

**This Opinion is Not a
Precedent of the TTAB**

Oral Hearing: March 21, 2017

Mailed: August 7, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Paradise Biryani, Inc.

v.

Paradise Hospitality Group, LLC
—

Cancellation No. 92055264

Cancellation No. 92055487
—

Paradise Hospitality Group, LLC

v.

*Biryani Pointe Paradise, LLC and
Paradise Biryani Express, Inc.*
—

Cancellation No. 92058843
—

Paradise Hospitality Group, LLC

v.

*Paradise Biryani, Inc. and
Paradise Biryani Express, Inc.*
—

Cancellation No. 92058851

(consolidated)
—

Christopher DeBacker of The Law Office of Mark Brown LLC,
for Paradise Biryani, Inc., Biryani Pointe Paradise, LLC, and Paradise Biryani
Express, Inc.

Clifford D. Hyra, of Symbus Law Group LLC,
for Paradise Hospitality Group, LLC.

Before Mermelstein, Greenbaum and Goodman,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

I. Procedural Background

These consolidated cases have a complicated procedural history involving two registrations owned by Paradise Hospitality Group, LLC (“PHG”), and an application and two registrations pleaded and purportedly owned by Paradise Biryani, Inc. (“PBI”), all for PARADISE-inclusive marks for, inter alia, restaurant services.

On March 1, 2012, PBI filed petitions to cancel PHG’s registrations for the marks



and PARADISE INDIAN CUISINE (in standard characters)

for “restaurant, bar and catering services” in International Class 43.¹ The proceedings were assigned Cancellation Nos. 92055264 and 92055487, respectively. As grounds for cancellation in each proceeding, PBI alleged priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a registration

¹ Reg. Nos. 3900817 and 3900816, respectively. In each instance, the underlying application was filed on August 20, 2010 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming February 8, 2010 as the date of first use and first use of the mark in commerce, the registration issued on January 4, 2011, a Section 8 Affidavit has been accepted, and “INDIAN CUISINE” has been disclaimed. The composite word and design mark in Reg. No. 3900817 does not claim color as a feature of the mark, and describes the mark as follows: “The mark consists of a chef extending out of a circle carrying a plate of food next to the words ‘PARADISE INDIAN CUISINE.’” The Board consolidated the two proceedings soon after PHG filed its answers. 8 TTABVUE.

for the mark PARADISE BIRYANI POINTE (in standard characters) for “café and restaurant services; restaurant; restaurant and bar services, including restaurant carryout services; restaurant and café services; restaurant and catering services; restaurant services” in International Class 43,² and applications for the marks PARADISE INDIAN CUISINE (in standard characters) for services including restaurant, bar, and catering services,³ and PARADISE BIRYANI POINTE and Design, displayed below, for “café and restaurant services” in International Class 43.



² Reg. No. 4047868 (“’868 Registration”) was filed (as application Serial No. 85124078) on September 7, 2010 by Narsing Raj Gowlikar (“Raj”), an individual, under Section 1(a) of the Trademark Act, claiming October 26, 2007 as the date of first use and first use of the mark in commerce. “BIRYANI” has been disclaimed. The ‘868 Registration issued on November 1, 2011, listing Raj as the owner of the mark. On September 21, 2011, Raj assigned the mark to Paradise Biryani Express, Inc. dba Paradise Biryani Pointe (“Express”), and he filed the assignment with the Assignment Services Branch on November 27, 2011, i.e., 26 days after the registration issued. Although the assignment documents identify Express as the assignee, the assignment cover sheet erroneously identified PBI, rather than Express, as the assignee. Consequently, this assignment, which was recorded at reel 4866, frame 0171, identified PBI as the assignee, and thus, the registered owner of the ‘868 Registration. On May 8, 2014, Raj filed a “corrective assignment” of the ‘868 Registration to Express. The “corrective assignment” was recorded at reel 5276, frame 0181. However, PBI remains the named plaintiff in Cancellation Nos. 92055264 and 92055487. As explained below, the ‘868 Registration is the subject of a counterclaim by PHG.

In this opinion, we generally refer to the pertinent individuals by their given names, following the nomenclature of the individuals in their depositions.

