

This Opinion is not a  
Precedent of the TTAB

Hearing: August 31, 2016

Mailed: September 13, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*Aachi Spices & Foods*

*v.*

*Kalidoss Raju*

—  
Cancellation No. 92058629  
—

M. Scott Alprin and Nicholas T. Santucci of Alprin Law Offices, P.C.,  
for Aachi Spices & Foods.

Davasena Reddy of HM Law Group LLP,  
for Kalidoss Raju.

—  
Before Bergsman, Lykos and Greenbaum,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Kalidoss Raju (“Respondent”) has registered the mark AACHI AAPPAKADAI and design, shown below, for “restaurant and catering services,” in Class 43.<sup>1</sup>

<sup>1</sup> Registration No. 4375227, registered on July 30, 2013. The registration is based on application Serial No. 85772720, filed November 6, 2012, under Section 1(a) of the Trademark Act of 1946, 15 U.S.C. § 1051(a), claiming March 17, 2011 as the date of first use anywhere and September 13, 2011 as the date of first use in commerce.



In his application, Respondent provided the following translation statement: “The English translation of AACHI AappaKadai in the mark is Grandma Aappam shop.” Respondent also explained, in his application, that “[t]he word AAPPA comes from the tamil [sic] word “aappam” and describes an Indian type flat crepe.”<sup>2</sup> Thus, during the prosecution of his application for registration, the Trademark Examining Attorney required Respondent to disclaim the exclusive right to use “AappaKadai.”

Aachi Spices & Foods (“Petitioner”) petitioned to cancel Respondent’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Respondent’s mark as used in connection with restaurant and catering services so resembles Petitioner’s previously used and registered mark AACHI for a wide variety of food items as to be likely to cause confusion. Petitioner pleaded ownership of the two registrations listed below for the mark AACHI, in standard character form:

1. Registration No. 3983355 for the goods listed below:

Jellies and jams; processed peanuts; pickles; potato chips and potato crisps; ghee; dairy products excluding ice cream, ice milk and frozen yogurt; milk and milk products excluding ice cream, ice milk and frozen yogurt, in Class 29; and

---

<sup>2</sup> See also Respondent’s abandoned application for the mark AAPPAKADAI (39 TTABVue 15-17) (“[t]he English translation of ‘Aappa Kadai’ in the mark is ‘pancake shop.’”).

Masala powder and spices, in Class 30.<sup>3</sup>

2. Registration No. 4077412 for the goods listed below:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruit and vegetables; fruit sauces, namely, cranberry sauce and applesauce; fruit chips; eggs; edible oil; coconut oil and fat; coconut powder, in Class 29; and

Turmeric, flour, preparations made from cereals, namely, Indian food varieties prepared from cereals, including idlis, dosas, vadas, bondas, and bajjis; mustard; rice; masala rice for biriyani, and other spices for meat dishes of India, namely masala powder and spices for meat dishes such as mutton biriyani, mutton curry, mutton chops, mutton fry, mutton chukka, chicken biriyani, chili chicken, chicken fry, chicken lollipop, grilled chicken, pepper chicken; asafetida; chili powders; appalum and papadum, in Class 30.<sup>4</sup>

In its applications for registration, Petitioner stated that “[t]he foreign wording in the mark [AACHI] translates into English as a distinguished lady.”

Respondent, in his Answer, denied the salient allegations in the Petition for Cancellation and pleaded various affirmative and putative affirmative defenses, including the affirmative defense of laches.<sup>5</sup>

---

<sup>3</sup> Registered on June 28, 2011. This registration was based on application Serial No. 77980022, filed August 20, 2008, filed and registered pursuant to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e).

<sup>4</sup> Registered on December 27, 2011. This registration was based on application Serial No. 77551668, filed August 20, 2008, filed pursuant to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), but eventually registered based on use.

<sup>5</sup> Respondent’s fifth affirmative defense.

## I. Preliminary Issues

Respondent pleaded and argued in its trial brief 11 “affirmative” defenses. Respondent’s eighth affirmative defense (unclean hands), if successful, would prevent Petitioner from relying on its pleaded registrations.

Respondent’s first “affirmative defense” is a pleading that the Petition for Cancellation fails to state a claim upon which relief can be granted. Failure to state a claim upon which relief can be granted is an alleged defect to Petitioner’s pleading, not an affirmative defense. In this case, it has no merit.

Respondent’s second, third, seventh, tenth and eleventh “affirmative defenses” are amplifications of his defenses to the Petition for Cancellation rather than affirmative defenses.

As his fourth affirmative defense, Respondent pleaded that Petitioner’s mark is generic or merely descriptive and, as his ninth affirmative defense, Respondent pleaded that Petitioner committed fraud on the USPTO during the prosecution of its applications for registration because Petitioner did not translate the mark AACHI as “grandma.”<sup>6</sup> These allegations are attacks on the validity of Petitioner’s pleaded registrations. As such, we may not consider them absent a counterclaim to cancel those registrations. *See* 37 C.F.R. § 2.106(b) and 37 C.F.R. § 2.114(b); *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1373 n.3 (Fed. Cir. 2008); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. “42” Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968)

---

<sup>6</sup> Tenth affirmative defense.

