

This Opinion is Not a
Precedent of the TTAB

Mailed: April 24, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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M/S White Feathers Restaurant Private Ltd.
v.
Moti Mahal Delux Management Services Private Ltd.

—
Cancellation No. 92061198
—

Kevin S. Klein and George D. Rosenbaum of Rosenbaum & Rosenbaum, P.C.
for M/S White Feathers Restaurant Private Limited.

Stacy J. Grossman, Esq.
for Moti Mahal Delux Management Services Private Limited.

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Before Taylor, Wolfson and Lykos,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On April 1, 2015, M/S White Feathers Restaurant Private Ltd. (“Petitioner”) petitioned to cancel the following registration owned by Moti Mahal Delux Management Services Private Ltd. (“Respondent”):

Registration No. 4664064 for the standard character mark MOTI MAHAL on the Principal Register for “Bar services; cocktail lounge services; restaurant services; bed and breakfast inn services; Bistro services; cafe services; cafeterias; carry-out restaurants; catering services; consulting services in the field of culinary arts; consulting services in the field of hospitality; fast-food restaurant services; snack bar services; Food preparation

services featuring fresh, properly proportioned, healthy meals designed to fuel metabolism and burn fat and made to order for delivery or pick up; Hotel services; Motel services; preparation of food and beverages; Providing social meeting, banquet and social function facilities; restaurant carryout services; Restaurant reservation services; Restaurant services featuring Indian cuisine; Restaurant services, including sit-down service of food and take-out restaurant services; restaurant services, namely, providing of food and beverages for consumption on and off premises; restaurants featuring home delivery; self service restaurants; serving of food and drink/beverages; canteen services; take-out restaurant services; wine bars” in International Class 43.¹

In the Petition to Cancel, Petitioner pleads ownership of Application Serial No. 85672701 for the composite mark displayed below,



alleging that Petitioner first used the mark displayed in the application in commerce “on or about June 1, 2012 in connection with running a successful Indian restaurant, Moti Mahal Delux, 1149 1st Avenue, New York, NY 10065”; that Petitioner’s restaurant “received food reviews from reputable news outlets such as the Wall Street Journal as early as August 2012 and the New York Times as early as December 2012”; and that further action on Petitioner’s pending application (Serial No. 85672701) was suspended

¹ Registered December 30, 2014, based on an application filed September 19, 2011 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The statement of use was filed on November 13, 2014, and alleges November 11, 2014 as the date of first use anywhere and in commerce.

on November 7, 2012 and the application remains suspended based on Respondent's previously registered mark. Petition to Cancel ¶¶ 7, 11, 25; 1 TTABVUE 4, 6.² As grounds for cancellation,³ Petitioner alleges that "...registrant never intended to use the mark 'MOTI MAHAL' in commerce and in fact has never used said mark in commerce;" that Respondent's specimen supporting its statement of use is a menu for another restaurant named Tulsi that "is in no way connected to any 'commerce' by registrant;" that the address of 211 East 46th Street, New York, NY displayed on the specimen under the mark Moti Mahal is the address of Tulsi and not of any restaurant owned by Respondent; that Respondent devised the menu "to create the appearance as though it had a restaurant operating at 211 East 46th Street, New York, NY;" that the menu is "in no way connected to the ... services" identified in Respondent's registration; that Respondent has no ownership or management stake in Tulsi; and that Respondent obtained its registration "through deceptive means and in bad faith with intent to harm petitioner... ." *Id.* at ¶¶ 16-22, 24; 1 TTABVUE 5-6.

Respondent filed an answer on May 8, 2015, admitting that Petitioner is the owner of Application Serial No. 85672701 and that Office records show that Petitioner's application was suspended on November 7, 2012 (¶¶ 7 and 11), but otherwise denying the salient allegations in the Petition to Cancel. 4 TTABVUE 2-6.

² For the citations to the record in TTABVUE throughout the decision, the number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Portions of the record have been designated confidential.

³ The affidavit of Chef Hemant Mathur submitted as Exhibit A with the Petition to Cancel is not part of the trial record and has been given no consideration. *See* Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a).

The case is now fully briefed. As plaintiff in this proceeding, Petitioner bears the burden of establishing its standing and proving its claims by a preponderance of the evidence. In reaching our decision, we have not considered any statements made by either party in their briefs that are unsupported by evidence in the record. *See Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010).

