

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed:  
April 30, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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**Trademark Trial and Appeal Board**  
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Tantra One LLC

v.

Tita's Inc.

—————  
Cancellation No. 92043607  
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Bruce B. Brunda of Stetina Brunda Garred & Brucker for  
Tantra One LLC.

Gustavo Sardina of Rothstein Rosenfeldt Adler for Tita's  
Inc.

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Before Hairston, Zervas and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Tantra One LLC ("petitioner") has filed a petition to  
cancel Registration No. 2274115 for the mark TANTRA for  
restaurant services owned by Tita's Inc. ("respondent").<sup>1</sup>  
Petitioner has alleged that respondent's mark TANTRA for  
restaurant services is likely to cause confusion with its  
previously used TANTRA mark for restaurant services.  
Petitioner specifically alleged that its restaurant services

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<sup>1</sup> Registration No. 2274115, issued August 31, 1999; Section 8  
declaration filed and accepted. Although the petition for  
cancellation was filed on August 16, 2004, respondent filed, and  
the U.S. Patent and Trademark Office acknowledged, respondent's  
Section 15 declaration filed on August 30, 2005.

identified by the mark TANTRA are "known in the industry as TANTRA, CUISINE OF INDIA or TANTRA'S INDIA OVEN."<sup>2</sup>

Respondent denied the salient allegations in the petition for cancellation.<sup>3</sup>

Preliminary Issue

On November 30, 2006, petitioner filed a "Motion for Leave to File Testimony From Other Proceedings." Respondent did not oppose the motion. Specifically, the testimony from another proceeding that petitioner seeks to introduce in this proceeding is the affidavit of respondent's principal, Timothy Hogle, submitted in a civil action in support of respondent's opposition to petitioner's motion to dismiss a civil action between the parties for lack of personal jurisdiction and improper venue, and a copy of the complaint in that civil action.<sup>4</sup>

Trademark Rule 2.122(f), 37 CFR §2.122(f), reads as follows:

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<sup>2</sup> There is no evidence that petitioner ever used the mark TANTRA, CUISINE OF INDIA. In addition, petitioner never refers to TANTRA, CUISINE OF INDIA in its briefs.

<sup>3</sup> Respondent also pleaded 7 enumerated affirmative defenses that it never pursued, including laches and the claim that the petition is time barred. The other affirmative defenses merely amplify respondent's arguments why there is no likelihood of confusion. The final affirmative defense is respondent's reservation of the right to amend its affirmative defenses to comport with the evidence. Respondent never sought to amend its affirmative defenses even though it argued that petitioner had abandoned its use of TANTRA'S INDIA'S OVEN in 1992. (Petitioner's Brief, pp. 13-14).

<sup>4</sup> *Tita's Inc. v. Tantra One, LLC*, Civil Action No. 06-60812, in the United States District Court for the Southern District of Florida; dismissed.

By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

The Board construes "testimony" as meaning only trial testimony, or a discovery deposition that was used, by agreement of the parties, as trial testimony in the other proceeding. TBMP §704.13 (2<sup>nd</sup> ed. rev. 2004). See also *MarCon Ltd. v. Avon Products, Inc.*, 4 USPQ2d 1474, 1475 n.3 (TTAB 1987). Therefore, an affidavit and a complaint are not admissible as "testimony taken in another proceeding" pursuant to the Board's rules of practice. In view thereof, petitioner's "Motion for Leave to File Testimony From Other Proceedings" is denied, and the affidavit of respondent's principal and the complaint in the civil action will be given no consideration.<sup>5</sup>

#### The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the registration file

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<sup>5</sup> We note, however, that even if we had granted the petitioner's motion and considered Mr. Hogle's affidavit and the complaint in the civil action, those documents would not change our decision in this case.

for respondent's mark. The record also includes the following testimony and evidence:

A. Petitioner's Evidence.

1. Petitioner filed a notice of reliance for the following documents:

- a. Respondent's responses to petitioner's interrogatories; and,
- b. Printed publications;<sup>6</sup>

2. Testimony deposition of Rodolfo Guardada, produce deliveryman;

3. Testimony deposition of Timothy J. Davis, one of petitioner's customers;

4. Testimony deposition of Chara Kingra, the Assistant Manager of petitioner's restaurant located in Silver Lake, California;

5. Testimony deposition of Navraj Singh, petitioner's General Partner, with attached exhibits; and,

6. Rebuttal testimony deposition of Navraj Singh.

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<sup>6</sup> Trademark Rule 2.122(e), 37 CFR 2.122(e), reads so far as pertinent that, "Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered." Because Exhibits B-D, and O are excerpts from websites, we have not given them any consideration unless they were properly introduced and authenticated through a deposition.

