

This Opinion is not a
Precedent of the TTAB

Mailed: February 10, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Arya Samaj Greater Houston
v.
Kavita Vachaknavee

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Opposition No. 91278867
—

Stephen S. Hodgson, Esq.,
for Arya Samaj Greater Houston

Kavita Vachaknavee, pro se.

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On Opposer's Request for Reconsideration
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Before Johnson, Acting Deputy Chief Administrative Trademark Judge, and Kuhlke and Casagrande, Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:

Opposer Arya Samaj Greater Houston timely requested reconsideration of the Board's final decision, dated November 20, 2024.¹ *See* 37 C.F.R. § 2.129(c). Applicant

¹ *See* 22 TTABVUE. The Board issued a Notice of Correction and Corrected Opinion on December 13, 2024. The only change reflected in the December 13 Corrected Opinion is a footnote not implicated by this reconsideration request.

Kavita Vachaknavee has not responded, but there is no requirement that the other party file a response to a request for reconsideration of a decision issued after final hearing. *See* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 543 (June 2024). Because the time for Applicant to respond has passed, the request is ripe for consideration. For the reasons below, we deny the request.

This opinion assumes familiarity with the November 20, 2024, final decision and December 13, 2024, Corrected Opinion.

“The purpose of a request for reconsideration is to show that, based on the evidence submitted and the prevailing authorities, the Board’s decision was erroneous and should be changed or modified.” *Nkanginieme v. Appleton*, No. 91256464, 2023 WL 2424119, at *2 (TTAB 2023) (citing *In re Berkeley Lights, Inc.*, No. 88895703, 2022 WL 15733123, at *2 (TTAB 2022));² *see also* TBMP § 543 (June 2024).

Opposer argues that the Board improperly dismissed its opposition.³ At trial, Opposer asserted one claim: that the application should be refused under Section 2(d) because Opposer has prior common law rights in the unregistered mark VSS GLOBAL. “A party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his

² This opinion is issued as part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases. Westlaw (WL) citations are used for precedential decisions of the Board. Decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals are cited only to the Federal Reporter (e.g., F.2d, F.3d, or F.4th). This opinion thus conforms to the practice set forth in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024).

³ *See* 22 TTABVUE 3-4.

term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through whatever other type of use may have developed a trade identity.” *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945 (Fed. Cir. 1990) (cleaned up; citation omitted); *see also id.* at 946 (“As to an unregistered term, such a likelihood of confusion results when there are trade identity rights in the prior user’s term. Those trade identity rights arise when the term is distinctive, either inherently or through the acquisition of secondary meaning.”). The Board dismissed the opposition because Opposer did not even argue at trial, let alone prove, that the mark in which it claimed rights, VSS GLOBAL, was inherently distinctive or had acquired distinctiveness.

Opposer does not argue that the Board incorrectly determined that Opposer had not provided proof or argument that its alleged VSS GLOBAL mark was either inherently distinctive or had acquired distinctiveness. Rather, it argues that “[t]here was no need for Opposer to present evidence” of distinctiveness, for two reasons.⁴ First, it says that the Examining Attorney examining Applicant’s application to register VSS GLOBAL “already determined” that the term is inherently distinctive.⁵ But this ignores that the reason we remanded Applicant’s application back to the examining attorney—notwithstanding that we dismissed the opposition—was that what little evidence there was in the record of this opposition strongly suggested that the term was not distinctive of the services, that the examining attorney did not

⁴ *See* 22 TTABVUE 3.

⁵ *See id.* at 3, 4-5.

appear to have addressed that potential ground for refusal, and that the examining attorney needed to address and expressly determine that issue. *See* Trademark Rule 2.131, 37 C.F.R. § 2.131. In addition, we point out that evidence bearing on whether a mark is distinctive or not can turn on how the owner uses it on, for instance, its website and advertising materials. *See, e.g., In re N.C. Lottery*, 866 F.3d 1363, 1367-68 (Fed. Cir. 2017) (descriptiveness case); *In re Gould Paper Corp.*, 834 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (genericness case); *In re Central Counties Bank*, No. 73153633, 1981 WL 48125, at *5 (TTAB 1981) (acquired distinctiveness case). As a result, it is possible that one party could use a term in a distinctive way for given goods or services, yet another party might use the same term in a nondistinctive way for the identical goods or services. Thus, the concept that a determination that an applicant's mark is distinctive transfers to an opposer's use of an identical term is legally problematic.

