

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

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Butler

Mailed: November 19, 2009

Opposition No. 91172885

AYUSH HERBS, INC.

v.

HINDUSTAN LEVER LTD. CO.

Before Quinn, Kuhlke and Mermelstein, Administrative Trademark  
Judges.

By the Board:

Applicant seeks to register the mark AYUSH for "medical services; providing hygienic care for human beings; medical clinics; health spa services, namely, ayurvedic also known as holistic health treatment, therapy center for personal care, and advice on positive health, physical therapy, stress relief, aches, pains, weight loss, health consultation."<sup>1</sup>

As grounds for the opposition, opposer alleges priority of use and likelihood of confusion. Opposer pleads ownership of the registered mark AYUSH HERBS for "cosmetics, namely, skincare preparations, skin lotions, skin creams and skin moisturizers;

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<sup>1</sup> Application Serial No. 76602470, filed on July 12, 2004, claiming a *bona fide* intent to use the mark in commerce.

massage oil; replenishing oil, namely, hair conditioners," "herbal and nutritional supplements; medicated candy for alleviating pain and intestinal distress; homeopathic and pharmaceutical preparations, natural medicines, and herbal and plant extracts for medical use, all for human and veterinary use for alleviating pain and for treating gastrointestinal problems, joint ailments and stress related nervous disorders," and "spices; candy; herbal candy; tea and processed herbs."<sup>2</sup> Opposer also alleges it uses its mark in connection with personal care, health and medical services.

The discovery period was last set to close on December 27, 2008. This case now comes up on 1) opposer's fully briefed motion, filed December 17, 2009, for summary judgment on its priority of use and likelihood of confusion claim; 2) applicant's fully briefed motion, filed June 26, 2009, for leave to amend its pleading to include a counterclaim to cancel opposer's pleaded registration;<sup>3</sup> and 3) applicant's fully briefed motion, filed July 28, 2009, to strike certain exhibits introduced with opposer's reply brief on its summary judgment motion.

## **Background**

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<sup>2</sup> Registration No. 2493772, issued on October 2, 2001, claiming an earliest date of first use and an earliest date of first use in commerce of April 1990 (Class 5). A disclaimer of the term HERBS is of record.

<sup>3</sup> The counterclaim fee has been paid and the proposed amended pleading is signed. Applicant first moved to amend its answer to assert a counterclaim on April 2, 2009. However, because the proposed amended pleading was not signed and the fee was not paid, consideration of such motion was deferred.

As the record indicates, and as discussed in previous orders,<sup>4</sup> applicant first noticed the deposition of opposer's president, Dr. Shailinder Sodhi, and opposer's Rule 30(b)(6) witness (who may also be Dr. Sodhi), for September 26, 2007. In a spirit of cooperation, because opposer's witness traveled extensively, applicant worked with opposer for almost one year to identify a mutually agreeable date for the deposition. Such date was August 5, 2008. However, due to a dispute about the client file between applicant's present and prior law firms, applicant was not able to proceed because its prior law firm refused to transfer the file. Opposer agreed to several extensions and then filed its motion for summary judgment. Several weeks later, applicant's present attorney received the client file.

Applicant, on January 21, 2009, then moved for discovery under Fed. R. Civ. P. 56(f). Specifically, applicant sought two depositions, one of Dr. Sodhi, on the basis that his affidavit is the sole support for the factual assertions made by opposer in its motion for summary judgment concerning the nature and scope of opposer's alleged use of its mark AYUSH HERBS and the alleged renown of its mark. Applicant appropriately specified the topics. Applicant also sought to depose opposer's attorney to confirm the nonuse by opposer of its mark on certain goods (e.g., candy, herbal candy) to determine whether it was appropriate to amend its answer to assert a counterclaim. In response, opposer

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<sup>4</sup> See orders dated January 23, 2009; March 3, 2009; and May 27, 2009.

withdrew certain statements made by Dr. Sodhi in a supporting declaration submitted with its motion for summary judgment and clarified that it was not relying on certain matters as follows:

1. Opposer states it has not asserted the fame of its mark.
2. Opposer admits, for purposes of its summary judgment motion, "that its Ayurvedic clinic in the United States does not, at this time, operate under the AYUSH or AYUSH HERBS name."
3. Opposer withdrew Mr. Sodhi's statement that "Opposer's Goods are highly related to Applicant's [services] because they are often sold and promoted together and to the same customers. In fact, Opposer's Goods are used in connection with many of Applicant's Services as Ayurveda and Ayurvedic medicine often involves the use of oils, herbs, spices and supplements." Paragraph No. 12 of the Sodhi declaration.<sup>5</sup>
4. Opposer clarified that it is not relying on its Class 30 goods ("candy") and, relying on *G&W Laboratories, Inc. v. G W Pharma, Ltd*, 89 USPQ2d 1571 (TTAB 2009), posits that, even if it were determined it was not using its mark on such goods, only Class 30 would be cancelled from the registration.