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the involved registration file.⁴

During its main testimony period, Petitioner submitted the oral testimony deposition of restaurateur Gurav Anand, owner of Tripti, Inc., Petitioner's partner in Moti Mahal Delux restaurant (14 TTABVUE) and Hemant Mathur, the chef of Tulsi restaurant,⁵ (15 TTABVUE), each with exhibits. Petitioner also submitted a notice of reliance on certain documents (13 TTABVUE), including Petitioner's Interrogatories dated December 3, 2015 and Respondent's Responses thereto (Exhibits A and B); Petitioner's Document Production Requests dated November 5, 2015 and Respondent's Responses thereto (Exhibits L and M); the "Home Page," "Menus," "All Locations," and "Business Solicitation" landing pages from Respondent's website <http://motimahal.in> (Exhibits C-F); and the Office action

⁴ As such, Petitioner's submission under notice of reliance of portions of the registration file (Notice of Reliance Exhibits G-K; 13 TTABVUE 60-84) was superfluous. *See ITC Entm't Group Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021 (TTAB 1998).

⁵ In accordance with the Board's December 26, 2017 order (51 TTABVUE 4-5), no consideration has been given to Petitioner's rebuttal testimony of Chef Mathur (41 TTABVUE), insofar as Petitioner failed to submit a signed transcript by the witness. *See* Trademark Rule 2.123(e)(5), 37 C.F.R. § 2.123(e)(5). In addition, the Board granted Respondent's motion to strike the affidavit of Chef Mathur, improperly submitted with Petitioner's rebuttal disclosures on February 2, 2017. *See* April 27, 2017 Board Order, 39 TTABVUE 2.

showing suspension of Petitioner's Application Serial No. 85672701 based on Respondent's Registration No. 4664064 (Exhibit N).

Respondent submitted the deposition on written questions and cross-examination questions of its Director, Monish Gujral, who resides in India, with exhibits.⁶ 25-27 TTABVUE. Respondent did not submit any documents under notice of reliance.

II. Respondent's Objections

During Mr. Anand's testimony deposition, Respondent interposed multiple objections to Mr. Anand's testimony on the basis that Mr. Anand lacks the requisite authority to testify on Petitioner's behalf. Respondent lodged objections on various other grounds as well such as lack of personal knowledge, hearsay and lack of foundation. Respondent maintains these objections in its main brief.

We note Mr. Anand's business relationship with Petitioner and testimony and supporting documentation whereby Petitioner authorized Mr. Anand to "prepare, sign, file any document, application, notice, evidence, affidavit, counter affidavit" in connection with this proceeding. Anand Deposition 11:20-12:4, Ex. 1 ("Letter of Authority dated May 19, 2016"); 14 TTABVUE 14-15, 85. We thus overrule Respondent's objection on that basis.

As for Respondent's objection to the testimony on other grounds, the Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony. *Alcatraz Media, Inc. v. Chesapeake*

⁶ On April 27, 2017, the Board granted Respondent's motion to quash or strike Petitioner's Notice of Cross-Questions (filed at 30 TTABVUE) and Amended Notice of Cross-Questions (filed at 32 TTABVUE) of Mr. Gujral. 39 TTABVUE 2-3. Accordingly, we have not considered them.

Marine Tours, Inc., 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.) (citing *Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) and *Marshall Field & Co. v. Mrs. Fields Cookies*, 15 USPQ2d 1321, 1326 (TTAB 1992)); *see also Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014). In accordance with our practice, we have not stricken any of the objected-to testimony offered by Mr. Anand; rather, we have considered the probative value of his testimony in light of Respondent's specific objections. *See Alcatraz Media*, 107 USPQ2d at 1755.

Respondent also objects to portions of Mr. Anand's testimony as exceeding the scope set forth in Petitioner's pretrial disclosures. *See* Petitioner's Pretrial Disclosures, 11 TTABVUE 3. Again we do not strike Mr. Anand's testimony, but have kept in mind the scope of his testimony as identified in the pretrial disclosures.

III. Factual Background

The following is a brief description of the relevant entities and individuals who either appeared as witnesses or are mentioned in the record:

A. Entities

- Petitioner, M/S White Feathers Restaurant Private Ltd. located in New Delhi, India: Co-owner of Moti Mahal Delux Restaurant in New York City along with Tripti, Inc. Anand Deposition 8:9-10:7, 39:10-40:20; 14 TTABVUE 12-13, 42-43.
- Respondent, Moti Mahal Delux Management Services Private Ltd., located in New Delhi, India: Established in 2004 in India as a family business to franchise the MOTI MAHAL mark and sub-brands internationally, it operates over 100 restaurants in India as well as in New Zealand, Africa, and the Middle East, directly and through franchisees. Gujral Deposition 4:13-21, 6:8-8:2; 25 TTABVUE 5, 7-9.
- Tripti, Inc.: A corporation established by restaurateur Gurav Anand in 2008 that operates several restaurants in New York City, including a restaurant named Moti

Mahal Delux Restaurant in which Petitioner owns a 10% stake. Anand Deposition 8:9-10:7, 39:10-40:20; 14 TTABVUE 12-13, 42-43.

