

This Opinion is not a
Precedent of the TTAB

Mailed: November 20, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Arya Samaj Greater Houston
v.
Kavita Vachaknavee

—
Opposition No. 91278867
—

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

Kavita Vachaknavee, pro se.

—
Before Kuhlke, Johnson, and Casagrande,
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:¹

Kavita Vachaknavee (“Applicant”) applied to register the mark VSS GLOBAL (in standard characters, with the word “GLOBAL” disclaimed) on the Principal Register

¹ 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).

for “Education services, namely, providing live and on-line classes, seminars and workshops in the field of Vedic philosophy and culture” in International Class 41.²

Arya Samaj Greater Houston (“Opposer”) filed a Notice of Opposition to registration of Applicant’s mark.³ The Notice of Opposition alleges that Opposer has made prior use of several marks, including VSS, DAVSS, and VSS GLOBAL in connection with its provision of “education services in the field of Vedic Hindu culture.”⁴ Opposer alleges that it has made continuous use of the mark DAVSS for over twenty-five (25) years, of the mark VSS since August 2020, and of VSS GLOBAL since October 2020, all in connection with these services, and thus has earned common law rights and goodwill in the marks.⁵ The Notice of Opposition alleges that Opposer has priority and that there is a likelihood of confusion between its marks and Applicant’s VSS GLOBAL mark for identical services, and that registration of Applicant’s mark should therefore be refused under Section 2(d) of the Lanham Trademark Act, 15 U.S.C. § 1052(d).⁶

² Application Serial No. 90870471 was filed on August 6, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere as early as July 20, 2021, and in commerce since at least as early as July 23, 2021.

³ See 1 TTABVUE. References to the briefs, other filings in the case, and the record cite the Board’s TTABVUE docket system. The number preceding “TTABVUE” is the docket number assigned to the cited filing in TTABVUE and any number immediately following “TTABVUE” identifies the specific page(s) to which we refer.

⁴ We note that, in the Notice of Opposition, Opposer alleges that the fields of “Hindu culture” and “Vedic Hindu culture” are “essentially the same” or “essentially identical.” See *id.* at 6. Applicant’s filings similarly use the terms interchangeably.

⁵ See *id.* at 4. The Notice also alleged that Opposer filed applications to register VSS (Appl. Ser. No. 97176986) and DAVSS (Appl. Ser. No. 97177003) for the same services. See *id.*

⁶ See *id.* at 6. We note that, although the Notice of Opposition mentions Opposer’s DAVSS mark, it does not allege a likelihood of confusion between Applicant’s mark and DAVSS. The cover sheet for the Notice of Opposition also lists, as grounds for opposition, that Applicant

Applicant's Answer to the Notice of Opposition denied most of the salient allegations in the complaint and asserted, among other defenses, the affirmative defense that "Opposer lacks priority because any 'use' of Opposer's Marks was insufficient to confer prior trademark rights to Opposer."⁷

The parties filed trial briefs⁸ and Opposer filed a reply brief.⁹ For the reasons explained below, we dismiss the opposition and, further, remand the application to the Examining Attorney.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the challenged application. Both parties put in all their evidence through notices of reliance, with both parties' notices including documents such as promotional flyers, emails sent or received by the parties, and other types of

is not the rightful owner of the mark VSS GLOBAL as required by Section 1 of the Act, 15 U.S.C. § 1051, *see id.* at 1, but the Notice itself contains no allegations directed to any such claim. Moreover, Opposer did not address this claim in its brief, so it is forfeited. *Nextel Commc'ns Inc. v. Motorola Inc.*, Opp. No. 91164353, 2009 WL 1741923, at *1 n.1 (TTAB 2009) (grounds for opposition not pursued at trial or otherwise argued by opposer in its brief deemed waived).

⁷ *See* 5 TTABVUE 2-4. Applicant's Answer admitted that Applicant filed the opposed application. *See id.* at 3.

⁸ *See* 16 TTABVUE (Opposer's trial brief); 17 TTABVUE (Applicant's trial brief). Applicant's trial brief purported to attach several exhibits as evidence. *See* 17 TTABVUE 57-116. This is inappropriate. "A brief may not be used as a vehicle for the introduction of evidence. The Board will not consider evidence and other evidentiary materials attached to the briefs unless they were properly made of record during the time assigned for taking testimony." *Hole in 1 Drinks, Inc. v. Lajtay*, Canc. No. 9206586, 2020 WL 859853, at *2 (TTAB 2020) (citations omitted).