³ Raj also filed Application Serial No. 85124045 (“’045 Application”) on September 7, 2010, claiming September 2, 2009 as the date of first use and first use of the mark in commerce. “INDIAN CUISINE” is disclaimed. The assignment and “corrective” assignment documents and recordation information detailed in footnote 2 also cover the ‘045 Application.

⁴ Application Serial No. 85373450 was filed on July 18, 2011 by Biryani Pointe Paradise, LLC (“BPP”), claiming October 23, 2007 as the date of first use and first use of the mark in commerce. “BIRYANI” is disclaimed. The application issued as Reg. No. 4208745 (“’745 Registration”) on September 18, 2012, and was assigned to Express on April 16, 2014. This

In its answers, PHG denied the salient allegations of the petitions to cancel, and set forth the affirmative defenses of laches, unclean hands, estoppel, waiver, acquiescence, and abandonment due to naked licensing.

After the Board resolved discovery motions, PBI filed, on October 21, 2013, a summary judgment motion on its pleaded Section 2(d) ground.⁵ The Board denied PBI's motion on January 29, 2014, finding that "genuine disputes of material fact remain, at a minimum, as to whether the named plaintiff is the proper petitioner in these proceedings; whether the record owner of the pleaded marks is the proper owner thereof; priority;" and certain elements of the likelihood of confusion claim.⁶

During the pendency of this proceeding, in an apparent attempt to correct the name of the "record owner of the pleaded marks," on March 7, 2014, PBI filed in the '868 Registration and BPP filed in the '745 Registration Section 7 Requests to change the named owner of each registration to Express. The "Explanation[s] of Filing" for the Section 7 Requests read as follows:

The full legal name of the corporate entity which holds Reg. No. 4,047,868 is Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe. In everyday parlance among those familiar with the company it is referred to as "Paradise Biryani, Inc." Narsing Raj Gowlikar, the sole

assignment was recorded on April 21, 2014 at reel 5264, frame 0897. The registration claims "the color(s) orange, brown, blue, red and white ... as a feature of the mark," and describes the mark as follows: "The mark consists of a design of a chef with a plate of food in brown above the term 'PARADISE' in blue both superimposed against an orange rhombus shape, and the wording 'BIRYANI POINTE' in white superimposed against a red swath that intersects the lower point of the rhombus shape." As explained below, the '745 Registration also is the subject of a counterclaim by PHG.

⁵ 26 TTABVUE.

⁶ 31 TTABVUE 3-4.

owner of Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe,^[7] was unaware that this distinction might be important when he retained counsel to protect the PARADISE BIRYANI POINTE Mark he has worked so hard to establish. As a result, all parties involved have simply been referring to the shorthand “Paradise Biryani, Inc.” when the proper Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe should have been referenced.^[8] Pursuant to TMEP 1201.02(c) this is a correctable error.^[9] Furthermore, this error was made by the registration owner in good faith, therefore we respectfully request that the Registrant’s name be corrected accordingly.^[10]

The full legal name of the corporate entity which holds Reg. No. 4,208,745 should have been listed as Paradise Biryani Express, Inc. d/b/a/ Paradise Biryani Pointe. Narsing Raj Gowlikar, the sole owner of Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe and Biryani Pointe Paradise, LLC,^[11] was unaware that this distinction might be important when he retained counsel to protect the PARADISE BIRYANI POINTE + Design Mark he has worked so hard to establish. As a result, all parties involved have simply been referring to ‘Paradise’ as an overall term for both companies when the proper Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe should have been referenced in the application itself. Pursuant to TMEP 1201.02(c) this is a correctable error.^[12] As this was an inadvertent error by the registration owner, made in good faith, we respectfully request the registration certificate be corrected accordingly.^[13]

⁷ As discussed below, the record does not support a finding that Raj was ever the sole owner of Express.

⁸ Although the Section 7 Request in the ‘868 Registration does not include the clause “in the application itself,” the references to “when he retained counsel to protect the [mark] he has worked so hard to establish,” and TMEP § 1201.02(c) (“Correcting Errors in How the Applicant is Identified” in the application) in the “Explanation of Filing” make it clear that this omission was an oversight.

