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

Faint

Mailed: September 24, 2008

**Opposition No. 91178534**

Brathibbe Sethuraman

v.

Ramesh Sethuraman

**Opposition No. 91180875**

Ramesh Sethuraman

v.

Brathibbe Sethuraman

**Before Bucher, Kuhlke and Bergsman,**
**Administrative Trademark Judges.**

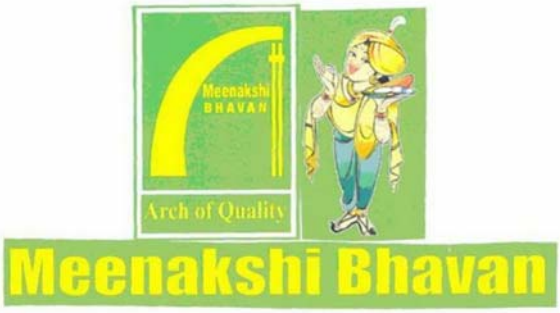
**By the Board:**

This case comes up on Dr. Brathibbe Sethuraman's (hereinafter "Dr. B") motion to amend the notice of opposition in Opposition No. 91178534 to add claims of deceptiveness and false association under Trademark Act Section 2(a), and Ramesh Sethuraman's (hereinafter "Mr. R") motion for summary judgment filed in each proceeding on the

claims of priority and likelihood of confusion.[1] All motions have been briefed.

On April 17, 2008, the Board consolidated the two above-captioned proceedings because they involve the same parties and common questions of fact and law (*i.e.*, while the parties are reversed in each opposition, the issues of priority and likelihood of confusion to be decided by the Board are identical).

On August 17, 2006, Mr. R filed an intent-to-use application to register the mark




for "restaurant, cafeterias and catering services," in International Class 43.[2]

On October 30, 2006, Dr. B filed an intent-to-use application for the mark

[1] In its April 17, 2008 consolidation order, the Board informed the parties that Mr. R's motion for judgment on the pleadings would be treated as a motion for summary judgment and allowed additional briefing by the parties.

[2] Application Serial No. 78954836. A disclaimer of "BHAVAN" is of record. A translation statement for "Bhavan" as "House" is of record.

for "restaurant services," in International Class 43.[3]

*Motion to Amend in Opposition No. 91178534*

The motion to amend the notice of opposition seeks to add claims under Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a), for deceptiveness and false suggestion of a connection.[4]

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law, would be prejudicial to the rights of the adverse party, or parties, or would be futile. *See* Fed. R. Civ. P. 15(a); and TBMP § 507.02 (2d ed. rev. 2004). In deciding a motion for leave to amend, the Board must consider whether there is any undue prejudice to the non-movant and whether the amendment is legally sufficient and not futile. *See, e.g.,*

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[3] Application Serial No. 77032288. A disclaimer of "BHAVAN", "UNAVAGAM" and "SEIVA SUVAIYAGAM" is of record. A translation statement for "Bhavan" as "House" is of record. A transliteration statement for the non-Latin characters in the mark is of record and notes that "Unavagam" translates as "Eating Place," and "Seiva Suvaiyagam" translates as "Vegetarian Eating Place."

[4] The pleading also seeks to add a count under Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064, that use of the mark "misrepresents the source of the goods or services." However, Section 14 of the Trademark Act is not applicable to opposition proceedings because it is limited to registered marks. Moreover, the claim appears to duplicate the allegations with respect to

*Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702-03 (TTAB 2002)(finding motion for leave to amend opposition futile where proposed amended claims lack essential elements and are legally insufficient).

The amended notice of opposition seeks to add in part, the following factual allegations in support of its claims under Section 2(a):

> 1. Opposer is using the MEENAKSHI BHAVAN logo in franchising of restaurants in the United States for restaurant services and plans to open restaurants in the United States under the MEENAKSHI BHAVAN name and logo.
>
> 2. The principal of MEENAKSHI BHAVAN, LLC is also the Managing Partner of 'Sriram Caterers', a catering service provider that has been running an Indian Vegetarian Restaurant in India, under the brand name of 'MEENAKSHI BHAVANI' since January 27, 1998. The restaurant in India has been operating at the same address since its inauguration in 1998 which is 141 Collector Office Road, Anna Bus Stand, Maduai [sic] - 625020, Taiml [sic] Nadu, India. It can be accessed in the United States through its website www.sr-cat.com. This is a family owned business with international rights given to Opposer.
>
> 3. The Respondent filed for the MEENAKSHI BHAVAN logo, serial number 78954836, which involves the exact same logos and trademarks used by Sriram Caterers since 1998.
>
> 4. Applicant had previous knowledge of Opposer's rights in the 'MEENAKSH BHAVAN' [sic] marks as a relative of the family.
>
> 5. Applicant had previous knowledge that Applicant's use of the MEENAKSHI BHAVAN logo falsely suggests an association with, or approval by Sriram Caterers, and will inevitably create confusion in the marketplace, as customers will assume Applicant's goods are

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deception and false association. Accordingly, the motion to amend is denied with respect to this count.

> authorized or endorsed by Sriram Caterers and Opposer. Such false association will cause harm to Opposer.