⁹ *See* 18 TTABVUE. Opposer's reply brief asserts that we should not consider Applicant's trial brief because it was filed a day late. *See id.* at 2-3. Because one day is a minimal delay and Opposer identifies no prejudice, and in light of the fact that Applicant is an individual appearing pro se, we exercise our discretion to consider Applicant's trial brief.

business records, even though these types of documents are generally not considered admissible via notices of reliance. *See* Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g). Usually, parties attach such documents to declarations attesting to their authenticity. *See, e.g., Wet Seal, Inc. v. FD Mgmt., Inc.*, Opp. No. 91157022, 2007 WL 458529, at *2 (TTAB 2007). Neither party, however, objected to the other's submission of such documents as evidence by notice of reliance, and so we will consider the documents to be properly of record for all purposes. *See, e.g., Hiraga v. Arena*, Canc. No. 92047976, 2009 WL 723334, at *2 (TTAB 2009) (where neither party objected to the other's submission of documents inappropriate for notices of reliance, the Board treated the documents as though stipulated into the record).¹⁰

During its trial period, Opposer filed a Notice of Reliance with several attachments, including the following documents:

- Status information from the USPTO's TSDR electronic database concerning Opposer's pending Application Ser. No. 97600817 for VSS GLOBAL for "education services, namely, providing live and on-line classes in the field of Hindu culture," in Class 41, (Opposer's "'817 Application");¹¹

¹⁰ Applicant did lodge a multitude of other evidentiary objections. Because Board proceedings are akin to bench trials and the Board is capable of assessing the proper evidentiary weight of proffered evidence, parties are discouraged from lodging objections that are not outcome-determinative. We have considered all of the evidence of record and, in doing so, we have kept in mind Applicant's objections and accorded whatever probative value we deem the subject evidence to merit. *See, e.g., Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, Opp. No. 91190827, 2017 WL 542344, at *2 (TTAB 2017).

¹¹ *See* 13 TTABVUE 11-13. We note that Opposer did not allege, in its Notice of Opposition, that it had filed this application, but only that it had common law rights in VSS GLOBAL. We further note that the first page of the copy submitted is clipped on the right hand margin such that certain words are missing. Generally, we do not consider documents, or aspects of documents, that are illegible. *See, e.g., In re Virtual Indep. Paralegals, LLC*, Ser. No. 86947786, 2019 WL 1453034, at *8 n.23 (TTAB 2019) ("If evidence is not legible, we cannot consider it.") (citations omitted); *see also Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, Canc. No. 92050879, 2013 WL 5407315, at *8 (TTAB 2013) (illegible aspects of submitted documents not considered), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014). Because this

- Copies of a few of Opposer’s “Monthly Newsletter of Vedic Sanskriti School (VSS Global)”;¹²
- Copies of Applicant’s Answer to Opposer’s First Set of Requests for Admission;¹³
- Copies of Applicant’s Answer to Opposer’s Second Set of Requests for Admission;¹⁴
- Printouts of certain excerpts from Opposer’s website discussing Opposer’s VSS Global program;¹⁵
- Copies of emails and email chains between or including one or both of the parties;¹⁶
- A copy of a PowerPoint presentation created by Opposer entitled “Starting a New VEDIC SANSKRITI SCHOOL at Arya Samaj in your city”;¹⁷
- A copy of Opposer’s white paper entitled “Vedic Sanskriti School (VSS) Goes Global”;¹⁸ and
- Copies of documents from Arya Samaj of Chicagoland said to be evidence of actual confusion.¹⁹

During its trial period, Applicant submitted a Notice of Reliance including the following documents:

document reflects a USPTO application file and most of it is legible, and in light of the fact that Applicant did not object, we exercise our discretion to consider this document of record.

¹² See 13 TTABVUE 14, 102-05, 110-11.

¹³ See *id.* at 15-42.

¹⁴ See *id.* at 64-72.

¹⁵ See *id.* at 43-45.

¹⁶ See *id.* at 52-58, 73, 106-09, 112.

¹⁷ See *id.* at 80-96.

¹⁸ See *id.* at 99-100.