- Moti Mahal Delux Restaurant: A restaurant located in New York City co-owned by Petitioner and Tripti, Inc. serving Indian cuisine. The restaurant received favorable reviews from THE NEW YORK TIMES and WALL STREET JOURNAL in 2012. Anand Deposition 9:13-22; 14 TTABVUE 12.
- Tulsi Restaurant: A restaurant located in New York City serving Indian cuisine. The restaurant is owned in part by Chef Hemant Mathur. Mathur Deposition 5:22-6:2; TTABVUE 8-9. This is the restaurant named in the menu submitted as the specimen supporting Respondent's statement of use.

B. Individuals

- Gurav Anand, Petitioner's witness and a non-party to this proceeding: a restaurateur originally from India and residing in New York City and owner of Tripti, Inc., Petitioner's partner in Moti Mahal Delux restaurant in New York City. Anand Deposition 8:9-10:7, 39:10-40:20; 14 TTABVUE 12-13, 42-43.
- Hemant Mathur, Petitioner's witness and non-party to this proceeding: A professional chef for over thirty years and co-owner of Tulsi restaurant in New York City. Mathur Deposition 5:10-15; 10:9-11:13; 15 TTABVUE 8, 13.
- Monish Gujral, Respondent's witness: Mr. Gujral resides in India and is Director of Respondent. Gujral Deposition 3:19-4:1; 25 TTABVUE 4-5. He owns a portion of the company with other family members. *Id.* As Director, his responsibilities include identifying geographical locations for the expansion of Respondent's brands, overseeing discussions with prospective franchisees, negotiating franchise agreements and overseeing implementation, launching restaurants and developing menus. *Id.* at 4:22-5:4; 25 TTABVUE 5-6. Mr. Gujral is an "internationally acclaimed" food writer, television host and blogger. *Id.* at 8:3-5; 25 TTABVUE 9. His MOTI MAHAL COOK BOOK ON THE BUTTER CHICKEN TRAIN was awarded the best cook book in the "Easy Recipe" category by Gourmand, an international book fair in Paris in 2009 and his MOTI MAHAL COOK BOOK – KEBAB TRAIL won the best cook book in the world award in the "Foreign Cuisine" category in 2014 at the World Cook Book Fair in China. *Id.* at 5:5-17, 8:4-25; 25 TTABVUE 6, 9. Mr. Gujral's blog "Foodie Trail" (www.monishgujral.com) won the Gourmand Jury Award for the Best Food Blog in the world in 2015 in China. His books are available for sale in the United States via online retailers such as Amazon and brick-and-mortar bookstores such as Barnes and Noble. *Id.* at 5:18-24; 25 TTABVUE 6.

IV. Outstanding Motions

During the course of this proceeding, Respondent filed two motions which were deferred until final decision. *See* August 8, 2016 Board Order; 19 TTABVUE 1. We address these motions below.

A. Respondent's Motion to Strike Petitioner's July 1, 2016 Notice of Reliance

On July 13, 2016, Respondent filed a motion to strike Petitioner's second notice of reliance filed on July 1, 2016. The document submitted under the notice of reliance is a joint venture agreement purportedly executed between Petitioner and Tripti, Inc., a non-party to this proceeding. The cover sheet reads:

Relevance – document being offered to corroborate testimony of [Petitioner's witness] Gurav Anand that he had an agreement with Petitioner to, inter alia, act as the sales and operations representative of Petitioner outside of India and particularly in the United States. The document is only now relevant because at Petitioner's deposition, Registrant attempted to call into question Mr. Anand's relationship to Petitioner and the Joint Venture Agreement was discussed but never requested by Registrant. Accordingly it is being provided and relied on to clarify that Mr. Anand has the authority to, pursuant to the Joint Venture Agreement, represent Petitioner.

Respondent objects on the ground that the joint venture agreement does not fall within any of the categories of documents eligible for submission under notice of reliance. We agree. Certain types of evidence, such as official records and printed publications as described in Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), need not be introduced in connection with the testimony of a witness but may instead be made of record by filing the materials with the Board under cover of one or more notices of reliance during the testimony period of the offering party. Documents that do not fall under the purview of Trademark Rule 2.122(e) can only be introduced into evidence through the testimony of a

person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials. Petitioner's joint venture agreement does not qualify for introduction under notice of reliance. Petitioner had the opportunity during its rebuttal testimony period to make the agreement properly of record via witness testimony but neglected to do so.

In view thereof, Respondent's motion to strike is granted; the joint venture agreement submitted under Petitioner's second notice of reliance filed on July 1, 2016 is inadmissible and has been given no consideration.