(allegedly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration); *Contour Chair-Lounge Co. v. The Englander Co.*, 324 F.2d 186, 139 USPQ 285,287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition had been dismissed); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB1986); *Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (defense attacking validity of pleaded registration must be raised by way of cancellation of registration). Therefore, we cannot consider Respondent's fourth and ninth affirmative defenses.

As his sixth affirmative defense, Respondent pleaded that Petitioner's claims are barred by the doctrine of fair use. The "fair use" defense of Section 33(b)(4) of the Trademark Act, 15 U.S.C. § 1115(b)(4), is a defense available to a defendant in a federal action charged with infringement of a registered mark, [*See, e.g., KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 72 USPQ2d 1833,1836 (2004)], and has no applicability in *inter partes* proceedings before the Board, which involve only the issue of registrability of a mark. *See Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1454 (TTAB 1986). Further, the "noncommercial use" exception of Section 43(c)(3)(C) of the Trademark Act, 15 U.S.C. § 1125(c)(3)(C), does not apply in a Board proceeding involving a mark sought to be registered as a trademark or service mark, because an applicant seeking

registration is necessarily relying on a claim of use of its mark, or intended use of its mark, in commerce. *American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1298 (TTAB 2010). *See also Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102USPQ2d 1187, 1188 (TTAB 2012) (Board will assess alleged parody as part of the circumstances in determining whether plaintiff has made out its claim).

Finally, we review Respondent's eighth affirmative defense, an allegation that Petitioner's claims are barred by the doctrine of unclean hands because Petitioner did not translate the foreign word "aachi" as "grandma." As noted above, in its applications for registration, Petitioner stated that "[t]he foreign wording in the mark [AACHI] translates into English as a distinguished lady." Respondent argues that if Petitioner had translated "aachi" as "grandmother," the Trademark Examining Attorney may have refused registration of Petitioner's mark.

[T]he Examiner would have at such time by virtue of the doctrine of foreign equivalents conducted a search of all records that contained the words GRANDMOTHER, MOTHER, GRANDMA or any variation thereof such as Nonna, Abuela, Mama, Babushka[,] Mamina[,] etc.[.] against the applied for goods. Grandmother and Mother [have] long been used in association with food products and restaurant services as [they] suggest[] tasty food, food that is homemade, food one can trust. Accordingly, one would expect to find hundreds of trademarks at the USPTO with the term Grandmother that are associated with food or restaurant services.<sup>7</sup>

---

<sup>7</sup> Respondent's Brief, p. 9 (44 TTABVUE 14).

The equitable doctrine of unclean hands prevents a plaintiff from relying on its pleaded registration if it made a false statement during the prosecution of its application for registration or maintenance of its registration. *See Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422, 425 (CCPA 1970). In *Duffy-Mott*, the Court of Customs and Patent Appeals (a predecessor court of the U.S. Court of Appeals for the Federal Circuit), precluded the plaintiff in that case from relying upon a pleaded registration where, as here, there was no counterclaim or petition to cancel that registration. In that case, the plaintiff's predecessor had filed a combined affidavit under Sections 8 and 15 attesting to the continued use of the mark involved in that case when the mark had not in fact been in use on those goods.

We agree with applicant that the act of opposer's predecessor in interest in filing a patently false combined affidavit under sections 8 and 15 on March 15, 1960, precludes reliance in these proceedings on the registration thus maintained in force...

...[W]e are of the view that opposer may not rely on its registration for any purpose in the Patent Office or in this court on appeal therefrom. We consider that filing a sworn statement as far from the truth as was that which was filed precludes opposer from relying on the registration in these proceedings. This is in accord with the principle of the equitable doctrine of "unclean hands."

*Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 165 USPQ at 424-25. *See also Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001) (where the conduct alleged to have resulted in unclean hands relates to a plaintiff's acquisition, or attempt to acquire, a registration, the unclean hands defense goes only to the plaintiff's ability to rely on its registration, not to its common law rights); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB

2000) (a proper pleading of unclean hands in this case must include an allegation that opposer's predecessor made specific misrepresentations of fact which caused the examining attorney to allow publication of opposer's mark); *Lever Brothers Company v. Shaklee Corporation*, 214 USPQ 654, 659-660 (TTAB 1982).

