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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91276101
Party	Defendant Arrehman Arraheem Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 90/327,658
Published in the Official Gazette of January 11, 2022
Mark: BUNDU KHAN KABAB HOUSE BEST BBQ JUST FOR YOU

BUNDOO KHAN USA, LLC	§	
	§	
<i>Opposer,</i>	§	
	§	
v.	§	Opposition No. 91276101
	§	
ARREHMAN ARRAHEEM CORP.	§	
	§	
<i>Applicant.</i>	§	

**ARREHMAN ARRAHEEM CORPORATION’S
MOTION TO DISMISS**

Applicant Arrehman Arraheem Corporation (“Applicant”) files this Motion to Dismiss Bundoo Khan USA, LLC’s (“Opposer”) Notice of Opposition. Opposer’s likelihood of confusion basis for opposition must be dismissed because Applicant failed to allege prior use in the United States. Opposer’s false suggestion of a connection basis for opposition must also be dismissed because the alleged false association is with a third party and not Opposer.

I. Legal Standard

To survive a motion to dismiss, Petitioner must allege facts which, if true, would establish its entitlement to the relief sought. *Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, v. Juan E. Rodriguez*, 99 U.S.P.Q.2d 1873, 1874 (T.T.A.B. 2011). In other words, the Petition “must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Doyle v. Al Johnson's Swed. Rest. & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements” do not suffice. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

II. Opposer's Failure to Allege Prior Use in the United States is Fatal

Opposer's likelihood of confusion basis for opposition must be dismissed because Opposer has not and cannot establish priority. "[T]he express statutory language of Section 2(d) requires prior use of a mark in the United States by the [Opposer]." *Jung v. Magic Snow, LLC* 124 U.S.P.Q.2d 1041, *2 (T.T.A.B. 2017) (citing 15 U.S.C. § 1052(d)). Stated differently, an opposer seeking to block registration based on likelihood of confusion must plead and prove that it is the senior user of the mark in the United States. Opposer does not (and cannot) make this required allegation.

There is no dispute that Applicant has used its BUNDU KHAN Mark in commerce since as early as 2005,¹ which predates Opposer's first use in the United States by more than fifteen (15) years. *Compare* U.S. Reg. No. 4,011,592; *with* US. Reg. No. 6,623,887 (listing 2021 as the date of first use of Opposer's alleged mark in commerce).

While Applicant appears to claim rights through its alleged Pakistani licensor dating back to 1948, such allegations have no relevance to its likelihood of confusion claim because the TTAB does not recognize the "well known mark doctrine." Opposer contends that, although it did not use the Mark in the United States until 2021, "the BUNDOO KHAN trademark was first used in Karachi, Pakistan in connection with restaurant services in 1948." 13 TTABVUE ¶ 8. Opposer further contends that, "[o]ver the years, the BUNDOO KHAN name and brand rose to prominence and became well known as the best Pakistani barbeque available not only in Pakistan, but also worldwide, including the United States." *Id.* But Opposer's allegations of use in Pakistan and

¹ While this proceeding concerns the mark BUNDU KHAN KABAB HOUSE BEST BBQ JUST FOR YOU, Opposer's complaints are directed only to the use of the phrase BUNDU KHAN. In any event, Applicant's date of first use for the BUNDU KHAN KABAB HOUSE BEST BBQ JUST FOR YOU mark in 2020 still predates Opposer's alleged date of first use in 2021.

allegations that the Mark became well known in the United States do not satisfy the requirement that Opposer allege it was a prior user in the United States. *Jung*, 124 U.S.P.Q.2d 1041, *2-3.

The facts in *Jung* were similar to the facts here. Specifically, the opposer in *Jung* argued that its mark had become “famous to the . . . Korean-American in the United States . . . prior to the filing of Applicant’s Application.” *Jung*, 124 U.S.P.Q.2d 1041 at *2. The Board in *Jung* dismissed with prejudice the opposer’s 2(d) claim for failure to state a claim and held that “the ‘well known mark’ doctrine provides no basis for a Section 2(d) ground for opposition because it does not establish *use of the mark in the United States* as required by the statutory language of that section.” *Id.* (emphasis added). The Board continued that “[r]ecognition in the United States is not the same as use in the United States.” *Id.* (citing *Green Spot (Thailand) Ltd. v. Vitasoy Int’l Holdings Ltd.*, 86 USPQ2d 1283, 1284-85 (TTAB 2008) (the fact that a mark is well-known in other countries “cannot establish priority in the United States”)); *see also ITC Ltd. v. Punchgini*, 482 F.3d 135, 82 USPQ2d 1414 (2d Cir. 2007) (well-known mark doctrine rejected as a basis for asserting priority); *Melon Optics Ltd. v. Love Your Melon, Inc.*, 2021 WL 725612, * 10 (TTAB 2021).