B. Respondent's Motion to Amend Registration No. 4664064

After the close of Petitioner's first trial period, Respondent filed on July 13, 2016 the following motion to amend, as noted below, the identification of goods of its involved registration without Petitioner's consent.

~~Bar services; cocktail lounge services; restaurant services; bed and breakfast inn services; Bistro services; cafe services; cafeterias; carry out restaurants; catering services; consulting services in the field of culinary arts; consulting services in the field of hospitality; fast food restaurant services; snack bar services; Food preparation services featuring fresh, properly proportioned, healthy meals designed to fuel metabolism and burn fat and made to order for delivery or pick up; Hotel services; Motel services; preparation of food and beverages; Providing social meeting, banquet and social function facilities; restaurant carryout services; Restaurant reservation services; **Restaurant services featuring Indian cuisine**; Restaurant services, including sit-down service of food and take-out restaurant services; restaurant services, namely, providing of food and beverages for consumption on and off premises; restaurants featuring home delivery; self service restaurants; **serving of food and drink/beverages**; canteen services; take-out restaurant services; wine bars in International Class 43.~~

18 TTABVUE 2.

A registration that is the subject of a Board inter partes proceeding may not be amended except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. Trademark Act Section 7(e), 15 U.S.C. § 1057(e); Trademark Rule 2.133(a), 37 C.F.R. § 2.133(a). When a motion to amend an application or registration in substance is made without the consent of the other party as is the case here, it ordinarily should be made prior to trial, in order to give the other party fair notice. An unconsented motion to amend that is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a).⁷ *See, e.g., Personnel Data Sys., Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863, 1865 (TTAB 1991) (defendant's motion to restrict identification of goods in involved registration, filed with brief on case, denied).

In this particular case, Respondent failed to file its motion to amend prior to the commencement of trial. Petitioner makes no mention of Respondent's proposed amendment at any point in this proceeding, meaning that this issue was neither tried by express or implied consent. *See* Fed. R. Civ. P. 15(b). Respondent, however, in its main brief urges the Board to grant its motion to amend insofar as Petitioner has failed to raise

⁷ Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a) states "[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure." Inter partes proceedings before the Board are also governed by the Federal Rules of Evidence.

any objections. To grant the motion as conceded would run contrary to our practice noted above under Fed. R. Civ. P. 15(b). Accordingly, Respondent's motion is denied.

V. Claims Argued and Tried Before the Board

Respondent argues that Petitioner waived any asserted fraud claim by failing to argue fraud in its opening brief. It further argues that any additional claims argued by Petitioner in its main brief, namely lack of bona fide intent to use the mark in commerce, nonuse, and abandonment are unpleaded and untried by either express or implied consent. Petitioner, in its reply brief, counters that while its opening brief does not specifically use the word "fraud," it is clear that the facts show that Petitioner fraudulently obtained its registration and that the remaining claims argued in its brief were tried by implied consent.

Petitioner's opening brief is devoid of any discussion of fraud. If a party fails to reference a pleaded claim in its brief, the Board will deem the claim to have been waived. *See, e.g., Alcatraz Media*, 107 USPQ2d at 1753; *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (opposer's pleaded claims not argued in its brief deemed waived), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015). We have thoroughly reviewed Petitioner's opening brief and agree with Respondent that Petitioner failed to argue its pleaded fraud claim. We therefore deem Petitioner's fraud claim waived.

This brings us the question of whether any of Petitioner's unpleaded claims were tried by either express or implied consent. Fed. R. Civ. P. 15(b)(2) provides that when issues not raised by the pleadings are tried by express or implied consent of the parties, an amendment of the pleadings may be made to cause them to conform to the evidence. In

light of Respondent's unequivocal objections in its brief, it is clear there was no express consent. Respondent's Brief, p. 9 n.2; 52 TTABVUE 10 ("Respondent does not consent to conforming the pleading at this late time...").

Considering now whether any claims were tried by implied consent, "[i]mplied consent to the trial of an unpleaded issue can be found only where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue." TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 507.03(b)(2018). *See also Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-21 (TTAB 2008); *Boise Cascade Corp. v. Cascade Coach Co.*, 168 USPQ 795, 797 (TTAB 1970) ("Generally speaking, there is an implied consent to contest an issue if there is no objection to the introduction of evidence on the unpleaded issue, as long as the adverse party was fairly informed that the evidence went to the unpleaded issue."). "The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter." *Morgan Creek*, 91 USPQ2d at 1139. *See also* TBMP § 507.03(b).