Petitioner's founder and Chairman, A. D. Padmasingh Isaac, testified that "AACHI' is a popular and fond way to address women in the Chettinad region of India, and it is used to denote a distinguished lady."<sup>8</sup> On cross-examination, Mr. Isaac testified as follows:

The word AACHI is used to denote any distinguished "elderly woman." Some people use it to refer to their mother or grandmother. The word AACHI is also used to refer to elderly persons other than one's mother or grand mother [sic].<sup>9</sup>

Nevertheless, Petitioner used the word "Aachi" as meaning grandmother and/or mother on its website as described below:

#### Aachi – The Word

'Aachi' is a fond reference to 'Grand Mother' in Chettinad Tamil. Food made by mother is always special and in good taste. If mother has a language of her own, it is the language of love and good taste. Good tasting food is always a favourite with the young and old.<sup>10</sup>

Respondent introduced a decision of the High Court of Madras, India regarding a case between Petitioner and Aachi Aapakadai Chettinad A/c Restaurant in India to show the meaning of the word "Aachi."

---

<sup>8</sup> Testimony declaration of A. D. Padmasingh Isaac ¶5 (22 TTABVUE 7-8).

<sup>9</sup> Petitioner's responses to Respondent's cross-questions ¶1C (22 TTABVUE 100).

<sup>10</sup> 40 TTABVUE 98.



6(1) The word 'AACHI' is a common Tamil word, which is prominently used in Chettinad region of Tamil Nadu. The simple meaning of the word 'AACHI' is elderly woman. This word is commonly used in relation to Chettinad Style of cooking.<sup>11</sup>

Because the word "Aachi" appears to have several meanings (*e.g.*, distinguished lady, elderly woman, grandmother, *etc.*), we cannot find that Petitioner made a false statement during the prosecution of its applications for registration by submitting the translation of "Aachi" as a distinguished lady.

Also, it is not clear that the Trademark Examining Attorney would have applied the doctrine of foreign equivalents to translate the word "Aachi" to "grandmother" and then search for and potentially cite as a bar to registration any relevant mark incorporating the word "grandmother" or a foreign equivalent. "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation ..." *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005)). "The translation ... must be one that is likely to be made by a significant number of prospective purchasers." *Bottega Venetta, Inc. v. Volume Shoe Corp.*, 226 USPQ 964, 967 (TTAB 1985) (quoting *Jules Berman & Assoc., Inc. v. Consolidated Distilled Prods., Inc.*, 202 USPQ 67, 70 (TTAB 1979)). "When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign

---

<sup>11</sup> Respondent's second notice of reliance, Exhibit 115 (40 TTABVUE 104 at 107).

equivalents will not be applied.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1696 (citing *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975) (“it is unlikely to expect that a person encountering ‘AUNT MARY’S’ canned fruits and vegetables in a supermarket or other establishment where goods of this type are customarily sold would translate ‘AUNT MARY’S’ into ‘TIA MARIA’, and then go one step further and associate these food products with applicant’s restaurant.”) and *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976) (the doctrine of foreign equivalence should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent)).

“Aachi” is a word derived from the Tamil language. “Tamil is a language spoken in the State of Tamil Nadu in India. Tamil Nadu is one of the 28 States in India.”<sup>12</sup> As of 2011, Tamil Nadu had a population of 72 million. “Although Tamil is also one of the official languages of Srilanka and Singapore, it is spoken by a linguistic minority in these countries.”<sup>13</sup> However, there is no evidence or testimony regarding how many consumers in the United States speak Tamil. Accordingly, based on the record, in comparing the word “Aachi” with “grandmother,” there is no evidence that an appreciable number of purchasers are likely to be aware that “Aachi” means “grandmother” and, therefore, we find that consumers in the United States are unlikely to translate the word “Aachi” into English.

---

<sup>12</sup> Isaac Declaration ¶5 (22 TTABVUE 7-8).

<sup>13</sup> Isaac Cross-examination Declaration ¶1A (22 TTABVUE 100).

Finally, although Respondent forcefully argues that there are numerous marks comprising the word “Grandmother,” Respondent did not introduce any evidence supporting the argument. *See In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (Board will not take judicial notice that there are thousands of registered marks incorporating the term NEW YORK for goods and services that do not originate there), *aff’d*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) (the Board does not take judicial notice of third-party registrations).

In view of the foregoing, Respondent’s eighth affirmative defense of unclean hands is denied. Petitioner may rely on the presumptions afforded a registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

We discuss Respondent’s fifth affirmative defense of laches after we analyze and decide Petitioner’s likelihood of confusion claim because laches is applicable only if we find that there is a likelihood of confusion.

## II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Respondent’s registration file. The parties stipulated to direct testimony by sworn declaration and cross-examination by written questions.<sup>14</sup>

### A. Petitioner’s testimony and evidence.

---

<sup>14</sup> 16 TTABVUE.