Applicant was informed by the Board that it could rely on its own knowledge with respect to several other topics and that, because there was no counterclaim to cancel opposer's pleaded registration, a deposition concerning opposer's purported nonuse of its mark and potential fraud was not allowed in preparation for a summary judgment response. Applicant's motion for 56(f) discovery, and later motion for reconsideration of the Board's determination thereof, were denied. Applicant was informed, however, that it would be allowed time to depose Dr. Sodhi if opposer's motion for summary judgment was denied.

**Applicant's motion for leave to assert a counterclaim**

On April 2, 2009, applicant first moved to amend its answer to assert a counterclaim to cancel opposer's pleaded Registration No. 2493772 alleging abandonment and fraud.<sup>6</sup>

On June 26, 2009, applicant submitted its fee and a signed proposed amended answer and counterclaim asserting the above-referenced claims. In addition to candy products and "possibly other products," applicant now asserts the claims in connection with skin lotions and "possibly other products." Applicant now also moves for leave to assert another ground for cancellation: that opposer's registration is void in whole or in part because opposer has failed to comply with the Federal Food, Drug and Cosmetic Act (the "FD&C Act"); that is, that opposer has made numerous, unlawful health claims about its products, falsely representing that they constitute drugs when opposer has not obtained Federal Drug Administration ("FDA") approval for these products as drugs.

With respect to its proposed abandonment and fraud claims, applicant indicates that, in preparation for its 56(f) motion, it undertook a search of opposer's website and learned that opposer may not be using its mark on all the goods identified in the

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<sup>5</sup> In lieu of Dr. Sodhi's statement, opposer indicates it relies on other evidence it submitted for the purpose of showing the relationship between the parties' respective goods and services.

<sup>6</sup> As mentioned earlier, such motion was not accompanied by a counterclaim fee and the proposed pleading was not signed. Applicant was allowed time to cure such defects and informed that, should it submit its fee and signed proposed amended pleading, its motion would be considered at the same time opposer's summary judgment motion is considered.

registration, including candy and possibly "hair conditioner" and "skin lotion."<sup>7</sup> Applicant expresses its belief that, in retrospect, opposer's discovery response on this topic (that it produces and sells over 100 products) was evasive. Applicant notes that, in response to applicant's 56(f) motion, opposer stated it was not relying on its candy products as a basis for its summary judgment motion. Applicant argues that the pendency of opposer's summary judgment motion does not preclude applicant from asserting a counterclaim; that the proposed counterclaim is germane to the summary judgment motion because opposer is relying on the presumptions associated with a pleaded registration and the lack of restrictions on channels of trade therein; and that the discovery period has not yet closed.

With respect to its proposed claim under the FD&C Act, opposer explains that the FDA recently issued, on June 12, 2009, a warning letter to a seller of ayurvedic products that promotion of certain therapeutic claims establishes that the products are being marketed as drugs where "they are intended for use in the cure, mitigation, treatment, or prevention of disease"; that "marketing of these products with these claims violates the Act"; and that "the Act authorizes seizure of the illegal products and injunctions against manufacturers and distributors of those products." Applicant contends that opposer's goods are similarly

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<sup>7</sup> As mentioned earlier in this order, applicant sought 56(f) discovery, in part, to depose Dr. Sodhi on the topic of whether opposer was using its mark

marketed, possibly in violation of the FD&C Act. Based on the timing of the FDA determination, two weeks before applicant moved to include this counterclaim, applicant argues its proposed, additional counterclaim is timely asserted and, based on the FDA determination in the third-party case, as well as the purported similarities to opposer's marketing, the counterclaim is meritorious.

In response, opposer argues that applicant's proposed new claim is untimely and prejudicial and that applicant, recognizing its fraud counterclaim would only cancel classes 5 and 30, amended its fraud counterclaim to be directed at class 3 as well. Opposer contends that applicant's proposed fraud counterclaim is untimely and dilatory because applicant must have known of its basis insofar as it has been seeking a costly deposition for months; that applicant's FDA-based counterclaim is without merit because it was a third party, not opposer, that was warned by the FDA determination; and that applicant, rather than filing a substantive response to the summary judgment motion, has filed numerous other motions: a 56(f) motion, a first motion to amend its answer to assert a counterclaim, a motion for reconsideration of the 56(f) determination, and now a second motion to amend the answer to assert an additional basis for a counterclaim.