The cover sheet of Petitioner's notice of reliance filed June 24, 2016 referring to the pages from Respondent's website <http://motimahalin> (Exhibits C-F) contains a relevancy statement only as to fraud, which as noted above has been waived. 13 TTABVUE 2-3. While none of the other admissible documents indicate their general relevance or

association with any particular claim,⁸ the discovery requests and responses made of record focus on Respondent's business and promotional efforts in the United States including activities essential to the running of a brick-and-mortar restaurant, such as the existence of any leases, telephone lines, tax returns, W-4 forms for employees, utility bills, reservation logs, garbage removal, and laundry services "up to three (3) years prior to the present." Petitioner's Interrogatories dated December 3, 2015 and Respondent's Responses thereto (Exhibits A and B) at 13 TTABVUE 5-31; Petitioner's Document Production Requests dated November 5, 2015 and Respondent's Responses thereto (Exhibits L and M) at 13 TTABVUE 92-103. Petitioner's witness, Chef Mathur, testified on various subjects identified in his pretrial disclosures including whether Respondent had any ownership or management stake in Tulsi restaurant; whether or not Mr. Gujral was present at Tulsi restaurant on or around November 11, 2014 solely for a cookbook signing and not to prepare, cook or serve any food; and whether or not Respondent ever used the mark "Moti Mahal" in commerce in connection with Mr. Gujral's appearance at Tulsi. Petitioner's Pretrial Disclosures, 11 TTABVUE 4 and Mathur Testimony Deposition, 15 TTABVUE 10-16. Respondent had the opportunity to cross-examine Chef Mathur on these topics.

In view thereof, we find that Respondent was fairly apprised that Petitioner's evidence was introduced for the purpose of proving the claims of lack of bona fide intent to use, nonuse, and abandonment and therefore these claims were tried by implied consent under

⁸ Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g) states 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."

Fed. R. Civ. P. 15(b)(2). *See, e.g., Productos Lacteos Tocumbo S.A. de C.V. v. Paletería La Michoacana Inc.*, 98 USPQ2d 1921, 1925-26 (TTAB 2011) (Board found petitioner's likelihood of confusion claim based on petitioner's common law use of the mark LA MICHOCACANA and the mark comprising an Indian girl design was tried by implied consent where petitioner's notices of reliance and testimony fairly apprised respondent that it was relying on these marks to show priority). We therefore deem the pleadings amended to conform to the evidence.

VI. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that “[a] petitioner is authorized by statute to seek cancellation of a mark where it has both a real interest in the proceeding as well as a reasonable basis for its belief of damage.” *Id.* at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

Petitioner introduced evidence of its pending application which has been provisionally refused registration based on a likelihood of confusion with the mark in Respondent's registration. Petitioner's Notice of Reliance Ex. N, 13 TTABVUE 119-122. This suffices to show that Petitioner has a real interest in this proceeding and, therefore, has standing. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“Thus, to have standing in this case, it would be sufficient that [plaintiff] prove that

it filed an application and that a rejection was made because of [defendant's] registration"); *see also ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) (evidence of record showing petitioner's pending application refused registration based on respondent's registration).

VII. Lack of Bona Fide Intent to Use the Mark in Commerce

We turn now to the substantive claims before us commencing with the claim that Respondent lacked a bona fide intent to use its mark at the time it filed its trademark application. The underlying application that ultimately matured into the involved registration was filed on September 19, 2011 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Trademark Act Section 1(b) states as follows:

A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

Petitioner has the burden of demonstrating by a preponderance of the evidence that Respondent lacked a bona fide intent to use the mark on the identified services at the time Respondent filed its application. We note at the outset that our inquiry is not into Respondent's subjective state of mind alone. Rather, evidence of circumstances bearing on intent

is "objective" in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant's testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future."

L'Oreal S.A. v. Marcon, 102 USPQ2d 1434, 1444 (TTAB 2012) (quoting 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 19:14 (4th ed. 2009)); *see also SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 USPQ2d 1300, 1305 (TTAB 2010); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1931 (TTAB 2009). Thus, as we have consistently held, our determination whether Respondent had a bona fide intention to use the mark in commerce is an objective determination, based on all the circumstances. *Boston Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008); *see also Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 86 USPQ2d 1527, 1537-38 (D.C. Cir. 2008) (“Here, Congress made clear that a ‘bona fide intent to use’ also involves an objective standard by specifying there must be ‘circumstances showing ... good faith.’”) (internal citation omitted).

Mr. Gujral testified that prior to the filing date of Respondent’s underlying application, Respondent had entered into a franchise agreement with a party in New Jersey:

Q.54. Why did you file a trademark application in the United States?

A. Because we wanted to expand the Moti Mahal brand in USA.

Q.55. At the time you filed your trademark application in the United States, did you intend to use the Moti Mahal trademark in the United States[?]