As to the deceptiveness claim, the deceptiveness must be as to the nature or meaning of the mark in relation to the services. *See e.g., In re Budge Manufacturing Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

The proposed amended pleading has no allegations as to how the use of the mark by Mr. R would be deceptive in relation to the services, and there is nothing in the proposed amendments that would allege plausibility or materiality of a Section 2(a) deceptiveness claim.

As to the false suggestion of a connection claim, BS must plead (and prove) the following:

1. Defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
2. That the defendant's mark would be recognized as such;
3. That the plaintiff (Dr. B) is not connected with the activities performed by the defendant under the mark; and,
4. That plaintiff's (Dr. B) name or identity is of sufficient fame or reputation that when the defendant's mark is used in connection with its services, a connection with the plaintiff would be presumed.

*Consolidated Natural Gas Co v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985), *citing Buffett v. Chi Chi's*, 226 USPQ 428, 429 (TTAB 1985). However, Dr. B has not pleaded any facts that would establish that the defendant's mark is

the same or a close approximation of the plaintiff's previously used name or identity, that the defendant's mark would be recognized as a close approximation of the plaintiff's previously used name or identity, or the fame or reputation of her mark in the United States, nor even fame in India, and these are necessary elements of the claim.

Accordingly, because we find that the proposed claims under Section 2(a) are legally insufficient, the motion to amend the notice of opposition is denied.[5]

*Motion for Summary Judgment*

We turn now to Mr. R's motions for summary judgment in his favor in each of these proceedings on the ground of priority and likelihood of confusion.

Summary judgment is appropriate when there is no genuine issue of material fact in dispute and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c). A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be

[5] We hasten to add, however, that even if the amendment had been allowed, it would have no effect on our summary judgment decision which follows.

resolved in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

When the moving party's summary judgment motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment as a matter of law, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. *See* Fed. R. Civ. P. 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

A party moving for summary judgment in its favor on a priority and likelihood of confusion claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark or marks or the owner of a valid and subsisting federally registered mark; and (3) contemporaneous use of the parties' respective marks on their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v.*

*Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001); see also, *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

There are no questions as to standing or similarity of the marks and services in these cases, as each of the parties has filed an intent-to-use trademark application for nearly identical marks, and legally identical services. The sole issue that remains is one of priority.

To establish priority on a likelihood of confusion claim brought under Section 2(d) of the Trademark Act, a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States … and not abandoned …." 15 U.S.C. § 1052(d).

A party who has filed an intent-to-use application may rely on the filing date of its application to establish priority. *See Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1845 n. 7 (TTAB 1995) (constructive use provisions may be used both defensively and offensively to establish priority); *see also, Zirco Corp. v. American Telephone & Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (right to rely on constructive use date comes into existence with filing of intent-to-use application).

Mr. R argues that because his application has the earlier filing date, and because Dr. B has not provided

evidence of any earlier use in the United States, Mr. R is entitled to judgment as a matter of law.

In response, Dr. B argues that there are a number of disputed facts that still need to be decided, including first use of the mark in the United States, rights in the marks and whether or not Mr. R has unclean hands or committed fraud based on his knowledge of Dr. B's prior rights to the mark.[6] The only evidence she provides in support, however, are letters from principals of Sriram Caterers in India. These letters were not supported by any affidavits or declarations and will not be considered.[7] *See Racciopp i v. Apogee Inc.,* 47 USPQ2d 1368, 1369-70 (TTAB 1998). There is no evidence to establish any use of Dr. B's mark in the United States for a date prior to the intent-to-use application filing date of October 30, 2006.

Because Mr. R's intent-to-use application has the earlier filing date of August 17, 2006, he may rely on this constructive use date to establish his priority. Thus even viewing the arguments and evidence in a light most favorable

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[6] We note that fraud has not been pled, and was not part of the proposed amended pleading.

[7] Documents or other exhibits that are not self-authenticating may be admissible as evidence on a motion for summary judgment pursuant to Fed. R. Civ. P. 56(e), provided that they are authenticated by and attached to an affidavit or declaration. *See* 10A Charles A. Wright, Arthur R. Miller and Mary Kay Kane, *Fed. Prac. & Proc. Civ. 3d* § 2722 (WESTLAW update 2008). Even if these letters were considered they are not sufficient to raise a genuine issue regarding priority inasmuch as they do not provide any information about use of the mark in the United States. *See Person's Co. Ltd. v. Christman*, 14 USPQ2d 1477 (Fed. Cir. 1990).

to the non-movant, we find that there are no genuine issues of material fact as to this issue.

Accordingly, the motions for summary judgment are granted and judgment in favor of Mr. R is hereby entered, subject to Mr. R's establishment of constructive use through the registration of his mark. The time for filing an appeal or for commencing a civil action will run from the date of the present decision. *See* Trademark Rules 2.129(d) and 2.145; and TBMP § 901.02(b) (2d ed. rev. 2004). In Opposition No. 91178534, the notice of opposition is dismissed and Application Serial No. 78954836 will go forward for issuance of a Notice of Allowance. In Opposition No. 91180875, the opposition is sustained and registration as to application Serial No. 77032288 is refused. When Mr. R's mark has been registered or the application becomes abandoned, Mr. R should inform the Board, so that appropriate action may be taken to terminate these proceedings.

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