In reply, applicant contends that it moved promptly to amend its answer and assert the proposed counterclaims after learning

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on all the goods in its pleaded registration to ascertain whether there were

of the basis for each of the proposed counterclaims; that, after receiving discovery responses, it sought to depose opposer's witness but has not yet been able to do so, pointing out specifically that, after concluding certain goods were not offered on opposer's website, it was not able to confirm their nonuse because its request for a 56(f) discovery deposition was denied; and that it then moved to counterclaim on fraud and abandonment based on the information it had acquired under its own investigation. With respect to the assertion of unlawful use as a counterclaim, applicant points out that it was only shortly before it sought to add this basis that the FDA issued its determination regarding a third party, and applicant could not have alleged such unlawfulness prior to the issuance of the determination. Applicant argues that it has not acted improperly or in a dilatory manner and that its motion to amend its answer and counterclaim should be allowed.

As a general policy, leave to amend a pleading must be freely given when justice so requires. See Fed. R. Civ. P. 15(a). 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 or be prejudicial to the rights of the adverse party. See TBMP §507.02 (2d ed. rev. 2004). The question of whether an adverse party would be prejudiced by allowance of the amended pleading in a

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grounds for a counterclaim.

Board case is largely dependent on the timing of the motion to amend. For example, the Board will liberally grant such motions when the proceedings are still in the pre-trial stage. *Id.* In addition, counterclaims against pleaded registrations are compulsory and governed by Trademark Rule 2.106(2)(i) which provides:

If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefore are learned.

Applicant has shown that it moved promptly to amend its answer to assert a counterclaim on three separate bases once it learned of the bases and realized, at least with respect to the abandonment and fraud counterclaims, it would not be able to obtain a deposition to explore the bases unless and until opposer's summary judgment motion was denied. The proposed counterclaim is not prejudicial to opposer because the discovery period has not been closed; because opposer is charged with the knowledge concerning its own use or nonuse of its mark on certain goods; and because opposer effectively admitted, at least for purposes of this summary judgment motion, that it is not using its mark for candy products. Thus, the Board looks now at the proposed amended pleading to see if the counterclaim bases are

futile and, if not, are sufficiently pled. Applicant alleges as follows:

30. On information and belief, opposer is not using its AYUSH HERBS mark for candy products of any kind and possibly other products, such as skin lotion, and has abandoned the mark for such products within the meaning of 15 U.S.C. §1127.
31. On information and belief, opposer has never used or has not used continuously for five consecutive years its AYUSH HERBS mark for candy products of any kind and possibly other products, such as skin lotion, and has thereby committed fraud on the United States Patent and Trademark Office ("USPTO") in connection with procurement and/or maintenance of Registration No. 2,493,722 by alleging use when opposer knew, or should have known, that one or more of its statements of use were false. Thus, for example, on information and belief, opposer committed fraud when it falsely represented to the USPTO, in Section 8 and 15 affidavits filed in connection with Reg. No. 2,493,722, that it was using and had continuously used for five consecutive years the AYUSH HERBS mark for "skin lotion" in Class 3, "medicated candy" in Class 5, and "candy" and "herbal candy" in Class 30.
32. Applicant repeats and realleges the allegations set forth in paragraphs 27 through 29 as if fully set forth herein.
33. On information and belief, opposer has made materially false statements in the form of unlawful health claims about its products affixed with the mark AYUSH HERBS. Thus, for example, opposer has stated that a formula for one of its products "is an excellent choice for supportive action against viruses, bacteria and toward the treatment of ... a weak immune system"; that another product "is used for kidney and urinary infections"; that yet another product "works wonders on normalization of hypertension" as well as results in a "lowering blood pressure" and "normalizing the blood pressure and cutting down the side effects"; and that still another product consists of "eighteen herbs which have been shown to exhibit hepatoprotective action," "facilitate deep internal detoxification," act as a "tonic for liver and heart conditions" and "demonstrated hepatoprotective activity by regulating the levels for hepatic microsomal drug metabolizing enzymes."
34. On information and belief, these statements are in clear violation of the Federal, Drug and Cosmetics Act ("Act"). On information and belief, these statements, in violation of a determination by the Food and Drug Administration

("FDA"), promote opposer's products for conditions that cause them to be drugs in that the therapeutic claims state that these products are intended for use in the cure, mitigation, treatment, or prevention of disease and thereby violate the Act. On information and belief, opposer has not obtained FDA approval for the promotion and sale of its products affixed with the mark AYUSH HERBS as drugs.