¹⁹ See *id.* at 46-51,

- Copies of emails and email chains between or including one or both of the parties;²⁰
- A copy of Opposer's Response to Applicant's First Set of Requests for Admission;²¹
- A copy of Opposer's Response to Applicant's Second Set of Requests for Admission;²²
- A copy of Opposer's Response to Applicant's First Set of Interrogatories;²³
- A copy of Opposer's Response to Applicant's Second Set of Interrogatories;²⁴
- A copy of a Suspension Notice issued by the USPTO in Opposer's Application Ser. No. 97176986 for the mark VSS in view of Applicant's earlier-filed application for the VSS GLOBAL mark;²⁵ and
- A copy of a Suspension Notice issued by the USPTO in Opposer's '817 Application for the mark VSS GLOBAL in view of Applicant's earlier-filed application for the VSS GLOBAL mark and a subsequent Nonfinal Office Action in that file.²⁶

In its rebuttal period, Opposer filed a second Notice of Reliance attaching, among other things, several more emails between or including one or both of the parties.²⁷

²⁰ See 14 TTABVUE 27-28, 30-38, 41-43, 46-49, 152-53, 156, 159-60, 163-64, 167-73, 176-79, 182-86, 191-97, 209-11, 214, 236-43, 246-49, 252-55, 258-64, 294-96, 299-302, 305-11, 318-22, 325-30, 332, 335-36, 339-43, 345-47, 350-51, 353-61, 364-65.

²¹ See *id.* at 50-71.

²² See *id.* at 73-78.

²³ See *id.* at 79-105.

²⁴ See *id.* at 107-11.

²⁵ See *id.* at 266-73.

²⁶ See *id.* at 275-90.

²⁷ See 15 TTABVUE.

II. Preliminary Matter

Trademark Rule 2.122(g), 37 CFR § 2.122(g), provides for notices of reliance as a means to submit certain types of evidence into the trial record. It provides that “[f]or all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding.” The parties’ notices of reliance here, however—especially Applicant’s Notice of Reliance and Opposer’s Rebuttal Notice of Reliance—went beyond simply “associating” the evidence attached “to one or more issues” in the case. Rather, those notices included argument about how the attached evidence supported their respective positions in the case and how it undercut the other party’s position or evidence.

This is inappropriate. As the Trademark Trial and Appeal Board Manual of Procedure (TBMP) makes clear, “[a] notice of reliance is essentially a cover sheet for the materials sought to be introduced.” TBMP § 704.02 (June 2024). It is not a vehicle to discuss the probative value of the evidence or to argue the merits of issues in the case. That is what trial briefs are for. We have not considered any of the argument in any of the notices of reliance in this case.

III. Opposer is Entitled Under the Trademark Act to Initiate an Opposition Proceeding.

In every inter partes case, the plaintiff must establish that it is entitled to have invoked the statute authorizing the proceeding it filed. Here, that statute is Section 13 of the Trademark Act, 15 U.S.C. § 1063, which provides for opposition proceedings. An opposition plaintiff must demonstrate: (i) an interest falling within the zone of

interests protected by the opposition statute; and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 120-37 (2014)); *id.* at 1305 (applying *Lexmark* to inter partes TTAB cases). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark establishes damage proximately caused by registration of the mark. *Id.* at 1305-06.

Opposer's trial brief does not specifically address statutory entitlement. Nor does Applicant's brief. Yet it is a necessary element in every case we decide, so we will determine if the record establishes Opposer's entitlement to have filed this opposition. *See, e.g., Exec. Coach Builders, Inc. v. SPV Coach Co.*, Opp. No. 91212312, 2017 WL 3034059, at *5 (TTAB 2017). Opposer has made its '817 Application for VSS GLOBAL of record.²⁸ The record reflects that examination of this application was suspended due to a likelihood of confusion with the mark in Applicant's prior-filed application.²⁹ This shows that Opposer has a reasonable belief in damage proximately caused by the registration of the mark in Applicant's application. *See, e.g., Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, Opp. No. 91221553, 2018 WL 1326374, at *7 (TTAB 2018) (opposer's "standing" established through applicant's concessions and admissions that opposer's pending application would be refused registration should applicant's application register); *Life Zone Inc. v. Middleman Grp.*

²⁸ See 13 TTABVUE 11-13; *see also supra*, n.11.