Opposer's second excuse for concededly not attempting to prove distinctiveness is that there is an exception for opposition plaintiffs who are asserting common law rights in a mark identical to the one they're opposing.⁶ In other words, according to Opposer, only opposers asserting non-identical unregistered marks have to prove that their marks are distinctive. We see no such exception in *Tower*. *See also Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1332 (CCPA 1981) ("Under section 2(d), as utilized in an opposition, confusion, or a likelihood thereof, is not recognized where one claiming to be aggrieved by that confusion ... has not proved that that which he

⁶ *See* 22 TTABVue 3-4.

claims identifies him as the source of goods or services actually does so.”); *Threshold.TV, Inc. v. Metronome Enters., Inc.*, No. 91152662, 2010 WL 3164750, at *5 (TTAB 2010) (both parties asserting rights in the term BLACKBELT TV). That is because the rule clearly stated in *Towers* (and in *Otto Roth*) stems from Section 2(d) itself. Section 2(d) makes no exception for allegedly identical marks. It requires that, to be the basis of a likelihood of confusion refusal, any designation “previously used” must be a “mark or trade name.” The “trade identity rights” that qualify a previously-used term as a mark or trade name that can be the basis of a Section 2(d) claim “arise when the term is distinctive, either inherently or through the acquisition of secondary meaning.” *Towers*, 913 F.2d at 946.

We therefore reject Opposer’s argument that we erred in dismissing the opposition.

Opposer also argues that we should not have remanded the application for further examination. It says this is “unfair” and “inefficient,” noting that, if Applicant convinces the examining attorney on remand that its mark is distinctive, Opposer might have to file another opposition.⁷ First, we note that, if, on remand, Applicant fails to prove distinctiveness, there will be nothing for Opposer to oppose.⁸ Second,

⁷ See 22 TTABVUE 6.

⁸ Under Section 1(f) of the Trademark Act, 15 U.S.C. § 1051(f), Opposer is permitted to “submit for consideration for inclusion in the record of an application evidence relevant to a ground for refusal of registration.” See also Trademark Rule 2.149, 37 C.F.R. § 2.149 (procedures for third-party submission of relevant evidence during examination through letters of protest). If Opposer does not wish to wait to see if Applicant’s application is allowed after the ordered remand, it can avail itself of this procedure while the application is being examined for distinctiveness.

Opposer shares responsibility for any so-called “inefficiency” because it wholly failed to argue, let alone demonstrate, at trial that its “term is distinctive of [its services], whether inherently or through the acquisition of secondary meaning or through whatever other type of use may have developed a trade identity.” *Towers*, 913 F.2d at 945. That is a bedrock element of any Section 2(d) claim based on an unregistered term. If Opposer had addressed and proved this required element (and assuming we also found that Opposer established distinctiveness before Applicant and likelihood of confusion), we would have refused the application.

Opposer urges us (as opposed to the examining attorney on remand) to determine that Applicant’s mark is not distinctive.⁹ But Opposer neither pleaded nor asserted at trial that Applicant’s mark is not distinctive and should not be registered on that basis. The Board cannot reach out and make such a ruling against Applicant, who was not on notice of any such claim. *See generally* TBMP § 314 (“A plaintiff may not rely on an unpleaded claim.”) (citing cases). That is precisely why a remand of Applicant’s application is indicated. *See* 37 C.F.R. § 2.131.

We therefore adhere to our decision to remand the application for further examination.

Decision: Opposer’s request for reconsideration is **DENIED**.

⁹ *See* 22 TTABVue 9.