B. Respondent's Evidence.

1. Respondent submitted a notice of reliance on the following items:

- a. Petitioner's responses to respondent's second set of interrogatories;<sup>7</sup>
- b. Official records on file with the state of California regarding the corporate status of India's Oven, Inc. and Royal's India's Oven, Inc.; and,

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<sup>7</sup> Respondent proffered its own responses to petitioner's interrogatories through the notice of reliance. However, Trademark Rule 2.123(j)(5) provides that "an answer to an interrogatory . . . may be submitted and made part of the record only by the receiving or inquiring party." Nevertheless, respondent's discovery responses are in evidence because petitioner introduced them into evidence.

Respondent also submitted documents produced by petitioner in response to respondent's request for production of documents citing "Trademark Rule 2.120(k)." We have given those documents no consideration. First, there is no Rule 2.120(k). Second, Trademark Rule 2.120(j)(3)(ii) provides, that "a party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)." In summary, documents produced in response to a request for production of documents are not admissible through a notice of reliance unless they are the type of documents that are specifically admissible through a notice of reliance.

c. Various "printed publications, such as information available on the internet, newspaper articles, and magazine articles";<sup>8</sup> and,

2. Testimony deposition of Timothy Hogle, respondent's principal.

Standing

Petitioner operates a restaurant named TANTRA located at 3705 West Sunset Boulevard, Los Angeles, California.<sup>9</sup> This is sufficient to demonstrate that petitioner has a real interest in this proceeding, and therefore has standing. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

In order for petitioner to prevail on its Section 2(d) claim, it must prove that it has a proprietary interest in the marks TANTRA or TANTRA'S INDIA'S OVEN and that interest was obtained prior to either the filing date of respondent's application for registration or respondent's date of first use. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40,

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<sup>8</sup> Printouts of webpages, generally, are not admissible through a notice of reliance, and therefore we have not given them any consideration. See footnote 6.

<sup>9</sup> Singh Dep., pp. 6-7; Singh Rebuttal Dep., pp. 12-13.

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43 (CCPA 1981); *Miller Brewing Co. v. Anheuser-Busch Inc.*,  
27 USPQ2d 1711, 1714 (TTAB 1993).

Respondent filed its application for registration on May 27, 1998; however, it first used its mark in December 1997, when it opened its restaurant.<sup>10</sup> Accordingly, for purposes of determining priority of use, respondent's date of first use is construed as December 31, 1997. *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period). *See also Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB 1985) (evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use).

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<sup>10</sup> Hogle Dep., pp. 4, 14, and 33. Respondent incorrectly identified its pre-opening advertising as its September 1997 date of first use in the application for registration. (Hogle Dep., pp. 32-33). Pre-opening advertising falls under the penumbra of "use analogous to trademark use." Use analogous to trademark use "is non-technical use of a trademark in connection with the promotion or sale of a product under circumstances which do not provide a basis for an application to register, usually because the statutory requirement for use on or in connection with the sale of goods in commerce has not been met." *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993). Use analogous to trademark use is proven by advertising of sufficient clarity and repetition to create the required identification by a substantial portion of the public that might be expected to purchase the service. *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1883 (Fed. Cir. 1996). In this case, there is no evidence regarding the extent or effect of respondent's pre-opening advertising, and therefore respondent has not shown use analogous to trademark use prior to December 1997.

Establishing petitioner's first use date for the mark TANTRA is far more complex, and it has been made even more complicated because petitioner and respondent have treated the marks TANTRA'S INDIA'S OVEN and TANTRA as if they were one mark.<sup>11</sup> This is relevant because petitioner is, in essence, attempting to tack its first use of TANTRA'S INDIA'S OVEN onto its use of TANTRA. If tacking is permitted, petitioner may claim 1981 as its date of first use. On the other hand, if tacking is not permitted, petitioner may only claim July 24, 2002 as its date of first use.

A party seeking to "tack" its use of an earlier mark onto its use of a later mark for the same goods or services may do so only if the earlier and later marks are legal equivalents, or are indistinguishable from one another. To meet the legal equivalents test, the marks must create the same commercial impression, and cannot differ materially from one another. Thus, the fact that two marks may be confusingly similar does not necessarily mean that they are legal equivalents.

*Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1226 (TTAB 1993). See also *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir.

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<sup>11</sup> For example, in its brief, petitioner states that "the record clearly establishes that Mr. Navraj Singh first commenced use of the mark "Tantra" in 1981 when Tantra's India's Oven opened on Pico and Fairfax in Los Angeles." (Petitioner's Brief, pp. 6-7). See also Petitioner's Brief at p. 7 ("the depositions of three individuals . . . also indicate that 'Tantra' is part of the name since the restaurant opened in 1992").