²⁹ See 14 TTABVUE 257-90.

Inc., Opp. No. 91160999, 2008 WL 2781162, at *6 (TTAB 2008) (suspension of opposer's pending trademark application based on the applicant's application sufficient); *see also Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (CCPA 1982) ("rejection of [the plaintiff's] application during prosecution" in light of defendant's registration sufficient to invoke cancellation proceeding). Accordingly, Opposer has proven its entitlement to file an opposition proceeding under Section 13.

IV. Analysis of Opposer's Section 2(d) Claim

Having determined that Opposer is entitled to invoke the opposition statute, we turn to the other elements of Opposer's claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). At the outset, we observe that Opposer's trial brief does not address whether Applicant's mark causes a likelihood of confusion with Opposer's alleged VSS and DAVSS marks. Its trial brief instead argues only that Opposer has prior rights in its alleged VSS GLOBAL mark and that Applicant's application for the same mark for the same services will likely cause confusion. Therefore, Opposer has forfeited any claim that Applicant's mark is likely to cause confusion in view of Opposer's alleged VSS and DAVSS marks. *See, e.g., Bell's Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 WL 6525233, at *9 (TTAB 2017) ("Although Opposer pleaded that Applicant's mark also is confusingly similar to its mark BOTTLING INNOVATION SINCE 1985, it did not make that argument in its brief, and the claim as to the latter mark standing alone therefore is deemed waived.") (citation omitted). That leaves only Opposer's alleged VSS GLOBAL mark.

Section 2(d) prohibits registration of a mark that “so resembles ... a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). Thus, Opposer must prove both priority and likelihood of confusion, and it must do so by a preponderance of the evidence. *See, e.g., Araujo v. Framboise Holdings Inc.*, 99 F.4th 1377, 1380 (Fed. Cir. 2024) (“The opposer has the burden to prove its prior use by a preponderance of the evidence.”) (citation omitted); *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (“In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.”) (citation omitted).

As to priority under Section 2(d), an opposer must prove either ownership of a prior-filed application or registration, or else prove priority of use. Here, Opposer bases its Section 2(d) claim on allegedly prior use. “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 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.”).

Opposer’s trial brief, however, wholly fails to address whether its alleged VSS GLOBAL mark is distinctive. As noted earlier, Applicant’s answer denied Opposer’s allegation of prior common law rights in VSS GLOBAL and further asserted that Opposer’s alleged prior use “was insufficient to confer prior trademark rights to Opposer.”³⁰ The burden thus rests on Opposer’s shoulders to prove distinctiveness.

In her trial brief, Applicant notes that at least six other organizations have adopted the term VSS for their Vedic Sanskriti Schools and that, as a result, she considers VSS to be “a generic term, like, say, JHS (for Junior High School).”³¹ Indeed, an email from Devinder Mahajan, the president of Opposer in 2014,³² states that, upon learning that Applicant applied to register VSS GLOBAL, Opposer “had to oppose this filing not only to protect [Opposer] but also all Samajs using VSS. We filed the application to trademark VSS [Appl. Ser. No. 97176986] only to avoid any other claims, as it is for the use of any Arya Samaj based school.”³³ These statements by the parties strongly point to VSS being a generic term for the services at issue here.

³⁰ See 5 TTABVUE 3, 4.

³¹ See 17 TTABVUE 19; *see also id.* at 46 (noting that seven other Sanskriti Schools use VSS GLOBAL and arguing that, as a result, VSS GLOBAL “cannot be owned by any individual Sanskriti School”).

³² See 14 TTABVUE 47-48; *see also id.* at 53, 61 (Opposer responses to requests for admission indicating agreement that Devinder Mahajan took various actions on behalf of Opposer); 15 TTABVUE 8 (Opposer’s Rebuttal Notice of Reliance indicates that Devinder Mahajan made a presentation in Chicago on behalf of Opposer).

³³ See 14 TTABVUE 300.

“A generic term names a class of goods or services” *U.S. Patent and Trademark Office v. Booking. Com B.V.*, 591 U.S. 549, 554 (2020). It “is by definition incapable of indicating a particular source of the goods or services.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 972 (Fed. Cir. 2018) (cleaned up; citations omitted). Genericness is determined by first identifying the relevant goods or services at issue and then assessing whether the evidence shows that the relevant public uses or understands the term primarily to refer to those goods or services. *See, e.g., Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366 (Fed. Cir. 2018). If so, the term is generic and cannot qualify for protection or registration as a trademark or service mark. *See, e.g., id.; accord Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985); *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1569 (Fed. Cir. 1995).