⁹ We would be remiss if we did not point out that these types of errors are among those listed as “non-correctable” in TMEP § 1201.02(c).

¹⁰ Section 7 Request in the ‘868 Registration.

¹¹ We reiterate that the record does not support a finding that Raj was ever the sole owner of Express.

¹² As previously noted, this is considered a “non-correctable” error. *See* TMEP § 1201.02(c).

¹³ Section 7 Request in the ‘745 Registration.

We discuss below the import of these averments.

On March 13, 2014, PHG filed petitions to cancel the registration pleaded by PBI for the standard character mark PARADISE BIRYANI POINTE, and the registration



for the mark PARADISE BIRYANI POINTE and Design, , pleaded by PBI when it was an application. The latter registration issued on September 18, 2012, during the pendency of these proceedings.¹⁴ The proceedings were assigned Cancellation Nos. 92058843 and 92058851, respectively, and we will address them momentarily.

Turning back to the Section 7 Requests, on April 7, 2014, the USPTO Post Registration Division denied them because, in each instance,

[t]he registration is currently the subject of an inter partes proceeding before the [Board] and can only be amended (1) with the consent of the other party or parties and with the approval of the Board, or (2) upon motion granted by the Board. 37 C.F.R. § 2.133; *see* TBMP § 514.01-514.03. ... The owner of the registration may file a motion to correct the registration with the Board, pursuant to Trademark Rule 2.133. ...

On April 11, 2014, PBI filed a motion in Cancellation No. 92055264 (which had been consolidated with Cancellation No. 92055487) “to amend the named registered owner” of the pleaded ‘868 Registration and “the named owner” of the pleaded ‘045 Application from Raj to Express “to cure an inadvertent error in the manner in which

¹⁴ As mentioned above, as part of its Section 2(d) claim, PBI pleaded ownership of the underlying application, which was filed by BPP.

the ownership name was set forth on the assignment cover sheet.”¹⁵ On May 7, 2014, the Board denied the motion without prejudice, stating that “the Board has no jurisdiction over the registration, application, or assignment cover sheet within the context of these consolidated proceedings,” and therefore the motion was “procedurally improper in this proceeding.”¹⁶ However, even though the Board, in denying PBI’s summary judgment motion, had informed the parties that a genuine dispute remained as to “whether the named plaintiff is the proper petitioner in these proceedings,”¹⁷ PBI never filed a motion to correct the name of the plaintiff in Cancellation Nos. 92055264 and 92055487 (the original consolidated cases), or to join Express as a party plaintiff. PBI therefore remains the sole named plaintiff in Cancellation Nos. 92055264 and 92055487.

Circling back to PHG’s new petitions for cancellation, the Board treated them as effective motions to amend the answers in Cancellation Nos. 92055264 and 92055487 to assert compulsory counterclaims.¹⁸ The Board granted the effective motions in part, and denied them in part, ultimately allowing PHG to file amended answers in Cancellation Nos. 92055264 and 92055487 to assert, as counterclaims, the following

¹⁵ 36 TTABVUE, 40 TTABVUE. PHG filed a response to this motion. 38 TTABVUE.

¹⁶ 41 TTABVUE. However, as previously noted, on April 21, 2014, BPP filed in the ‘745 Registration an assignment of the mark to Express. And on May 8, 2014, Raj filed in the ‘868 Registration and ‘045 Application a “corrective assignment” assigning the marks to Express. Express, therefore, is currently listed as the owner of all of the marks that PBI pleaded in Cancellation Nos. 92055264 and 92055487.

¹⁷ January 29, 2014 Board Order, 31 TTABVUE 3.

¹⁸ The Board joined Express as a party defendant in each of the new cancellations filed by PHG because the “corrective assignments” of the subject registrations from Raj to Express occurred after PHG filed the new cancellations. 42 TTABVUE 1, nn. 1 and 2.

limited grounds: (1) abandonment based on non-use and intent not to resume use; (2) the underlying applications are void ab initio because they were not filed by the rightful owners of the registered marks; and (3) there was no bona fide use of the marks when the applications were filed.¹⁹ The Board also added Cancellation Nos. 92058843 and 92058851 to the previously consolidated cases, maintaining Cancellation No. 92055264 as the parent of the four proceedings.