A. Yes, in fact back in 2010, I had entered into an agreement with [a] third party to open a Moti Mahal franchise in New Jersey. Unfortunately the deal fell through but as I had been expanding the Moti Mahal brand around the world and as the United States is such an important market I certainly planned to do business in USA and open Moti Mahal.

Gujral Deposition 12:17-13:7; 25 TTABVue 13-14. Mr. Gujral’s testimony is corroborated by documentary evidence of the franchise agreement executed on June 14, 2010, before

the September 19, 2011 filing date of the underlying application. *Id.* at 13:8-14:2; 25 TTABVUE 14-15 (testimony authenticating June 14, 2010 franchise agreement between Respondent and Haiban, Inc. based in Edison New Jersey) and Ex. 41 (confidential - June 14, 2010 franchise agreement between Respondent and Haiban, Inc.).

All of the foregoing constitutes objective evidence of Respondent's bona fide intent to use its applied-for mark in commerce in connection with restaurant and restaurant related services prior to the application filing date. Accordingly, Petitioner's claim that Respondent lacked a bona fide intent to use its mark at the time it filed its trademark application is dismissed.

VIII. Lack of Bona Fide Use of Respondent's Mark As of the Statement of Use Filing Date

Petitioner contends that Respondent failed to make bona fide use of its mark as of November 13, 2014, the filing date of its statement of use.⁹ A verified statement that "the mark is in use in commerce" is a minimum requirement that must be satisfied before the expiration of the statutory period for filing the statement of use. 15 U.S.C. § 1051(d)(1); Trademark Rule 2.88(c)(3), 37 C.F.R. § 2.88(c)(3). By logical extension, a registration issued from an underlying application not meeting this requirement is void ab initio. *Id.* *Cf. Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1289 (TTAB 2007) ("...an opposition will be sustained as to any of the identified goods as to which it is shown that no use had been made as of the application filing date."); *Labs. du Dr. N.G. Payot Etablissement v. Sw. Classics Collection Ltd.*, 3 USPQ2d 1600, 1605-06 (TTAB 1987)

⁹ The relevant time period for a claim of lack of bona fide use or nonuse is of course different than the time period for an abandonment claim which begins no earlier than the date of registration.

(Board sustained opposition on ground that the mark PEYOTE either in the word format or in the design format, had not been used on any goods “either in commerce or anywhere”). The term “use” in this context means “the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.” Section 45 of the Trademark Act, 15 U.S.C. § 1127. Under this provision, a mark is deemed to be used in commerce for services when:

[1] it is used or displayed in the sale or advertising of services and [2] the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Id. (emphasis and numbering added). See *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2044 (Fed. Cir. 2015) (quoting 15 U.S.C. § 1127). To elaborate further on the meaning of “use in commerce” of a service mark:

Although the definition of use of a service mark in Section 45 of the Trademark Act is less concrete than the definition of use of a trademark, it is nonetheless clear that, at the very least, there must be an open and notorious public offering of the services to those for whom the services are intended. (internal citations omitted). In addition, mere publicity about services to be rendered in the future does not lay a foundation for an application. The statute requires not only the display of the mark in the sale or advertising of services but also the rendition of those services in order to constitute use of the service mark in commerce.

Intermed Commc’ns, Inc. v. Chaney, 197 USPQ 501, 507-08 (TTAB 1977). “[P]reparations to use a mark in commerce are insufficient to constitute use in commerce. Rather, the mark must be actually used in conjunction with the services described in the application for the mark.” *Aycock*, 90 USPQ2d at 1305. “Without question, advertising or publicizing

a service that the applicant intends to perform in the future will not support registration”; the advertising must instead “relate to an **existing service** which has already been offered to the public.” *Id.* at 1358 (internal quotation marks and citations omitted) (emphasis added). In other words, “rendering services requires actual provision of services.” *Couture v. Playdom, Inc.*, 113 USPQ2d at 2044 (citing 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:103 (4th ed. Supp. 2013)).

Respondent cannot rely on the mere existence of its federal registration and allegations of use therein nor the specimen submitted in connection with ex parte examination to defend against Petitioner’s claim of non-use. If it could do so, a contested cancellation based on lack of bona fide use or non-use could never be successful, despite the fact that such claims are clearly contemplated by statute. *See* Section 45 of the Trademark Act, 15 U.S.C. § 1127. *Cf. Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1395 (Fed. Cir. 1990) (“[T]he Lanham Act was not intended to provide a warehouse for unused marks.”).