Here, the parties both claim rights in VSS GLOBAL for the same services: education services in the field of Vedic culture. *See, e.g., Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 640 (Fed. Cir. 1991) (the proper focus of a genericness inquiry is on the goods or services named in the application and/or registration at issue). And the evidence of record corroborates that Opposer and other Arya Samajs who offer education services in the field of Vedic culture use “VSS” as an abbreviation for “Vedic Sanskriti School.”³⁴ Evidence that the party asserting rights in a mark and/or third

³⁴ *See, e.g.*, 13 TTABVUE 81-85, 89-91, 93-94, 96 (heading of Opposer’s PowerPoint about starting a “Vedic Sanskriti School” parenthetically abbreviates that term as “VSS”); *id.* at 99-100 (Opposer’s white paper describing what a VSS is and does also parenthetically indicates it is an abbreviation for “Vedic Sanskriti School”); 14 TTABVUE 61 (Opposer’s response to a request for admission refers to other Arya Samajs to start their own “VSSes.”); *id.* at 92 (Opposer’s answer to an interrogatory uses VSS as a generic noun: “Opposer developed the

parties use the term at issue as the name of the goods or services is evidence that the term is generic for the relevant goods or services. *See, e.g., BellSouth Corp.*, 60 F.3d at 1570 (use of the term by others in the field is evidence that the term is generic); *In re Gould Paper Corp.*, 834 F.2d 1017, 1019 (Fed. Cir. 1987) (the applicant's own usage relevant and "provided the most damaging evidence that its alleged mark is generic"). And, beyond use, Opposer's Mr. Mahajan corroborated that the term VSS is generic, indicating that Opposer filed its application to register VSS, not because it believed it had exclusive rights in the term, but to prevent others from trying to assert exclusive rights in the term, which he believes should be available "for the use of any Arya Samaj based school."³⁵ On this record, we have no difficulty finding that VSS is not inherently distinctive for education services in the field of Vedic culture.

But VSS is not the whole mark at issue. It's only the first part, followed by the term GLOBAL. The word GLOBAL is defined as "of, or relating to, or involving the

concept of VSS for other Arya Samaj's"); *id.* at 168 (Opposer newsletter using the terms "DAV Sanskriti School," "Dayanand Arya Vedic Sanskriti School," and "DAVSS" interchangeably); *id.* at 193 (Opposer newsletter parenthetically abbreviating "Vedic Sanskriti School" as "VSS"); *see also* 13 TTABVUE 83-84 (Opposer's PowerPoint stating: "Vedic Sanskriti School (VSS): What is It?" and explaining that it is a "Sunday School" located within an Arya Samaj to "To convey Vedic principles, values, culture and traditions to 5+ age children"); 17 TTABVUE 3 (section of Applicant's brief entitled "Definition of Terms" recites that "[t]he term 'Sanskriti School' (literally meaning, Cultural School) refers to school-going children's assembly operated particularly to educate them in Vedic/Hindu philosophy and culture").

We note that Applicant's brief asserts, in a section entitled "Definition of Terms," that "[t]he term 'Arya Samaj' refers to a Hindu temple but without a deity to be worshipped." *See* 17 TTABVUE 3. Opposer does contest this definition, and we note that its use of the term is consistent with Applicant's definition.

³⁵ *See* 14 TTABVUE 300.

entire earth.”³⁶ Notably, it is disclaimed in the subject application, indicating Applicant’s acknowledgement that it is non-distinctive. We further note that, in prosecution, a disclaimer was required in Opposer’s ’817 application for VSS GLOBAL.³⁷ We find that the word GLOBAL merely describes the territorial reach of the services and thus is non-distinctive.