35. On information and belief, opposer has acquired no rights in the mark AYUSH HERBS, since its promotion and the resulting sale of products affixed with the mark AYUSH HERBS has been and continues to be unlawful.

1. Applicant's abandonment counterclaim, paragraph No. 30

An assertion that a mark has been abandoned due to nonuse without intent to resume use is a sufficient claim. See TBMP §309.03(c)(12) (2d ed. rev. 2004). Here, reading paragraph Nos. 30-31 together, applicant has asserted a sufficient counterclaim on the grounds of abandonment, albeit minimally, with respect to opposer's alleged nonuse of its mark on candy products (Classes 5 and 30) and skin lotions (Class 3).<sup>8</sup> However, the term "possibly other products" is indefinite and stricken without prejudice to applicant to amend its pleading later, after discovery on this matter, to specify the other products for which it can allege opposer has abandoned use of its mark.

2. Applicant's fraud counterclaim, paragraph No. 31

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<sup>8</sup> Ordinarily, a plaintiff asserting abandonment by defendant alleges either (or both) 1) use has been discontinued with intent not to resume such use, with three years of consecutive nonuse being a prima facie case of abandonment or 2) a course of conduct has been undertaken which causes the mark to lose its significance as a mark. Trademark Act §45. Here, paragraph No. 31 alleges that opposer has not used its mark on the relevant products for five years.

Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”). That is, the time, place and contents of the false representations, the facts misrepresented, and identification of what has been obtained, shall be stated with specificity. See *Saks, Inc. v. Saks & Co.*, 141 USPQ 307 (TTAB 1964). Malice, intent, knowledge, and other conditions of mind of a person may be averred generally. Fed. R. Civ. P. 9(b). To satisfy Rule 9(b), any allegations made upon “information and belief” must be accompanied by a statement of facts upon which the belief is founded. See *Exergen Corp., v. Wal-Mart Stores, Inc.*, 91 USPQ2d 1656 (Fed. Cir. 2009). In addition and in view of the Federal Circuit’s recent decision in *In re Bose Corporation*, 476 F.3d 1331, 91 USPQ2d 1938 (Fed. Cir. 2009), pleadings of fraud, which rest on allegations that the trademark applicant or registrant made material representations of fact in connection with its application or registration which it “knew or should have known” to be false or misleading, constitute an insufficient pleading of fraud because such allegations imply the possibility of mere negligence, which is inadequate to infer fraud or dishonesty. See *Asian and Western*

*Classics B.V. v. Lynne Selkow*, \_\_\_ USPQ2d \_\_\_, Cancellation No. 92048821 (TTAB Oct. 22, 2009).

Here, applicant's counterclaim is insufficient because it does not set forth facts supporting its allegation that "opposer has never used or has not continuously used for five consecutive years its AYUSH HERBS mark for candy products of any kind and possibly other products, such as skin lotion," which is made only "on information and belief" and which appears to constitute nothing more than two alternative allegations with no particular basis in facts known to applicant or which it is likely to find support following investigation or discovery.<sup>9</sup> It is also insufficient because it uses the "should have known" language, clearly decried in *Bose*; and because there is no allegation that opposer's statements were made with intent to deceive the USPTO.<sup>10</sup>

If applicant uncovers facts during discovery which it ascertains provide a basis for a counterclaim of fraud that can be pleaded in compliance with Federal Rules 9 and 11 and USPTO Rule 11.18, then applicant may move to amend its pleading to reassert such claim.

3. *The unlawful use counterclaim, paragraph Nos. 33-35*

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<sup>9</sup> See USPTO Rule 11.18.

<sup>10</sup> "Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis." *Bose*, 91 USPQ2d at 1941.

Applicant has pled a sufficient counterclaim of unlawful use based on opposer's purported violations of the FD&C Act.<sup>11</sup> However, as the Board has said in the past, "the better practice in trying to determine whether use of a mark is lawful under one or more of the myriad regulatory acts is to hold a use in commerce unlawful only when the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a *per se* violation of a statute regulating the sale of a party's goods." See *General Mills, Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992). The Board notes that applicant has not alleged that the FDA determined that opposer is in violation of the FD&C Act. Evidence that a third party has violated the FD&C Act is not sufficient to prove the claim asserted against opposer. Applicant is on notice that a determination, by the FDA or a court, of opposer's purported violation of the FD&C Act, will be a necessary element to prove this counterclaim. (That is, the Board will not decide the issue of noncompliance, only the issue of whether opposer's compliance, if determined by the FDA or a court, is material to the continued registration of its mark.)