Just as in *Jung*, Petitioner’s “pleading of priority under Section 2(d) is insufficient” because the Board “**does not recognize the well known mark doctrine as an independent basis for establishing priority in its *inter partes* proceedings.**” *Jung*, 124 U.S.P.Q.2d 1041 at *3.

Based on its arguments in the co-pending cancellation proceedings, Opposer will likely argue that the well known mark doctrine can be used to establish priority when foreign use is “coupled” with actual use of the mark in the United States. *See* Cancellation No. 920804826, 6 TTABVUE p.7 (citing *Bayer Consumer Care AG v. Belmora, LLC*, 90 USPQ2d at 1587, 1591 n.4 (TTAB 2009)). But this cherry-picked statement from *Bayer* does not mean that an opposer can

rely on a prior foreign use where, like here, the use in the United States began almost 20 years after applicant's use. *See Bayer*, 90 USPQ2d at 1591-92. That makes no logical sense. In fact, the Board in *Bayer* granted the registrant's motion to dismiss petitioner's claim under the well-known mark doctrine despite petitioner alleging use in the United States. *Id.* Thus, the *Bayer* case supports Applicant's position that Opposer cannot rely on a third party's foreign use coupled with a use in the United States almost 2 decades after Applicant's use. *Id.*

It is undisputed that Opposer first used its BUNDOO KHAN mark in the United States in 2021, almost 20 years after Applicant's first use of its BUNDU KHAN mark in 2005. *See* U.S. Reg. No. 4,011,592. Applicant is therefore "the senior user as that term is defined under U.S. trademark law." *Person's Co. Ltd. v. Christman*, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990) ("Although Person's did adopt the mark in Japan prior to Christman's use in United States commerce, the use in Japan cannot be relied upon to acquire U.S. trademark rights."). In other words, Opposer's alleged use of its mark in the United States in 2021 does not magically entitle Opposer to the date the BUNDOO KHAN mark was first used in Pakistan. Applicant "was the first to use the mark in United States commerce and the first to obtain a federal registration thereon. [Opposer] has no basis upon which to claim priority and is the junior user under these facts." *Id.*

Finally, even if Opposer could rely on the well-known mark doctrine, it would still fail to establish priority because a licensee cannot rely on an alleged licensor's use to prove priority. *See Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1036 (TTAB 2017) ("We find that Moreno, a mere licensee, cannot rely on her licensor's use to prove priority"). Thus, because Opposer cannot establish priority over Applicant, Opposer's likelihood of confusion basis for refusal must be dismissed.

III. Opposer Fails to State A Claim for False Association Because the Alleged False Association is not with Opposer but with a Third Party

Opposer alleges that Applicant's Mark should be refused for false suggestion of a connection with the original Bundoo Khan restaurant under Section 2(a). But, because Opposer alleges the Mark creates a false association with the original Bundoo Khan restaurant, and Opposer is *not* the original Bundoo Khan restaurant, Opposer's claim of false association fails as a matter of law.

The TTAB has held that because the false suggestion of a connection ground is "essentially a statutory implementation of the rights of privacy and publicity . . . the ground is personal to the person or institution named in the mark, and **may only be asserted by that person or institution.**" *Mankind Research Found., Inc. v. Essiac Prods. Servs.*, 2000 TTAB Lexis 934, *16-17 (TTAB 2000); *Kobe, Inc. v. Hi-Tech Pharma., Inc.*, 2019 WL 6799797, *6 (TTAB 2019) (holding that to prevail on a Section 2(a) claim, opposer must establish that "Applicant's mark is the same or a close approximation of Opposer's name or identity"); *Gaziantepi Habes Seyidoglu Baklavalari v. Nema Food Dist. Inc.*, 2012 WL 3675113, *10 (TTAB 2021) ("To prevail on a false suggestion claim, Petitioner must establish that "the marks is the same as, or a close approximation of, Petitioner's previously used name or identity"); *Arrow Trading Grp. V. Swiss Army Brands, Ltd.*, 1996 TTAB Lexis 463, fn. 1 (TTAB 1996) ("an essential element of a false suggestion claim under Section 2(a) is that the mark in question must falsely suggest a connection with the plaintiff.") (emphasis in original); *Heroes, Inv. V. Boomer Esiason Hero's Foundation, Inc.*, 1997 WL 335807, *3 (TTAB 1997) ("to raise a claim that a mark falsely suggests a connection with an institution under Section 2(a), the challenger must be the institution itself"); *Golden State Warriors, LLC v. Morell*, 2019 WL 5188454, *4 (TTAB 2019). Thus, pursuant to TTAB precedent, dismissal is necessary.