PHG filed amended counterclaims on October 24, 2014,²⁰ asserting, with respect to PBI's pleaded '868 and '745 Registrations, the three grounds permitted by the Board, and priority and hypothetical likelihood of confusion only as to the '745 Registration.²¹ In addition, in contravention of the Board Order, PHG reasserted fraud as a ground for cancellation of the marks.

On November 21, 2014, Express, which is listed as the owner by assignment of the '868 and '745 Registrations and as one of two named defendants in each of PHG's petitions for cancellation (which we are treating as counterclaims), filed amended answers in Cancellation No. 92055264, referencing the amended counterclaims filed on October 24, 2014.²² In each instance, Express denied the salient allegations of the amended counterclaims. Express also asserted eight putative and actual affirmative defenses, including, as the "Eighth Affirmative Defense," a "request[] that the TTAB

¹⁹ The Board denied as legally insufficient PHG's counterclaim on the ground of fraud, denied as untimely PHG's counterclaim on the ground of abandonment based on naked licensing, and struck from the counterclaims the paragraphs in which those allegations were pleaded.

²⁰ 43 TTABVUE.

²¹ 43 TTABVUE 19-20, ¶¶ 30-34.

²² 44 TTABVUE. The ESTTA cover sheet lists PBI as the filing party.

strike” the fraud claim. Because PHG reasserted fraud as a ground for cancellation of the marks in contravention of the Board Order, in each instance we STRIKE paragraphs 9-23 of PHG’s amended counterclaims, which comprise the fraud claim in its entirety.²³

PBI and PHG each filed a brief addressing the Section 2(d) claim asserted in Cancellation Nos. 92055487 and 92055264, and the counterclaims asserted in Cancellation Nos. 92058843 and 92058851. The Board held an oral hearing on March 21, 2017.

II. Evidentiary Objections

PHG raised hearsay objections to several printed news articles and blog posts that PBI submitted both under Notice of Reliance and as exhibits to Raj’s testimony, and Raj’s testimony concerning these materials. We need not address the objections as we have not relied on this evidence in deciding the merits of this proceeding.

III. Record

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of PHG’s involved Registration Nos. 3900817 and 3900816 (which are the subjects of Cancellation Nos. 92055264 and 92055487,

²³ Because none of the other affirmative defenses were pursued in PBI’s brief, they are deemed waived and will be given no further consideration. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

respectively), and the files of the '868 and '745 Registrations, which PBI pleaded and which are the subjects of Cancellation Nos. 92058843 and 92058851.²⁴

Both PBI and PHG submitted the trial testimony and associated exhibits of Mangesh Guraraj²⁵ ("Mangesh"), a former franchisee of a PARADISE BIRYANI POINTE restaurant in Raleigh, NC; Satish Maram²⁶ ("Satish"), a franchisee of PARADISE BIRYANI POINTE restaurants in Virginia; and Gunapriya Babu Yalamurijana²⁷ ("Guna"), a former partner of Raj in Express and several LLCs.

In addition, PBI submitted the trial testimony of Raj,²⁸ and PHG submitted the testimony with exhibits of Sudakar Yadhla²⁹ ("Sudakar"), Respondent's principal; Jatavallabha Vishnubhatla³⁰ ("Jata"), former partner of Satish; and Rajbir Singh³¹ ("Rajbir"), former (and original) owner of JVR Foods d/b/a Paradise Indian Cuisine, Paradise Indian Cuisine, LLC, and a restaurant in New Jersey named Paradise Indian Cuisine, and a former partner in another LLC with Raj, Guna, and their wives.

²⁴ As we explained above, we are treating Cancellation Nos. 92058843 and 92058851 as compulsory counterclaims.

²⁵ 76 TTABVUE and 86 TTABVUE 3.

²⁶ 77 TTABVUE and 85 TTABVUE 220.

²⁷ 78 TTABVUE and 85 TTABVUE 4.

²⁸ 79 TTABVUE and 83 TTABVUE, which appear to be nearly identical. Among other things, the exhibits attached to the testimony include a printout of the '045 application for the mark PARADISE INDIAN CUISINE. 96 TTABVUE 25 (Exhibit 4).