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<sup>11</sup> Although this proposed counterclaim is not explicitly permitted by Trademark 14(3), which sets out the grounds for cancellation for a registration more than five years old, it is not barred because the opposition proceeding commenced before the pleaded registration was five years old. See *The Williamson-Dickie Mfg. Co. v. Mann Overall Co., Inc.*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); and *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048 (TTAB 1982).

In view thereof, applicant's motion for leave to amend its answer to assert the abandonment and unlawful use counterclaims is granted. Applicant's motion for leave to amend its answer to assert a fraud counterclaim is denied without prejudice.

**Opposer's motion for summary judgment**

In support of its motion, opposer argues that it has priority; that the parties' marks are "effectively identical"; that the parties' goods and services are highly related; that the trade channels are identical; and that, because neither applicant nor opposer has restricted its identification (as stated in the application and pleaded registration), the goods and services are available to all purchasers. Opposer's motion is supported by the declaration of its president, Dr. Sodhi, and accompanying exhibits and by the declaration of its attorney, Ryan M. Kaiser, and accompanying exhibits.

Dr. Sodhi introduced a certified copy of opposer's pleaded registration showing current status, that the registration is valid and subsisting, and title, that the registration is owned by opposer. Dr. Sodhi states that opposer began using the mark AYUSH HERBS "on or about 1990" for the items which it specifies are also the goods identified in the registration; that opposer operates an Ayurvedic clinic in Bellevue, Washington;<sup>12</sup> and that opposer owns the domain name "ayush.com." Dr. Sodhi introduced

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<sup>12</sup> As indicated earlier, opposer clarified that it does not operate such clinic under the name AYUSH or AYUSH HERBS.

copies of advertisements for AYUSH HERBS from *Whole Foods Magazine* (Nov. 2002); *Supplement Industry Executive* (Nov./Dec. 2002); and *Chiropractic Economics* (Oct. 23, 2003). The first two advertisements show a partial list of "over 100 standardized extracts" (e.g., amla, ginger, green tea, tylophora) and a reference to "over 30 essential oils" (the advertisement from *Supplement Industry Executive* also specifically lists some of those oils, e.g., angelica, jawa, valerian root). The third advertisement refers to the origin of the herbs ("All herbs are grown naturally in a pristine Himalayan habitat ....) and identifies certain physical conditions which are addressed by certain supplements (e.g., "joint support care: Boswelya Plus"; "liver care: Livit-1 & Livit-2"). Dr. Sodhi also introduced two copies of opposer's "home page" dated December 15, 2008. One excerpt concerns its supplements and the other concerns its clinic, "The Ayurvedic and Naturopathic Clinic." On both pages, under "Departments," the viewer may select from a wide range of choices including "Products A-Z," "Raw Materials," "Veterinary Clinic," "Ayurvedic Clinic," "Wellness library," and "Healthy Recipes."

Mr. Kaiser introduced the results of his search of the USPTO database of use-based applications and registrations for the premise that the parties' goods and services are offered by the same source. Mr. Kaiser introduced excerpts from certain magazines, *Shape* (January 2009) and *Vegetarian Times* (January

2009) showing that nutritional supplements, skin care products, and spa services are advertised in the same magazines. Also to demonstrate the relatedness of the parties' goods and services, Mr. Kaiser introduced pages from websites (e.g., Elaj Aveda Day Spa, NuU MedSpa). Mr. Kaiser introduced certain discovery responses from applicant; USPTO records of applicant's applications for different marks not involved in this proceeding (to show applicant offers the same goods as opposer, albeit under different marks); and copies of the Office Actions and responses thereto from applicant's application for the proposition that applicant admitted in its February 22, 2005, response that "there is some connection between Applicant's services and the goods identified in the cited registration," which was opposer's registration.

In response, applicant argues that opposer cannot rely on the presumptions of its registration in view of applicant's counterclaim.<sup>13</sup> As to the meaning of the term AYUSH, applicant points out that it is from Sanskrit referring to "long life"; is a common, given name for children of Indian descent;<sup>14</sup> is a prayer ritual used by parents of Indian descent to seek "long life" and prosperity for their children; and appears to have similar meaning in Arabic. Applicant argues that the marks are

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<sup>13</sup> Applicant also argues that opposer did not assert priority at common law. However, paragraph No. 2 of the notice of opposition is minimally sufficient to be a pleading of common law priority: "The Opposer and its predecessors in title have since 1990 used the mark AYUSH HERBS on [listing of goods]."