1. First notice of reliance on third-party websites purportedly showing both restaurant and/or catering services and grocery store services;<sup>15</sup>
2. Second notice of reliance on the testimony declaration of A. D. Padmasingh Isaac, Petitioner's founder and Chairman, with attached exhibits, including copies of Petitioner's pleaded registrations printed from the USPTO Trademark Status and Document Retrieval (TSDR) database showing the current title to and status of the registrations;<sup>16</sup>
3. Third notice of reliance on third-party registrations including both food products and restaurant and/or catering services in the description of goods and services;<sup>17</sup>
4. Fourth notice of reliance on Respondent's responses to Petitioner's written discovery, including requests for admission;<sup>18</sup> and
5. Fifth notice of reliance on the following items:<sup>19</sup>
  - a. Copies of Petitioner's pleaded registrations printed from the USPTO Trademark Status and Document Retrieval (TSDR) database showing the current title to and status of the registrations;
  - b. A copy of Respondent's abandoned application information printed from the USPTO TSDR database for the mark AAPPAKADAI for restaurant

---

<sup>15</sup> 21 TTABVUE.

<sup>16</sup> 22 TTABVUE.

<sup>17</sup> 25 and 27-38 TTABVUE.

<sup>18</sup> 23-24 and 26 TTABVUE.

<sup>19</sup> 39 TTABVUE.

services which includes a translation statement that “[t]he English translation of ‘Aappa Kadai’ in the mark is ‘pancake shop’”;<sup>20</sup> and

- c. A copy of the May 9, 2012 Office Action in Respondent’s abandoned application for the mark AAPPAKADAI.

B. Respondent’s testimony and evidence.

1. First notice of reliance on the following items:<sup>21</sup>

- a. Petitioner’s responses to Respondent’s written discovery, including requests for admission;<sup>22</sup>
- b. Documents Respondent disclosed to Petitioner as attachments to written discovery and initial disclosures,<sup>23</sup> namely,

---

<sup>20</sup> Serial No. 85525485.

<sup>21</sup> 40-41 TTABVUE. In his first notice of reliance, Respondent identified testimony and evidence previously introduced by Petitioner. Testimony and evidence made of record may be relied on by any party for any purpose permitted by the Federal Rules of Evidence. *See* Trademark Rule 2.120(j)(7), 37 C.F.R. § 2.120(j)(7). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (applicant may rely on copy of opposer's website made of record by opposer's deposition); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (notice of reliance on deposition already made of record by the other party is superfluous); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 432 n.6 (TTAB1985) (stipulation that deposition relied on by opposer may also be considered as part of applicant's case was unnecessary); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB1984); *Miles Laboratories, Inc. v. SmithKline Corp.*, 189 USPQ 290, 291 n.4 (TTAB 1975).

<sup>22</sup> Only an admission to a request for admission may be introduced into evidence through a notice of reliance. Trademark Rule 2.120(j)(3)(i), 37 C.F.R. § 2.120(j)(3)(i). *See, e.g., N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1501 n.11 (TTAB 2015) (Board considered only opposer’s admissions, not denials, in response to applicant’s requests for admission).

<sup>23</sup> Respondent, as the producing party, may not introduce these documents through a notice of reliance; only the receiving or inquiring party may introduce documents received as part of initial disclosures or discovery. Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5). However, because Petitioner did not object to the documents identified in Respondent’s first notice of reliance and acknowledged Respondent’s first notice of reliance in its brief

1. Respondent's menu;
2. Respondent's website (without a URL and date);<sup>24</sup>
3. A decision of the High Court of Madras for a case between Petitioner and Aachi Cargo Channels Private Limited;<sup>25</sup>
4. Excerpts from websites displaying restaurants using the word "Aachi" as part of their trade name;<sup>26</sup>
5. Posters used by Respondent;
6. Photograph of Respondent's van; and
7. Excerpt from the SpicyIP website commenting on the decision of the High Court of Madras between Petitioner and Aachi Cargo Channels Private Limited noted above.

---

(Petitioner's Brief, p. 8 (43 TTABVUE 14)), we consider those documents to be stipulated into evidence.

<sup>24</sup> Parties may introduce evidence obtained through the Internet by notice of reliance, but only if the URL and date of publication or date the document was printed are identified. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1038 (TTAB 2010) (if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e)). With the exception of the decision of the High Court of Madras, discussed *supra*, none of Respondent's Internet evidence include the URL or date of printing. As noted in footnote 22, because Petitioner did not object to the documents and acknowledged them in its brief, we consider the Internet evidence to be stipulated into evidence.

<sup>25</sup> 41 TTABVUE 17. This is a second decision of the High Court of Madras and not the decision previously discussed. In this decision, the court translated "Aachi" as "grandmother." 41 TTABVUE 20.

<sup>26</sup> Only four of the restaurants identified in the websites have locations in the United States. The websites of restaurants located outside of the United States have little, if any probative value, because there is no evidence that those restaurants are encountered by U.S. consumers.