1991), *quoting* 1 J. Gilson, Trademark Protection and Practice §3.03[1] at 3-67-68 (1990) ("What may seem minor to the trademark owner modifying his mark may, from the standpoint of maintaining continuous priority rights, result in an entirely new mark with its own, and later, priority").

TANTRA'S INDIA'S OVEN vs. TANTRA are clearly distinguishable and are not, therefore, legal equivalents. In part, the addition of the words "India's Oven" gives the mark TANTRA'S INDIA'S OVEN a connotation of cooking that is wholly absent from the mark TANTRA, *per se*. In view thereof, petitioner may not tack its use of the mark TANTRA'S INDIA'S OVEN onto the mark TANTRA.

Having found that petitioner may not tack its earlier use of the mark TANTRA'S INDIA'S OVEN onto its later use of the mark TANTRA, petitioner must prove it has a proprietary interest in either TANTRA or TANTRA'S INDIA'S OVEN that predates respondent's date of first use (December 31, 1997).

In 1981, Navraj Singh, petitioner's general partner, began operating TANTRA'S INDIA'S OVEN restaurant as a sole proprietorship. The restaurant was located at the corner of Pico and Fairfax in Los Angeles, California. On March 27, 1985, Mr. Singh formed India's Oven, Inc. to operate his

restaurant. Mr. Singh's restaurant was burned down during the 1992 riots in Los Angeles.<sup>12</sup>

In August 1992, India's Oven, Inc. opened a restaurant on Wilshire Boulevard, Los Angeles, California.<sup>13</sup> Although the sign on the building was INDIA'S OVEN,<sup>14</sup> the menus (in-house and take-out) displayed the name TANTRA'S INDIA'S OVEN.<sup>15</sup> Mr. Singh explained that the restaurant was located in a medical building and signage was limited.<sup>16</sup>

On May 29, 2001, Mr. Singh formed petitioner,<sup>17</sup> and on July 24, 2002, petitioner opened a restaurant named TANTRA located at 3705 West Sunset Boulevard, Los Angeles, California.<sup>18</sup> Petitioner's website refers to the name of the restaurant as TANTRA; and there is no mention of or reference to TANTRA'S INDIA'S OVEN.<sup>19</sup> The news stories regarding the new restaurant refer to it as TANTRA; and there is no reference to TANTRA'S INDIA'S OVEN in the news

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<sup>12</sup> Singh Dep., pp. 7-8 and 12; Kingra Dep., 8 (during Mr. Kingra's employment at the Pico/Fairfax restaurant from 1985-1992, the sign on the restaurant was TANTRA'S INDIA'S OVEN); Davis Dep. 7 (Mr. Davis patronized the TANTRA'S INDIA'S OVEN restaurant at Pico and Fairfax between 1981 and 1992).

<sup>13</sup> Singh Dep., pp. 9 and 13.

<sup>14</sup> Singh Dep., p. 9; Kingra Dep., pp. 6-7.

<sup>15</sup> Singh Dep., pp. 9, 13-15, Exhibits 4 and 5; Kingra Dep., pp. 7-9, 11; Davis Dep., pp. 8, 10, 13. Mr. Singh had no explanation why he authorized INDIA'S OVEN, and not TANTRA, on the sign. (Singh Dep., p. 40).

<sup>16</sup> Singh Dep., p. 10.

<sup>17</sup> Singh Dep., pp. 15-16, Exhibit 6

<sup>18</sup> Singh Dep., pp. 6-7, 10. Moreover, in its brief, petitioner states that its "current restaurant on Sunset Blvd. in Los Angeles is named 'Tantra.'" (Petitioner's Brief, p. 9).

<sup>19</sup> Singh Dep., Exhibit 8.

stories.<sup>20</sup> Petitioner's witnesses maintained the distinction between TANTRA'S INDIA'S OVEN restaurant and TANTRA restaurant. Mr. Davis testified that he had patronized petitioner's TANTRA restaurant, as well as TANTRA'S INDIA'S OVEN.<sup>21</sup> Mr. Kingra also testified regarding his employment at both the TANTRA restaurant and TANTRA'S INDIA'S OVEN.<sup>22</sup>

On November 30, 2006, Mr. Singh executed a *nunc pro tunc* assignment transferring the mark TANTRA and the goodwill associated therewith, to Tantra One, LLC from India's Oven, Inc. effective as May 29, 2001.<sup>23</sup>

TANTRA'S INDIA'S OVEN located on Wilshire was sold to a new owner at the end of 2006 or the beginning of 2007.<sup>24</sup>

Q. Do you currently own the Indian Oven (sic) on Wilshire?

A. No, I don't.

Q. Who owns that?

A. There is a new owner.

Q. Do you know when - - did you sell the Indian Oven (sic) to a new owner?

A. That's correct.

Q. And do you know when that occurred?

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<sup>20</sup> Singh Dep., Exhibit 9.