<sup>14</sup> Applicant specifically identifies, as an example, Ayush Manesh Khedekar, an Indian child actor who starred in the movie "Slumdog Millionaire."

dissimilar because they are not visually or phonetically equivalent and that, contrary to opposer's position, the addition of the term HERBS to opposer's mark results in the parties' marks having different connotations and different commercial impressions.

Applicant argues that the parties' goods and services differ in character and functions; that Dr. Sodhi has withdrawn his statement that the parties' goods are highly related; that opposer has conceded its clinic does not operate under the name AYUSH HERBS; and that opposer's failure to expand the use of its mark to its services is evidence that they are not related. Applicant argues that opposer's documentary evidence does not establish, as a matter of law, that the parties' goods and services are related. Relying on *Cognis Corp. v. DBV, LLC*, 73 USPQ2d 1766, 1768 (TTAB 2004), applicant indicates that, because opposer is not using its mark on some of its identified goods, the possibility that opposer's registration may be partially cancelled or restricted is fatal to opposer's summary judgment motion. Applicant also contends that the third-party registrations introduced by opposer for the premise that the parties' goods and services are related show that at least some of the registrations include additional goods covering a broad range of unrelated items, making the evidence less probative. Some of those items are: "artificial mustaches," "sun tan lotion," "laundry detergent," and "aspirin." With respect to its

statements during the prosecution of its application about the relationship of applicant's services and opposer's goods, applicant argues that opposer takes a phrase out of full context, and that applicant's reference to "some relationship" was one to the traditional Indian science of Ayurveda. Applicant argues that the fact it sought to register different marks for different goods is not relevant; that opposer's evidence that the goods and services offered by each party may be advertised in certain magazines is not persuasive, pointing out that there is also an advertisement for an automobile in the *Shape* magazine excerpts introduced by opposer; that applicant's services are marketed through its therapy centers and applicant will not sell any third-party traditional ayurvedic products in the United States; that applicant's customers are sophisticated, urban professionals who have the financial ability to purchase applicant's services; and that the vast majority of such purchasers will be familiar with traditional ayurvedic products and services as well as the meanings of the term "ayush."

Applicant argues that opposer's mark is not strong, pointing out that opposer has conceded the duPont<sup>15</sup> factor of fame, and that opposer's mark coexists with other AYUSH-formative marks (specifically, AYUSHAKATI, Registration No. 3179208 for "dietary supplements, mineral supplements, food supplements of herbal origin, and food supplements of herbo-mineral origin" and

AYUSHMAN, application Serial No. 76286928, now abandoned, for "dietary supplements, teas, body massage oils and hair oils"<sup>16</sup>).

In support of its motion, applicant introduced, among other things, the declaration of Vipul Chawla, its vice-president of oral care, and accompanying exhibits; the declaration of its attorney, Robert Alpert, introducing printouts from TESS of the mark AYUSHAKTI and AYUSHMAN as well as U.S. Census Bureau information concerning demographics in the United States, estimating the Asian-Indian population in 2007 at more than 2.5 million; and the declaration of Elizabeth Efeldt, a private investigator engaged by applicant who states she ordered products from Ayushakti Ayurved U.S., Inc., and accompanying exhibits composed of photographs of the bottles received showing the mark AYUSHAKTI.

In reply, opposer argues that it may rely on its common law rights to establish priority; that opposer submitted three dated advertisements from nationwide publications predating applicant's constructive use date; and that opposer now submits additional advertisements from nationwide publications. Opposer states that it "disputes the timeliness, veracity and legal merit of the new counterclaims" but "for purposes of its Summary Judgment motion, Opposer will concede the contentions to be treated as

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<sup>15</sup> *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 463 (CCPA 1973).

<sup>16</sup> Applicant states that a price list remains available over the Internet for AYUSHMAN products.

established." However, opposer argues, such counterclaims do not raise material facts which would preclude entry of summary judgment in its favor. Opposer argues that applicant's fraud counterclaim may result only in cancellation of opposer's registration (in possibly two classes,) but it will not negate opposer's common law rights. With respect to the counterclaim based on the FD&C Act, opposer contends that applicant does not allege misconduct which would result in the cancellation of opposer's registration; that opposer has used its mark as a house mark for a large variety of goods; that applicant only alleges a violation as to four items; and that, as a consequence, there is no allegation that opposer failed to engage in any lawful use. Opposer distinguishes *Cognis, Corp., supra*, relied on by applicant by pointing out that the defendant therein counterclaimed for partial cancellation of opposer's registration by restricting opposer's goods and further asserted that such a restriction would avoid a likelihood of confusion.