Respondent’s principal Mr. Gujral testified that he and Chef Mathur, the chef at Tulsi restaurant in New York City, agreed to operate a “pop-up” restaurant serving food from Respondent’s menu and under Respondent’s MOTI MAHAL mark for a temporary time period:

Q.142. Please describe circumstances around use. In other words, how did you come to use the mark?

A. On one of my trips to New York, I met with Chef Hemant Mathur who is known to me for a long time. We decided to open up a pop up Moti Mahal restaurant. I worked with him over time to design the menu, promote the restaurant and launch Moti Mahal. Following that I met with additional people and

prospects and received several enquiries from people in setting up a Moti Mahal in the United States.

Q.143. Why did you open a pop up restaurant?

A. I [thought] it would be a good way to enter the New York restaurant market as I continued to explore Moti Mahal licensing opportunities in the USA.

Gujral Deposition 24:20-25:6; 25 TTABVUE 25-26. Through his testimony, Mr. Gujral authenticated and introduced into the record a series of emails dated October 4 to “the end of November, 2014” in which he and Chef Mathur discussed various aspects of Respondent’s pop up restaurant at Tulsi as well as the menu to be used displaying Respondent’s MOTI MAHAL mark:

Q.152. What did you discuss in these emails?

A. We discussed the launch of my [pop up] Moti Mahal restaurant on November 14, 2014, the display to [be] place in the window with Moti Mahal signage. We discussed my travel plans and the menu to be served. I also sent him a menu and the recipes of the dishes in the menu that would be served. Besides this I sent him a window card/ advertisement.

Gujral Deposition 26:10-17; 25 TTABVUE 27 and Exs. 54 and 55; 26 TTABVUE 131-157. As documentary evidence, Mr. Gujral authenticated and introduced into the record a written agreement between Respondent and Chef Mathur governing the operation of Respondent’s MOTI MAHAL “pop up” restaurant. Gujral Deposition 25:7-21; 25 TTABVUE 26 and Ex. 53 at 26 TTABVUE 128-130. According to the terms of the agreement, Respondent granted Chef Mathur a non-exclusive non-assignable license to use the mark “Moti Mahal” and the customized menu containing Moti Mahal dishes at Tulsi for a limited time period from November 12-24, 2014. 26 TTABVUE 129. In consideration for the temporary license, Chef Mathur agreed to pay Respondent 5% of the

total revenue earned from the sale of dishes from the Moti Mahal menu. *Id.* In addition, both parties agreed that all costs and expenses for running the “pop up” restaurant would be borne by Chef Mathur. *Id.* Chef Mathur acknowledged Respondent as the owner of multiple trademarks and service marks, including Moti Mahal and Moti Mahal Deluxe, to identify food and restaurant services and agreed to use Respondent’s intellectual property holdings for this limited purpose. *Id.*

Mr. Gujral further testified that he personally observed sales from Respondent’s menu displaying the MOTI MAHAL mark.

Q.172. When was your Moti Mahal [pop up] restaurant open in New York?

A. November 12, 2014 to 24th November, 2014.

Q.173. Were you in New York at that time?

A. Yes.

Q.174. Were you present at the restaurant?

A. Yes I was present on several occasion[s].

Q.175. Did you observe diners ordering from the Moti Mahal menu?

A. Yes. I did.

Q.176. Did you sell Moti Mahal books at the restaurant in the United States?

A. Yes.

Q.177. Did you generate revenue from the food sales?

A. Yes.

Gujral Deposition 28:19-29:6; 25 TTABVUE 29-30.

Petitioner, relying on the testimony of Chef Mathur,¹⁰ counters that Mr. Gujral never asked Chef Mathur to open a “pop-up” restaurant at Chef Tulsi; rather Mr. Gujral was on the premises of Tulsi solely for a cookbook launch. Mathur Deposition 7:1-20; 41 TTABVUE 10. Much of Chef Mathur’s testimony is riddled with inconsistencies. This, in the face of Respondent’s testimony to the contrary which is supported by written documentary evidence leads us to conclude that Respondent’s witness Mr. Gujral is the more credible of the two.

We therefore find that that Respondent’s rendering of the “pop-up” restaurant services took place just prior to, and concurrent with, the filing of Respondent’s statement of use. Respondent’s “pop-up” restaurant, albeit temporary in nature, constituted an “an open and notorious public offering” of Respondent’s Indian cuisine restaurant services. *See Intermed*, 197 USPQ at 507-08. This, coupled with the display of Respondent’s MOTI MAHAL mark on the specially designed menu suffices to show “use in commerce” within the meaning of the statute. Accordingly, Petitioner has failed to carry its burden of proof by a preponderance of the evidence that Respondent failed to make bona fide use of its registered mark in connection with restaurant and restaurant related services as of the statement of use filing date and as such this claim is also dismissed.