2. Second notice of reliance on the following items:<sup>27</sup>
  - a. Excerpts from Petitioner’s website;
  - b. Excerpts from the statista.com, numberof.net and restaurant.org websites purporting to show the number of restaurants in the U.S.;
  - c. An article posted on The Times of India website (no URL) regarding the decision of the High Court of Madras between Petitioner and Aachi Cargo Channels Private Limited noted above;<sup>28</sup>
  - d. A copy of the decision of the High Court of Madras between Petitioner and Aachi Aappakadai Chettinad A/C posted February 28, 2014 at indiankanoon.org and referenced in the discussion of Respondent’s affirmative defense of unclean hands;<sup>29</sup> and
  - e. An excerpt from the Business Insider website (no URL) purporting to identify the number of Indian restaurants in the United States; and
3. Third notice of reliance on third-party registrations for restaurant services purportedly representative of restaurants that are not registered for “retail” services.<sup>30</sup>

### III. Standing

Because Petitioner has properly made of record its pleaded registrations, Petitioner has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d

---

<sup>27</sup> 40 TTABVUE 93-117.

<sup>28</sup> 40 TTABVUE 102.

<sup>29</sup> 40 TTABVUE 104

<sup>30</sup> 40 TTABVUE 7-92.

943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

#### IV. Priority

In a cancellation proceeding in which both parties own registrations, Petitioner must, in the first instance, establish prior rights in the same or similar mark, and Respondent can in turn defeat Petitioner's claim by establishing that, as between the parties, Respondent possesses prior rights in the mark sought to be canceled.

Of course, Petitioner or Respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date. Thus, a petitioner -- whose application filing date was earlier than respondent's application filing date -- could take its chances and elect to make of record simply a copy[ ] of its registration. Trademark Rules 2.122(d)(1) and 2.122(d)(2). By so doing, Petitioner's proven first use date of its mark would then be the filing date of the application. However, if Respondent proves an actual first use date pre-dating Petitioner's filing date, the issue of priority, and hence Petitioner's Section 2(d) claim, would be resolved in favor of Respondent.

*Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998).

Because Respondent did not introduce any testimony or evidence regarding his dates of first use, we look to the filing dates of the applications of the respective parties to prove priority.<sup>31</sup> Petitioner filed its applications for registration on June 28,

---

<sup>31</sup> The Board does not consider the dates of use recited in an application to establish priority. "The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence." Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2). Therefore, we do not consider the dates of use in Respondent's application for registration.



2011 and December 27, 2011.<sup>32</sup> Respondent filed his application for registration on November 6, 2012. Therefore, Petitioner has established prior use of the mark AACHI.

## V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, \_\_U.S. \_\_, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative

---

<sup>32</sup> Respondent’s argument that “Petitioner’s discrepancies in his [sic] statements regarding the dates of first use serves to prove that we cannot believe the first use date of his mark as contained in the USPTO record” (Respondent’s Brief, p. 7 (44 TTABVUE 12)) is unavailing because we are relying on the filing date of Petitioner’s applications to establish priority and not on actual dates of use.

effect of differences in the essential characteristics of the goods and differences in the marks.”). *See also In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1409 (TTAB 2015).

A. The similarities or dissimilarities of the marks.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”)).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average

customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because Respondent's mark is registered for restaurant and catering services without any restrictions or limitations and Petitioner's mark is registered for food items without any restrictions or limitations, the average customer is an ordinary consumer.

Petitioner's mark is the word AACHI in standard character form. Respondent's mark is AACHI AAPPAKADAI and design shown below:



Marks presented in standard characters are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording, and not in any particular display. Thus, Petitioner is entitled to all depictions of its standard character mark regardless of the font style, size, or color. Petitioner's mark could at any time in the future be displayed in a manner similar to Respondent's mark, that is, the word displayed in the same font style, size, and with a design element. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that a mark in standard character format

(typed) is distinct from a mark in a logo format; “[b]y presenting its mark in a typed drawing, a *difference* cannot legally be asserted by that party” (emphasis in original)); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

Respondent’s mark incorporates Petitioner’s entire mark. While there is no explicit rule that likelihood of confusion automatically applies where a junior user’s mark contains in part the whole of another mark, the fact that Petitioner’s mark is subsumed by Respondent’s mark increases the similarity between the two. *See, e.g., Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant’s mark BENGAL LANCER for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant’s mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus confusingly similar to TITAN for medical ultrasound diagnostic apparatus); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (applicant’s mark MACHO COMBOS for food items confusingly similar to MACHO for restaurant entrees); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY’S ACCU TUNE for automotive service centers confusingly similar to ACCU-TUNE for automotive testing equipment).

On the other hand, because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be

based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

In this regard, although the marks share the word “Aachi,” they are otherwise dissimilar because the word “AappaKadai” is the dominant part of Respondent’s mark as it is displayed in much larger lettering and Respondent’s mark contains a leaf design. The leaf design has a limited role in our analysis. In the case of marks consisting of words and a design, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the services. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation’s Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107

USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)).