In its co-pending cancellation proceeding, Opposer argued that recent Federal Circuit case law supports its position that it has the ability to bring a Section 2(a) claim. *See* Cancellation No. 920804826, 6 TTABVUE p. 6. But the *Piano Factory* case does not support Opposer’s position at all. *Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 1376 (Fed. Cir. 2021). In fact, *Piano Factory* supports Applicant’s position that a Section 2(a) claim must be brought by the person whose persona or identity is implicated by the mark at issue. In *Piano Factory*, the Federal Circuit affirmed the TTAB’s “correct” finding that petitioner properly brought a claim under Section 2(a) because the registered mark is “effectively **the same as the appellee’s name and identity.**” *Id.* at 1369, 1376. That decision is consistent with the TTAB precedent that “an essential element of a false suggestion claim under Section 2(a) is that the mark in question must falsely suggest a connection with **plaintiff.**” *Arrow Trading*, 1996 TTAB Lexis 463 at fn. 1 (emphasis in original).

Opposer argues that, because the *Piano* court stated that “[a] party asserting a false association bar to registration under section 2(a) need not have proprietary rights to a name,” a Section 2(a) claim need not be brought by the person whose persona or identity is implicated by the mark at issue. *See* Cancellation No. 920804826, 6 TTABVUE p. 6. But this cherry-picked quote does not mean what Opposer claims it does. That statement only means that petitioner did not have to have valid trademark rights to bring a claim under section 2(a). This is an important distinction. The *Jimmy Buffett* case illustrates the distinction. *Buffett v. Chi-Chi’s, Inc.*, 226 U.S.P.Q. 428 (TTAB 1985). In that case, while Buffet had no “proprietary rights” (a registered trademark) in the MARGARITAVILLE mark, he did have a right to control the use of his identity in the use of that term under Section 2(a). *Id.* at *2-3.

The Federal Circuit did not overrule TTAB precedent that a Section 2(a) claim **must** allege that the mark points “uniquely and unmistakably to **petitioner**.” *Bridgewater Candle*, 2002 WL 122608, at *2 (TTAB 2002); *see also Australian Therapeutic Supplies Pty. Ltd.*, 2021 WL 5983267, at *20 (TTAB 2021); *Bertoldi*, 2022 WL 873726, at *12 (TTAB 2022). Thus, dismissal is appropriate because it is undisputed that Opposer’s identity and persona is not the same as Mr. Bundoo Khan or the allegedly “original” Bundoo Khan restaurant in Pakistan.

Finally, in a thinly veiled attempt to avoid 12(b)(6), Opposer also alleges that Applicant’s claimed Mark falsely suggests a connection with Opposer. But how could Applicant’s use, which began in 2005, falsely suggest a connection with an entity that did not even exist until 2021? It could not. It is a matter of public record (that neither party disputes) that Applicant first used its BUNDU KHAN mark in the United States in 2005, almost **20 years prior** to Opposer’s first use of its alleged BUNDOO KHAN mark. *Compare See* U.S. Reg. No. 4,011,592; *with* U.S. Reg. No. 6,623,887. Thus, because a mark used since 2005 could not possibly suggest a connection with an entity formed in 2021, Opposer has failed to state a plausible claim for false suggestion of a connection with itself. *See Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009) (“Determining whether a complaint states a plausible claim for relief will, as the Court of Appeals observed, be a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.”).

IV. Conclusion

Opposer’s likelihood of confusion basis for refusal must be dismissed because Opposer failed to even allege prior use in the United States. And Opposer’s reliance on the well-known mark doctrine fails as a matter of law because that doctrine is not recognized by the TTAB. Finally,

Opposer's Section 2(a) grounds for refusal should also be dismissed because it lacks a viable allegation that the false connection is with itself.

Respectfully submitted,

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CERTIFICATE OF SERVICE

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