²⁹ 86 TTABVUE 148.

³⁰ 85 TTABVUE 182. No exhibits were submitted with Jata's testimony.

³¹ 86 TTABVUE 48.

PBI submitted a Notice of Reliance on PHG's responses to discovery.³² In addition, PHG submitted Notices of Reliance on corporate records from the State of New Jersey for Express, various LLCs, and other corporate entities involved in, or presumably related to, entities or individuals involved in these consolidated cancellation proceedings,³³ and various other printed materials that we do not list separately here because we do not rely on them in making our decision.

IV. PHG's Counterclaims

We begin with PHG's counterclaims to cancel the '868 and '745 Registrations pleaded by PBI.

A. PHG's Standing

As defendant in the '264 and '487 cancellations, PHG automatically has standing to pursue its counterclaims to cancel PBI's pleaded '868 and '745 registrations. *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478 (TTAB 2007) (applicant subject to opposition has inherent standing to counterclaim for cancellation); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492 (TTAB 2005) (“[a]pplicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registrations.” (citing *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999))).

³² 61 TTABVUE.

³³ 68 TTABVUE.

B. Ownership

Pursuant to Section 1(a)(1) of the Trademark Act, 15 U.S.C. 1051(a)(1), only “[t]he owner of a trademark used in commerce may request registration of its trademark...” Accordingly, only the owner of the mark may file an application. *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976) (“One must be the owner of a mark before it can be registered.”); *In re Deister Concentrator Co.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961) (“Under section 1, only ‘The owner of a trademark’ can apply for registration.”). Therefore, “[a]n application filed by one who is not the owner of the mark sought to be registered is a void application.” *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (citing *In re Techsonic Indus., Inc.*, 216 USPQ 619 (TTAB 1982)). See also *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (affirming Board’s holding that an application was void *ab initio* because the applicant was not the owner of the mark on the filing date); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void *ab initio*.”); Trademark Rule 2.71(d), 37 CFR 2.71§ (d) (“An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”).

1. Analysis

The record concerning this basic inquiry is not clear, due to a tangled web of corporate entities purportedly associated with PBI, including Express, BPP, and others. As Raj's former partner Guna stated when questioned about the Paradise Indian Cuisine restaurant in New Jersey and one of the other LLCs: "I was trying to recollect the name of the LLC because with Raj Gowlikar and me together we opened like so many LLC's, about seven or eight LLC's. Every new entity we create we open a new LLC. So, I myself confused so many times and you know I am exactly not sure what LLC we bought JVR Foods on."³⁴ Nonetheless, based on a preponderance of the evidence, we find that Raj was not the owner of the standard character mark PARADISE BIRYANI POINTE on September 7, 2010, when he filed, in his own name, the application underlying the '868 Registration, and that BPP was not the owner of the PARADISE BIRYANI POINTE and Design mark on July 18, 2011, when it filed the application underlying the '745 Registration.

Although the record is replete with testimony from many witnesses, and a fair amount of documentary evidence, all of which we have considered, we discuss only that testimony and evidence we believe to be relevant to our findings.

2. Raj, Express, and PARADISE BIRYANI POINTE Franchises

Raj and his wife Shailaja incorporated Express in New Jersey on January 29, 2007 for the "Business Purposes" of "Food."³⁵ Raj testified that he "founded this company

³⁴ 78 TTABVUE 8 at 15.

³⁵ 68 TTABVUE 12-14.

in 2007, January. Operational in October 2007. And we are currently operating restaurants and fast food service chains all over the US and trying to expand.”³⁶ The PARADISE BIRYANI POINTE restaurants operate as franchises run by various LLCs, virtually all of which do business as PARADISE BIRYANI POINTE.³⁷

In October 2007, Raj opened the first PARADISE BIRYANI POINTE restaurant in New Jersey, which Express “ran.”³⁸ Raj confirmed that he began using the PARADISE BIRYANI POINTE and Design mark at the “[s]ame time, from 2007.”³⁹ He also testified that he “designed the menu, logo, and all the things. I personally designed, me and my wife are part of it, and I completely design the menu, recipes, spice, everything.”⁴⁰

On October 18, 2008, Raj and Shailaja entered into a Shareholders Agreement with Guna, which added Guna as an owner of 41% of the stock of Express.⁴¹ This agreement remained in effect until June 3, 2011, when Guna sold his ownership interest in Express to Raj and Shailaja as part of a global “Settlement, Mutual Release and Sale Agreement.”⁴²

³⁶ 83 TTABVUE 5-6 at 5-6.