To consumers unfamiliar with the Tamil language, the terms “Aachi” and “AappaKadai” are arbitrary terms without any meaning associated with food products and restaurant and catering services. While the marks have their differences, consumers encountering both marks may mistakenly believe that AACHI AappaKadai is the restaurant and catering line of the AACHI food products company because they share the word “Aachi.”

On the other hand, consumers familiar with the Tamil language know that the word “Aachi” means “grandmother” or one of its other possible meanings and that the word “AappaKadai” means “aappam shop.” Thus, the word “AappaKadai” is descriptive and has less significance than the word “Aachi.” It is well-settled that descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re National Data Corp.*, 224 USPQ at 752); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

To the extent that Respondent is relying on the decision of the High Court of Madras in finding that the word “Aachi” is in common use and, therefore, “Aachi” is

not a distinctive term, decisions from foreign courts have little relevance in Board proceedings. It is well settled that trademark rights are territorial in nature and that the protection of a trademark in a certain country depends exclusively on the law of that country. *See Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999); *Miles Laboratories, Inc. v. International Diagnostic Technology, Inc.*, 220 USPQ 438, 445 (TTAB 1983), *aff'd*, 746 F.2d 798, 223 USPQ 977 (Fed. Cir. 1984). We have consistently held that information and decisions relative to trademark disputes in foreign jurisdictions are not controlling on a determination of a party's right to register in the United States. *See Societe Civile des Domaines Dourthe Freres V. S.A. Consortium Vinicole de Bordeaux et de la Gironde*, 6 USPQ2d 1205, 1207 n.6 (TTAB 1988); *Faberge, Inc. v. Dr. Bador GmbH & Co.*, 219 USPQ 848, 850 (TTAB 1983); *Beck & Co. v. Package Distributors of America, Inc.*, 198 USPQ 573, 575 n. 4 (TTAB 1978); *Hiram Walker & Sons, Inc. v. Canadian Distilleries Ltd.*, 176 USPQ 156, 158 (TTAB 1972).

We note that Respondent has introduced excerpts from four third-party websites for restaurants using the word “Aachi” as part of their trade name. Excerpts from four websites, without any evidence regarding the extent of their geographic trading areas, amount of business, and number of consumers, are insufficient to support Respondent’s argument that Petitioner’s mark is a weak term entitled to only a narrow scope of protection or exclusivity of use.

Finally, as discussed above, Respondent failed to introduce any evidence regarding the number of third-party registrations for the term “Grandmother” and/or

variations and translations thereof which would support Respondent’s argument that if the doctrine of foreign equivalents were applied, AACHI is a weak mark.

In view of the foregoing, we find that the marks are similar in their entirety in terms of their appearance, sound, connotation and commercial impression.

**B. The similarity or dissimilarity and nature of the goods and services.**



To show that Respondent’s restaurant and catering services are related to Petitioner’s food products, Petitioner introduced 450 use-based, third-party registrations with descriptions of goods and services incorporating food products and restaurant and/or catering services. Third-party registrations which individually cover a number of different goods and services that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The registrations listed below are representative.<sup>33</sup>

<b>Mark</b>	<b>Reg. No.</b>	<b>Goods and Services</b>
<b>Tiny’s Giant</b>	4240282	Meat, fish, cooking oil, ready-made sauces, Restaurant and catering services

---

<sup>33</sup> We have not included the entire description of goods and services for each registration. We have listed only the goods and services relevant to this decision as arguably encompassing the goods and services at issue.



Mark	Reg. No.	Goods and Services
	4406010	Beverages consisting principally of milk, candied fruits and vegetables, edible oils, fish, processed meat, royal jelly  Restaurant and catering services
<b>HOUSE FOODS</b>	4470956	Wheat flour based sauce mixes for use in curry, meat stews, fish stews, hashed beef stews and gratin; sauces; spices; seasonings; rice mix  Restaurant services
<b>DeCicco Family Markets</b>	4536562	Cut fruits; chicken; fruit-based spreads; fruits in preserved form; jellies; jams; marinated meat, fish and poultry; meat; preserved fruits and vegetables; spicy peanuts  Catering services
	4650037	Jellies and jams; sauces; spice rubs  Catering services

Under this *du Pont* factor, Petitioner need not prove, and we need not find, similarity as to each and every product listed in the description of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods and services in a particular class in the registrations. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d at 1409; *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1

(TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

Furthermore, the record is clear that Petitioner's products are Indian-style food products and that Respondent renders restaurant and catering services specializing in Indian-style food. *See Chicago Bears Football Club Inc. v. 12<sup>th</sup> Man/Tennessee LLC*, 83 USPQ2d 1073, 1078-79 (TTAB 2007) (noting that "applicant has made it clear that it intends to actually market its goods to purchasers would be identical to opposer's fans and purchasers.").

