2d at 1480-81.

However, in this case opposer has utterly failed to establish that its mark was even known (much less that it was famous) in the United States prior to applicant's first use of its mark in the United States in 2001. The vast majority of opposer's rather modest showing that its mark

is "famous" consists of photocopies of publications originating in India which make mention of opposer's restaurants using the mark SARAVANA BHAVAN. However, even if we were to find that such articles appearing in publications originating in India established that opposer's mark was famous in India (and we do not), such mentions of opposer's mark in publications originating in India would not establish that opposer's mark is famous in the United States. Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1405 (TTAB 1998) ("Only the fame of opposer's mark amongst consumers in the United States is of relevance to us. The renown of opposer's marks outside the United States or exposure of the foreign public to opposer's marks is irrelevant. ... Therefore, we sustain applicant's objections on the ground of relevance to those exhibits that are excerpts from foreign publications or do not clearly indicate that the publications are U.S. publications.").

Opposer has made of record photocopies of pages from just two United States publications where its mark received very brief mention. Such brief mention of opposer's mark in but two United States publications simply does not establish that opposer's mark is even known in the United States, much less that it is famous in the United States.

Moreover, these two U.S. publications suffer an additional fatal defect, namely, that they were published at times after opposer conceded that applicant first used (and applied to register) its mark in the United States, namely, in Atlanta in 2001. The first publication is The New York Times of November 30, 2003, and the second publication is San Francisco of August 2002.

In sum, we find that opposer's Section 2(d) claim is fatally flawed because opposer has failed to establish superior rights in its mark or name vis-à-vis applicant's applied for mark. As for opposer's claim pursuant to Section 2(a) that applicant's mark falsely suggests a connection with opposer, not only did opposer fail in its briefs to even argue its purported claim pursuant to Section 2(a), but in addition said claim would fail on its merits because a Section 2(a) claim of false suggestion of connection, like a Section 2(d) claim, requires that the party plaintiff's rights are superior to the party defendant's rights. As for opposer's "claim" pursuant to the Federal Trademark Dilution Act of 1995, not only did opposer not plead such a claim, but moreover, said claim was not tried by the consent of the parties. Even if such claim had been properly pled or tried by the consent of the parties, we would rule against opposer on the merits of

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said claim inasmuch as opposer has not even proven that its mark was even known in the United States before September 2001, much less that its mark was famous in the United States, and certainly much less that opposer's mark was (or even is) extremely famous in the United States.

Decision: The opposition is dismissed.