<sup>21</sup> Davis Dep., pp. 5-6.

<sup>22</sup> Kingra Dep., pp. 5-6, 8, 13.

<sup>23</sup> Singh Dep., p. 43, Exhibit 7.

<sup>24</sup> Singh Rebuttal Dep., p. 12.

A. A few months ago.<sup>25</sup>

Q. Two months ago?

A. A few months ago.<sup>26</sup>

Based on the evidence of record, we find that petitioner is currently operating a restaurant called TANTRA, and that Mr. Singh and/or India's Oven, Inc. are no longer operating a restaurant with the name TANTRA'S INDIA'S OVEN.

Respondent challenged the sufficiency of petitioner's chain of title to the mark TANTRA'S INDIA'S OVEN. However, it is clear from the record that Mr. Singh is the "leading light" or owner of a family enterprise engaged in the restaurant business. Over the years, Mr. Singh incorporated India's Oven, Inc. in 1985, and Tantra One LLC in 2001, and transferred the operation of his restaurants, including the use of the service marks, without disturbing their continuous operation. Accordingly, the use of the marks TANTRA'S INDIA'S OVEN, at Pico and Fairfax and on Wilshire Boulevard, and TANTRA on Sunset Boulevard, were for the benefit of and inured to the benefit of Mr. Singh. The determination by Mr. Singh that the ownership of the marks ultimately resides in petitioner does not create a break in the chain of title. Mr. Singh, India's Oven, Inc.,

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<sup>25</sup> The rebuttal testimony deposition of Mr. Singh was conducted on March 28, 2007.

<sup>26</sup> Singh Rebuttal Dep., p. 12.

and Tantra One, LLC are for all practical purposes the same entity, rendering the same services with substantially the same personnel, and therefore there has been a continuity of business operations by the entities.<sup>27</sup> See *Airport Canteen Services, Inc. v. Farmer's Daughter, Inc.*, 184 USPQ 622, 627 (TTAB 1974). However, those businesses were operated under different, but similar, marks: TANTRA'S INDIA'S OVEN and TANTRA.

As indicated above, petitioner is only using the service mark TANTRA. There is nothing in the record to indicate that petitioner is using TANTRA'S INDIA'S OVEN. Because petitioner is not using the mark TANTRA'S INDIA'S OVEN, it does not have a proprietary interest in that mark. Mr. Singh testified that he (or India's Oven, Inc.) sold the INDIA'S OVEN restaurant that displayed the mark TANTRA'S INDIA'S OVEN on the menus, and that his (petitioner's) new restaurant was called TANTRA. Because petitioner (through Mr. Singh or India's Oven, Inc.) is not using the mark TANTRA'S INDIA'S OVEN, it does not have a proprietary interest in it, and therefore petitioner must rely on its first use of the TANTRA service mark to prove priority of use.

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<sup>27</sup> Petitioner's evolution from casual dining to upscale restaurant services are a natural growth of petitioner's business, not the development of an entirely new business leading to an "assignment in gross." (Respondent's Brief, pp. 14-16).

This case is distinguishable from *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). In *West Florida Seafood*, petitioner introduced evidence proving its first use of its mark. However, because none of the evidence showed use during the two years prior to the filing of the petition for cancellation, the Board held that petitioner abandoned its mark. The Court reversed the Board's decision because the respondent failed to present any evidence to support abandonment and because petitioner did not have notice that abandonment was an issue and, therefore, could not present evidence to show its continued use. However, in this case, petitioner (through Mr. Singh) testified it was not using the mark TANTRA'S INDIA'S OVEN, and therefore petitioner failed to prove that it had a proprietary interest in the mark.

Because petitioner does not have a proprietary interest in the mark TANTRA'S INDIA'S OVEN, it cannot rely on that mark to establish its priority. Accordingly, petitioner must rely on its first use of the mark TANTRA to establish priority. Petitioner first used the mark TANTRA on July 24, 2002, four and one-half years after respondent's December 31, 1997 date of first use. In view of the foregoing, petitioner has failed to prove that it has a proprietary

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interest in TANTRA prior to that of respondent, and therefore petitioner's Section 2(d) claim fails.

Decision: The petition for cancellation is dismissed with prejudice.