But a determination that both constituent terms are not individually distinctive is not the end of the analysis. We must determine whether VSS GLOBAL, as a whole, is protectible. *See, e.g., Booking.com B.V.*, 591 U.S. at 556 (“the distinctiveness inquiry trains on the term’s meaning as a whole, not its parts in isolation”) (citations omitted). Opposer’s alleged mark VSS GLOBAL consists of two non-distinctive terms, VSS and GLOBAL. Opposer obviously makes no argument that the addition of the term GLOBAL somehow renders the mark something other than generic, due to Opposer’s larger failure to address the distinctiveness of VSS GLOBAL at all. Indeed, the record contradicts any such argument, revealing that Opposer added the term GLOBAL to VSS to reflect Opposer’s effort to “help[] setup local VSS ... across the globe.”³⁸ Thus, the evidence shows that the two terms together have no source-indicating meaning but, rather, retain their individual, non-distinctive meanings in

³⁶ *See* 14 TTABVUE 284 (The American Heritage Dictionary of the English Language, ahdictionary.com).

³⁷ *See* 14 TTABVUE 279-87.

³⁸ *See* 13 TTABVUE 78 (email from Opposer); *id.* at 99 (white paper discussing expanding VSSs globally); *id.* at 112 (Opposer’s email to parents of DAVSS announcing “VSS Global Virtual School ... for the students outside of the Greater Houston area”); 15 TTABVUE 24 (email from Opposer with the subject matter “VSS GLOBAL” announcing “an exciting Global initiative for everyone to be able to have the school age children attend a Vedic Sanskriti School”).

the term as a whole. *See Booking.com BV*, 591 U.S. at 560 (“A compound of generic elements is generic if the combination yields no additional meaning to consumers capable of distinguishing the goods or services.”). Namely, in the context of Opposer’s services, VSS GLOBAL means a Vedic Sanskriti School that is global in its reach.

Because the evidence establishes, at minimum, that VSS GLOBAL is not inherently distinctive for the alleged “education services in the field of Vedic Hindu culture” and Opposer has not argued, let alone established, that it has acquired distinctiveness, Opposer has failed to prove a necessary element of its Section 2(d) claim: prior trade identity rights in the sole designation asserted. For this reason, Opposer’s claim under Section 2(d) fails. *See, e.g., Towers*, 913 F.2d at 946. We need not resolve whether Opposer has established the other two required elements of its Section 2(d) claim (i.e., that Opposer used the term first and that there is a likelihood of confusion). *Cf. Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, Opp. No. 91175091, 2009 WL 691309, at *6 (TTAB 2009) (“We need not reach the issue of likelihood of confusion because without proof of priority, opposer cannot prevail.”); *Life Zone Inc. v. Middleman Grp., Inc.*, Opp. No. 91160999, 2008 WL 2781162, at *8 (TTAB 2008) (same).

V. Remand Application to Examining Attorney

Trademark Rule 2.131, 37 C.F.R. § 2.131 provides:

If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence,

the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in light of the matter referenced by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

Our finding, in view of the evidence adduced at trial, that VSS GLOBAL as a whole is not distinctive as to the services at issue, raises the issue of whether Applicant's asserted mark VSS GLOBAL qualifies for registration. In particular, Applicant referred to VSS as a generic term, noted that at least other Sanskriti Schools use the term VSS GLOBAL for identical services, and stated that VSS GLOBAL "cannot be owned by any individual Sanskriti School."³⁹

In this proceeding, Opposer did not allege or argue at trial that Applicant's alleged VSS GLOBAL mark is unregistrable due to being merely descriptive or generic. We therefore remand Applicant's application to the assigned Examining Attorney for further prosecution on the question of the potential non-distinctiveness of Applicant's asserted mark as a whole. *See* Trademark Rule 2.131, 37 C.F.R. § 2.131; *First Int'l Servs. Corp. v. Chuckles Inc.*, Opp. No. 91072787, 1988 WL 252292, at *9 n.6 (TTAB 1988); *Hecon Corp. v. Magnetic Video Corp.*, 1978 WL 21245, at *3 n.4 (TTAB 1978). In particular, we recommend the assigned Examining Attorney review the asserted

³⁹ *See* 17 TTABVUE 46.

mark for possible refusal as merely descriptive or generic under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051, 1052, 1053, and 1127.

Decision: For the reasons set forth above, we dismiss this opposition. The application will be remanded to the Examining Attorney at the appropriate time (i.e., following the expiration of the time for appeal, or following the final decision on any appeal, if it remains appropriate to remand) for consideration of the issue identified herein under Trademark Rule 2.131.