IX. Abandonment

Lastly, we consider Petitioner’s abandonment claim. The Trademark Act provides for the cancellation of a registration if the registered mark has been abandoned. *See* Section

¹⁰ According to the testimony deposition transcript of Chef Mathur, much of his testimony is unintelligible. 15 TTABVUE *in passim*.

14 of the Trademark Act, 15 U.S.C. § 1064. However, “[b]ecause registrations are presumed valid under the law, the party seeking their cancellation bears the burden of proving a prima facie case of abandonment by a preponderance of the evidence.” *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1532 (TTAB 2018); *see also On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2016). Section 1127 of the Trademark Act, 15 U.S.C. § 1127 provides, in pertinent part, that a mark is abandoned

[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

As explained by the U.S. Court of Appeals for the Federal Circuit:

A showing of a prima facie case creates a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use. The burden then shifts to the trademark owner to produce evidence that he either used the mark during the statutory period or intended to resume use. The burden of persuasion, however, always remains with the [challenger] to prove abandonment by a preponderance of the evidence.

Crash Dummy Movie LLC v. Mattel Inc., 601 F.3d 1387, 94 USPQ2d 1315, 1316 (Fed. Cir. 2010) (internal citations omitted). “Use in commerce” for services is defined as:

The bona fide use of a mark in the ordinary course of trade.... [A] mark shall be deemed to be in use in commerce —... on services when [1] it is used or displayed in the sale or advertising of services **and** [2] the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person

rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127 (emphasis and numbering added). Because abandonment is a question of fact, any inference of abandonment must be based on proven fact. *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1310 (Fed. Cir. 1989) (“The protection due the registrant is provided by requiring that the inference [of abandonment] have an adequate foundation in proven fact. Whenever an inference is based on pure speculation and ‘there is no basis ... to infer nonuse,’ a prima facie case of abandonment must fail.”) (quoting *P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 196 USPQ 801, 804-05 (CCPA 1978)). A defendant cannot rely on the mere existence of its federal registration or subsequent renewals to defend against a plaintiff’s claim of abandonment. If it could do so, a contested cancellation based on abandonment could never be successful, despite the fact that such claims are clearly contemplated by statute. *See Trademark Act § 14.*

Respondent’s MOTI MAHAL mark registered on December 30, 2014. As noted above, it is uncontroverted that Respondent has not used its registered mark MOTI MAHAL in U.S. commerce since the cessation of the temporary “pop-up” restaurant at Tulsi in New York City in November 2014. Petitioner has therefore established by a preponderance of the evidence abandonment through nonuse.

We next focus on whether Respondent intended to resume use. The record shows that subsequent to November 2014, Mr. Gujral engaged in discussions with potential franchisees for the purpose of securing franchise agreements to open MOTI MAHAL

branded restaurants in this country. *See* Gujral Deposition 21:23-23:25, 30:20-27; 25 TTABVUE 22-24, 31 and Exs. 51 and 52 (discussions, email exchanges and proposed license agreement dated March 5, 2015 with Mahesh Khemlani to open a Moti Mahal branded restaurant in New Jersey); *id.* at 30:20-32:6; 25 TTABVUE 31-33, Ex. 60 (discussions and email exchanges dated December 2-24, 2014 with Murali Kolapolli to open a Moti Mahal restaurant franchise in Virginia); *id.* at 32:15-33:16; 25 TTABVUE 33-34, Ex. 61 (discussions and email exchanges dated February 6-16, 2015 with Sanjai Bagai to open a Moti Mahal restaurant franchise in California). When asked why he thought his efforts were unsuccessful, Mr. Gujral testified that he believed that Petitioner's opening of its own MOTI MAHAL branded restaurant and U.S. trademark registration hindered Respondent's efforts to secure a franchise agreement in the United States. *Id.* at 33:17-22; 25 TTABVUE 33.

Mr. Gujral also testified that his sister, Anuranda Bhalla, Respondent's Business Development Manager, relocated along with her husband to Boston in 2016 with the intent of opening a MOTI MAHAL restaurant by the end of 2016. *Id.* at 33:23-34:6; 25 TTABVUE 34-35. According to his testimony, his sister and brother-in-law were "working with a real estate scout and [had] targeted two potential locations." *Id.* In addition, Respondent was "working to secure appropriate visas so we can send a chef from India to [the] United States to help open the restaurant and train the staff there." *Id.* Based on this evidence, we find that Respondent actively pursued opportunities to use the MOTI MAHAL brand in the United States following the close of the "pop-up" restaurant in November 2014, thereby evincing an intent to resume use. Accordingly, Petitioner's abandonment claim is dismissed.

Decision: The petition to cancel is denied.