³⁷ 83 TTABVUE 6 at 9, 83 TTABVUE 33-35 at 114-124.

³⁸ 83 TTABVUE 5-6 at 5-6, 83 TTABVUE 33 at 116.

³⁹ 83 TTABVUE 9 at 19, 83 TTABVUE 30 at 103, and 83 TTABVUE 37 at 131.

⁴⁰ 83 TTABVUE 6 at 7.

⁴¹ 85 TTABVUE 149, Exhibit 9 to Guna’s Test., labeled “Exhibit A Shareholders Agreement.”

⁴² 85 TTABVUE 120, Exhibit 6 to Guna’s Test. (Agreement), and Exhibit A thereto (85 TTABVUE 129, chart listing all businesses owned and/or managed by Guna and his percentage interests, compared to the other owners or investors). PHG also submitted the Agreement as Exhibit 12 to Guna’s Test. (83 TTABVUE 172, labeled “Exhibit B”), and the chart as part of Exhibit 10 to Guna’s Test. (83 TTABVUE 160).

Raj testified about several franchise agreements concerning PARADISE BIRYANI POINTE restaurants, including an October 14, 2009, agreement between Express and Paradise Biryani Pointe, Corp, a Virginia Corporation, for a restaurant in Herndon, Virginia,⁴³ a May 2010 agreement between Express and Hyderabad Foods, LLC, for one of the New Jersey locations, and a 2011 agreement between Express and Paradise Biryani Pointe, a Massachusetts Company, for a restaurant that opened in Boston in 2012.⁴⁴

According to Raj, every franchise agreement identifies Express as the owner of PARADISE BIRYANI POINTE:

Q. In all these agreements, do you specify that Paradise Biryani Express, Inc., owns the name?

A. Yes.

Q. That's correct? And so these other entities are all licensing the name from Paradise Biryani Express, Inc.?

A. Right.

Q. Okay. And it's been that way for as long – every restaurant since it's opened, it's been licensing the right to use the name from Paradise Biryani Express, Inc.?

A. That's correct.⁴⁵

⁴³ 83 TTABVUE 12 at 32; 96 TTABVUE 40, Exhibit 10 to Raj's Test., labeled "Exhibit D."

⁴⁴ 83 TTABVUE 35 at 123-124.

⁴⁵ *Id.*

Of course, in this case, the trade name is also the trademark, and Raj appears to use the terms interchangeably. For example, Raj testified about use of the term “trade name” in the franchise agreement⁴⁶ as follows:

Q. Thank you very much. The trade name, what is the trade name?

A. Trade name is Paradise Biryani Point.

Q. And would Paradise Indian Cuisine also be a trade name?

A. Paradise Indian Cuisine, like I filed in 2007 – sorry, 2010, September 7th. And once it was not – I thought, like, you know, when trademark allotted this to the other party, I thought like I won’t be able to use that, so that’s the reason I stopped. I respect TTAB and trademark office, so that’s the reason I stopped using that. But majority, like, you know, Indian Cuisine is mentioned if you check any document, articles or news media. Paradise Biryani Indian Cuisine, that’s what we mention it as. Indian cuisine is a common name. And Paradise is a name that’s attached to it. Paradise is a key name. Paradise is the trade name. Paradise is all about. It’s all about – not Indian cuisine, sir. It’s started with Paradise and the spice attached to it. That’s what we arguing on. So we have to – that’s a trade name. Paradise is the trade, nothing else. Indian cuisine, okay, generic word, that keep aside. We are not worried about Indian cuisine. Anybody else can use it. Everybody knows that. Paradise is the name, sir.⁴⁷

In addition, as mentioned above, in the “Explanation of Filing” in the Section 7 Request to correct the name of the owner of the ‘868 Registration, PBI averred as follows:

The full legal name of the corporate entity which holds Reg. No. 4,047,868 is Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe. In everyday parlance among those familiar with the company it is referred to as “Paradise Biryani, Inc.” Narsing Raj Gowlikar, the sole owner of Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe, was unaware that this distinction might be important when he retained counsel to protect the PARADISE BIRYANI POINTE Mark he has

⁴⁶ 96 TTABVUE 42, Exhibit 10 to Raj’s Test.