To counter this evidence, Respondent introduced copies of 42 third-party use-based registrations for restaurant services purportedly representative of restaurants that are not also registered for "retail" services.<sup>34</sup> As we indicated above, third-party registrations can be used to suggest that the goods and services are related because the same party has registered a common mark for the goods and services at issue in a likelihood of confusion case. Similarly, defendants may submit sets of third-party registrations to suggest the opposite (*i.e.*, that the USPTO has registered the same mark to different parties for the goods and services at issue). *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009) ("On the other hand, applicant has submitted copies of 13 sets of registrations for the same or similar marks for different types of trailers owned by different entities arguing, in essence, that the third-party registrations serve to suggest that the listed goods are of a type which may emanate from different sources."). *See also Helene Curtis Industries v. Suave Shoe Corp.*, 13

---

<sup>34</sup> 40 TTABVUE 7-92.

USPQ2d 1618, 1624 (TTAB 1989) (“In connection with its related goods arguments, plaintiff has made of record numerous third-party registrations and exhibits to show that it is common in the trade for the same mark to appear both on personal care products and wearing apparel emanating from the same source. Defendant, on the other hand, has introduced registrations and exhibits to show registration and use of the same or similar marks on these same types of products, but emanating from different sources.”).

Respondent’s evidence simply consists of registrations that list Respondent’s services but do not include any of Petitioner’s goods. Respondent did not introduce registrations for the same or similar marks for food products registered to one entity and restaurant and/or catering services to another entity. We give this evidence much less weight than Petitioner’s third-party registration evidence. There is no requirement that for goods and services to be found related that all or even a majority of the sources of one product and/or service must also be sources of the other products and/or services. Therefore, evidence showing only that the source of one product may not be the source of specific services does not aid Respondent in his attempt to rebut Petitioner’s evidence. *See In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d 1366, 1370 (TTAB 2009). *See also In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011)

Also, the mere fact that some goods and activities are not included in the identification of goods and/or services of a specific registration does not establish that *the owner of the mark* has not registered the mark for those goods and/or services in

another registration since, for example, the registrant may have begun using the mark on those goods and/or at a later date. *See In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d at 1370.

Finally, the law recognizes that trademark owners have different marks that are used as a house mark, a mark for a line of products, and a mark for specific items. It is, therefore, to be expected that many registrations for marks would not cover all of a party's goods and services. The fact that Respondent was able to find and submit for the record these registrations of marks for restaurant services does not rebut the Petitioner's evidence showing the existence of numerous third-party registrations using the same marks in connection with Petitioner's goods and Respondent's services. While this evidence provides some indication that there are many trademarks that are not registered for both products and services, it does not rebut Petitioner's evidence that the goods and services are related. *See In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d at 1370.

In view of the foregoing, we find that the food products listed in Petitioner's registrations are related to Respondent's restaurant and catering services.

C. Established, likely-to-continue channels of trade.

Petitioner submitted excerpts from 32 third-party websites advertising their restaurant and/or catering services and grocery store services.<sup>35</sup> Twenty-seven of the third-party websites are for Indian restaurants and grocery stores. To rebut this evidence, Respondent introduced excerpts from third-party websites to show that in

---

<sup>35</sup> 21 TTABVUE.

2015 there were approximately 1,000,000 restaurants in the United States,<sup>36</sup> including 5,000 Indian restaurants.<sup>37</sup> Respondent asserts that “27 restaurants that have restaurant services and Indian groceries out of 5,000, is a very small fraction and does not prove that it is common for Indian shops to sell groceries and have restaurant services.”

First, Respondent’s website evidence is hearsay. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d at 1040 (Internet documents submitted through a notice of reliance are admissible only to show what has been printed, not the truth of what has been printed).

Second, it is not necessary for a party to introduce every document obtained from an Internet search. The Board discourages the needless presentation of cumulative evidence. As Judge Rich commented in *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1451 (Fed. Cir. 1987): “It is indeed remarkable to see the thoroughness with which NEXIS can regurgitate a place name casually mentioned in the news.” The same can be said for the ability of Internet search engines. *See also Blue Man Productions Inc. v. Tarman*, 75 USPQ2d 1811, 1817-1819 (TTAB 2005), *rev'd on other grounds*, Civil Action No. 05-2037 (D.D.C. April 3, 2008) (“when unacceptable material, duplicative material, and material with no real probative value is removed, the amount of evidence showing recognition of opposer's mark is far less than the eleven-page listing in opposer's notice of reliance

---

<sup>36</sup> The National Restaurant Association website at restaurant.org (40 TTABVUE 101).

<sup>37</sup> The BusinessInsider.com website (40 TTABVUE 117).

would lead one to expect”). It is sufficient for the parties to submit enough evidence to make their point.

We find that Respondent’s services move in the same channels of trade and are sold to the class of consumers as Petitioner’s goods.

D. Analyzing the factors.

Because the marks are similar, the goods and services are related, and the goods and services move in the same channels of trade, we find that Respondent’s mark



for restaurant and catering services is likely to cause confusion with Petitioner’s mark AACHI for a wide variety of food products.