Opposer's reply is supported by copies of printed, dated publications which contained advertisements of herbal supplements and essential oils, similar to the advertisements discussed earlier; excerpts from opposer's website for the sale of specific supplements and an acne cream; and other materials.

1. Applicant's motion to strike certain evidence accompanying opposer's reply

Applicant moves to strike Exhibit Nos. 1-3 and 5 of opposer's summary judgment reply brief on the basis that they are

not self-authenticating and, consequently, not admissible. Exhibit 1 is composed of opposer's advertisements of the mark AYUSH HERBS for its herbal supplements and essential oils from printed publications (*Townsend Letter for Doctors and Patients*, July 2003; *Common Ground*, Fall 2003; *HSR Health Supplement Retailer*; *Nutrition Industry Executive*, March 2003; *Whole Foods Magazine*, July 2003, November 2004, November 200X;<sup>17</sup> *NutraCos*, cover undated; *Nutraceuticals World*; and *Nutritional Outlook*, March 2006); and Exhibits 2, 3 and 5 are internet printouts.

In support of its motion, applicant argues that the publications are not available to the general public in libraries. Applicant's motion is accompanied by the declaration and supporting exhibits of Christine M. Wierzba, the manager of library and research services for applicant's law firm, wherein she stated she conducted library searches on July 27, 2009, with the results that none of the publications were found in the search of the online catalog for the New York Public Library and only two were available (to authorized users) in the search of the website for the Brooklyn Public Library. Applicant contends that, because it could not find the publications in general circulation, they should be stricken. Applicant also points out that the pages at Exhibit 1 are mismatched and incomplete and, thus, should be stricken for lack of foundation.<sup>18</sup> Applicant

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<sup>17</sup> The "X" refers to a missing digit in the copies submitted.

<sup>18</sup> For example, the page that follows the cover of the July 2003 *Townsend Letter for Doctors and Patients* appears to be from the May 20XX issue; and the

argues that the internet evidence, Exhibits 2, 3, and 5, are not the electronic equivalents of printed publications and are not self-authenticating. Applicant seeks to strike these materials because they are not introduced by way of an affidavit or declaration. Applicant argues that Exhibits 1-3 should be stricken because they are impermissible insofar as they are being offered to bolster opposer's priority, an element opposer was required to establish in its main brief on summary judgment, and they are not responsive to new matters.

In response, opposer argues that it has proven its common law priority without the disputed exhibits. Nonetheless, opposer argues that the periodicals at Exhibit 1 are self-authenticating; that they are either of general circulation among the members of the relevant public or that segment of the public which is relevant under an issue in the proceedings; that they are available at specified libraries; and that the documents clearly show the name and date of the publication.<sup>19</sup> Opposer contends that the covers of the other magazines were not necessary to support the copies of the excerpted pages because such pages provide the necessary information (generally in the footer). As to the internet excerpts, opposer states its opinion that the evidence is probably not necessary. Opposer argues that its failure to submit a declaration may be remedied and now submits

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page following the cover for the Fall 2003 *Common Ground* is from the April 2004 issue of *HSR Health Supplement*.

the declaration of its attorney. Opposer notes that Exhibit 5 was submitted for Mr. Chawla's statement therein that applicant's services' "pricing is affordable" and, thus, contradicting Mr. Chawla's sworn statement concerning the nature and cost of applicant's services; and that the other evidence is not improper rebuttal evidence.

In reply, applicant argues that the availability of the publications is limited; and that opposer's use of the unknown website WorldCat.org to identify the libraries, which include foreign and corporate libraries, cataloging the different publications, constitutes hearsay to prove that the reproduced catalog contents of such public libraries in fact include the referenced publications. Applicant argues that opposer's internet evidence is improper rebuttal and its introduction cannot be remedied by the late declaration.

Insofar as opposer has explained that the covers of *Common Ground* and *NutraCos* were submitted in error, such materials are stricken. No further consideration will be given thereto.

Trademark Rule 2.122(e) provides, in relevant part, as follows:

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 ... if the publication ... is competent evidence and relevant to

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<sup>19</sup> Opposer acknowledges that, due to a scanning error, there are several pages that were not intended to be submitted (e.g., the covers of *Common Ground* and *NutraCos*).

an issue, may be introduced in evidence by filing a notice of reliance on the material being offered.