⁴⁷ 83 TTABVUE 13-14 at 37-38.

worked so hard to establish. As a result, all parties involved have simply been referring to the shorthand “Paradise Biryani, Inc.” when the proper Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe should have been referenced. Pursuant to TMEP 1201.02(c) this is a correctable error. Furthermore, this error was made by the registration owner in good faith, therefore we respectfully request that the Registrant’s name be corrected accordingly.

Similarly, in the “Explanation of Filing” in the Section 7 Request to correct the name of the owner of the ‘745 Registration, PBI averred as follows:

The full legal name of the corporate entity which holds Reg. No. 4,208,745 should have been listed as Paradise Biryani Express, Inc. d/b/a/ Paradise Biryani Pointe. Narsing Raj Gowlikar, the sole owner of Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe and Biryani Pointe Paradise, LLC, was unaware that this distinction might be important when he retained counsel to protect the PARADISE BIRYANI POINTE + Design Mark he has worked so hard to establish. As a result, all parties involved have simply been referring to ‘Paradise’ as an overall term for both companies when the proper Paradise Biryani Express, Inc. d/b/a Paradise Biryani Pointe should have been referenced in the application itself. Pursuant to TMEP 1201.02(c) this is a correctable error. As this was an inadvertent error by the registration owner, made in good faith, we respectfully request the registration certificate be corrected accordingly.

Based on this evidence and testimony, we find that Express was the owner of the mark PARADISE BIRYANI POINTE on September 7, 2010, when Raj filed, in his own name, the application for the standard character mark, and on July 18, 2011,



when BPP filed the application for the mark  (PARADISE BIRYANI POINTE and Design). We further find that Raj was never the sole owner of Express; he always co-owned Express with his wife, and Guna was a 41% owner from October

18, 2008 to June 3, 2011. Registration Nos. 4047868 and 4208745 therefore are void ab initio.

V. Cancellation Nos. 92055264 and 92055487

We now turn to the original petitions for cancellation, filed by PBI, for likelihood of confusion under Trademark Act Section 2(d) based solely on PBI's purported ownership of the two now-cancelled registrations, and a currently suspended application for the mark PARADISE INDIAN CUISINE which Raj filed, in his own name, on September 7, 2010. We need not decide whether Raj owned the mark PARADISE INDIAN CUISINE on September 7, 2010, because there is no evidentiary support upon which we can base a finding that PBI exists as a corporate entity, let alone one that can assert the pleaded application. Indeed, when questioned about the assignments of the now-cancelled registrations, Raj testified as follows:

Q. Now, is there a Paradise Biryani, Inc.?

A. Paradise Biryani Express, Inc., that's a parent company doing business as Paradise Biryani Pointe. There was a clerical error, I guess. Express was missing. But Paradise Biryani Express, Inc., is the complete name when I formed the company in 2007, January 29th. And again, I did a DBA immediately after one week also. So we do as business as –

Q. I believe what you just said – could you just repeat what you just said about a clerical error?

A. Yeah. When we assigned or when we filed, there was Express missing, but the company name Paradise Biryani Express, Inc., That's the parent which I formed.⁴⁸

⁴⁸ 83 TTABVue 9 at 20-21.

In view of this testimony, we find that PBI is a nonexistent entity that does not have standing to maintain the cancellation proceedings against PHG.

Decision: The counterclaims to cancel Registration Nos. 4047868 and 8208745 are GRANTED. In addition, the petitions to cancel Registration Nos. 3900817 and 3900816 are DISMISSED.⁴⁹

⁴⁹ Any affirmative defenses asserted by PHG and raised in its brief therefore are moot. The others are deemed to have been waived. *See Alcatraz Media*, 107 USPQ2d at 1753 n.6 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014).