Respondent argues, to the contrary, that the record fails to support finding that Petitioner’s food products and Respondent’s restaurant and catering services are sufficiently related to find that there is a likelihood of confusion. It is well settled that the fact that restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining the likelihood of confusion. Instead, “[t]o establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). (Emphasis added). In this case, we find that Petitioner satisfied the “something more” standard to find that there is a likelihood of confusion inasmuch as the marks share a similar arbitrary term (*i.e.*,

AACHI), 450 third-party registrations serve to suggest that food products and restaurant and catering services emanate from a single source, and 31 excerpts from third-party websites show that restaurant services and grocery store services, specifically Indian restaurants and groceries, move in the same channels of trade and are sold to the same classes of consumers. *See In re Opus One, Inc.*, 60 USPQ2d 1812, 1813-14 (TTAB 2001) (finding that “the requisite ‘something more’ exists, both in the strong and arbitrary character of registrant’s OPUS ONE mark and the resulting broad scope of protection to which the mark is entitled ... and in the specific commercial relationship between wine and restaurant services.”). *Compare* cases in which the weakness of the prior mark weighed against finding a likelihood of confusion, such as *In re Coors Brewing Co., supra* (BLUE MOON is a widely used term in connection with restaurant and food products); *Jacobs v. International Multifoods Corp., supra* (BOSTON TEA PARTY used in connection with tea cannot be classified as an arbitrary mark).

## VI. Laches

In order to prevail on his affirmative defense of laches, Respondent is required “to establish that there was undue or unreasonable delay [by Petitioner] in asserting its rights, and prejudice to [Respondent] resulting from the delay.” *Bridgestone/Firestone Research Inc. v. Automobile Club de l’Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462-1463 (Fed. Cir. 2001); *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

A critical factor when considering a laches defense in a cancellation proceeding is the length of delay between the time when a Petitioner first has notice of a defendant and its mark and the time when Petitioner files the petition for cancellation. *See, e.g., Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203, 1210 (TTAB 2006), *aff'd*, Appeal Nos. 2006-1366 and 1367 (Fed. Cir. Dec. 6, 2006) (3 years, 8 months of unexplained delay held sufficient for laches). A Petitioner must be shown to have had actual knowledge or constructive notice of a registrant's trademark use to establish a date of notice from which delay can be measured. *Loma Linda Food Co. v. Thomson & Taylor Spice Co.*, 279 F.2d 522, 126 USPQ 261, 263 (CCPA 1960); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1114 (TTAB 2007). In the presence of actual knowledge of defendant and its mark prior to publication for opposition, the date of publication is the operative date for laches. *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1431-32 (Fed. Cir. 1991). "In the absence of actual knowledge prior to the close of the opposition period, the date of registration is the operative date for laches," as it provides constructive notice to petitioner of registrant's claim of ownership. *Teledyne Technologies v. Western Skyways*, 78 USPQ2d at 1210, n.10 and the authorities cited therein; *see also Jansen Enterprises*, 85 USPQ2d at 1114 (publication in *Official Gazette* does not provide constructive notice). Thus, laches begins to run no earlier than the date the involved mark was published for opposition (actual knowledge), and no later than the issue date of the registration (constructive notice).



In this case, the earliest dates for determining whether there has been undue delay are the May 14, 2013 publication date for Respondent's application for registration (actual knowledge) and the July 30, 2013 issue date for Respondent's registration (constructive notice). Petitioner's principal testified that he "first learned that [Respondent] was using the AACHI mark in connection with his restaurant in 2013."<sup>38</sup> In view of the uncertainty of Petitioner's testimony and evidence regarding the date it became aware of Respondent, we find that the latest date on which Petitioner may rely is May 14, 2013, the publication date of Respondent's application. *Cf. 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); *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). Because Petitioner filed the petition for cancellation on January 31, 2014, the length of time between Petitioner's knowledge (May 14, 2013) and the filing date of the petition for cancellation (January 31, 2014) is eight months. An eight month delay is a limited period of time. Respondent has not cited, nor have we found, any cases supporting such a short period of time as sufficient to support a laches claim. *See Nashin v. Product Source International LLC*, 107 USPQ2d 1257, 1263 (TTAB 2013) (18 months not sufficient to establish laches); *Charrette*

---

<sup>38</sup> Isaac Testimony Declaration ¶22 (22 TTABVUE 11). *See also* Petitioner's response to Respondent's Interrogatory No. 1 (41 TTABVUE 11) (2013).

*Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2043 (TTAB 1989) (14 month delay not sufficient to establish laches). We find that an eight month delay does not constitute an unreasonable delay and, accordingly, Respondent has failed to meet the first element of a laches defense. We, therefore, need not assess whether Respondent has satisfied the prejudice requirement.

**Decision:** The petition for cancellation is granted.