The Board agrees with applicant that the page for Townsend Letter - May 20XX lacks an important element of self-authentication, the complete year. However, the Board will allow its introduction and notes that its probative value is limited in view of the deficiency in the self-authentication. The other publications opposer seeks to introduce at Exhibit 1 are self-authenticating. They provide the name of the publication and the month and date of the issue. While they may not be available to the general public in most libraries, they are publications of the type in general circulation among members of the public or that segment of the public which is relevant in this proceeding. Moreover, because many public libraries now have online catalogs that may be accessed remotely from anywhere, the publications, though perhaps uncommon, can be found in the event the non-introducing party wishes to examine them more thoroughly. Compare with Fed. R. Evi. 902(6) which provides that no extrinsic evidence is required to authenticate materials purporting to be newspapers or periodicals. The Board notes in passing that all the advertisements at Exhibit 1 show the mark AYUSH HERBS in connection with opposer's herbal extracts and essential oils only.

Accordingly, applicant's motion to strike the evidence at Exhibit 1 to opposer's reply brief is denied.

As applicant appears to concede, opposer's submission of a declaration in support of the internet evidence at Exhibits 2, 3, and 5 cured the defect in authentication. To the extent opposer was introducing the evidence to support its priority of use at common law, the materials do not constitute impermissible rebuttal. At the time opposer moved for summary judgment, there were no counterclaims in this case and opposer relied primarily on its pleaded registration to establish its priority. By the time applicant's response to the summary judgment motion was due, opposer was aware of applicant's intent to assert counterclaims to cancel the pleaded registration, an action which applicant undertook.

In view thereof, applicant's motion to strike the evidence at Exhibits 2, 3 and 5 of opposer's reply brief is denied. However, as in the case of all printed publications, these documents are admissible only for what they show on their face (e.g., that such an article or advertisement was published on a particular date), and not as proof of the matters asserted therein. *See 7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007).

The Board is aware of the nature of the evidence introduced in connection with a summary judgment motion; the self-serving nature of declarations; and the lack of opportunity for cross-examination of a declarant. The Board accords the evidence introduced by the parties an appropriate probative value in light

of the high standard (of establishing the absence of a genuine issue of material fact) required to succeed on a summary judgment motion.

2. Summary judgment determination

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it 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 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).

In this case, in view of the inconsistencies in the record, including the inconsistencies in Dr. Sodhi's declaration as it now stands, and in view of the existence of applicant's counterclaim, we find that genuine issues of material fact exist with respect to priority, more specifically, what goods opposer is using its mark on, when such use commenced, and whether there has been any abandonment of use on some products; the similarities of the marks, particularly with respect to connotation and commercial impression; the relatedness of the

parties' goods and services, in view of the withdrawal of Dr. Sodhi's statement regarding the relatedness of the parties' goods and services, the fact that the evidence opposer submitted regarding use of its mark predominantly concerns the herbal extracts and essential oils, and the broad range of categories on opposer's own website (involving veterinary and human care, for example); the channels of trade, in view of Dr. Sodhi's withdrawal of his statement on this matter and the evidence of record (where, as applicant pointed out, an automobile is advertised in the same magazines as dietary supplements and spa services); and prospective purchasers for the parties' goods and services, in view of Dr. Sodhi's withdrawal of his statement on this matter and the statement by Mr. Chawla that applicant's consumers are sophisticated.<sup>20</sup>

In view thereof, opposer's motion for summary judgment is denied.

**The schedule**

Proceedings are resumed. Applicant is allowed to notice and take the deposition of Dr. Sodhi prior to the close of discovery. All operative dates are reset below:

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<sup>20</sup> The question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed. See *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1683 (Fed. Cir. 1990). Such factors may be reflected expressly or inherently. *Id.* In this case, although the parties' have unrestricted identifications, inherent questions remain as to the channels of trade and potential consumers of the parties' respective goods and services under their respective marks.

THE PERIOD FOR DISCOVERY TO CLOSE:	1/16/2009
30-day testimony period for plaintiff in the opposition to close:	4/16/2009
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	6/15/2009
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	8/14/2009
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	9/28/2009

**Briefs shall be due as follows:  
[See Trademark rule 2.128(a)(2)].**

Brief for plaintiff in the opposition shall be due:	11/27/2009
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	12/27/2009
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	1/26/2010
Reply brief (if any) for plaintiff in the counterclaim shall be due:	2/10/2010

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.

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