

UNITED STATES PATENT AND TRADEMARK OFFICE  
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WINTER

March 6, 2023

Opposition No. 91276101  
Cancellation No. 92080482

*Bundoo Khan USA, LLC*

*v.*

*Arrehman Arraheem Corporation*

**BY THE TRADEMARK TRIAL AND APPEAL BOARD:**

These proceedings now come up for consideration of the fully briefed motions filed by Arrehman Arraheem Corporation (“Arrehman”) in Opposition No. 91276101 on November 30, 2022, and on October 14, 2022 in Cancellation No. 92080482, to dismiss each proceeding based on the alleged failure of Bundoo Khan USA, LLC (“Bundoo Khan USA”) to state a claim upon which relief can be granted. *See* 14 TTABVUE<sup>1</sup> (Opp. No. 91276101) and 4 TTABVUE (Canc. No. 92080482).

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<sup>1</sup> Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board’s electronic docketing system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020) (citing *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014)). To allow the Board and readers to easily locate materials in the record, the parties should cite to facts or evidence in the proceeding record by referencing the TTABVUE entry and downloadable PDF page number, e.g., “1 TTABVUE 2,” and not attach previously-filed evidence to their briefs. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 801.01 and 801.03 (2022). For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE

The Board has considered the parties' briefs submitted therewith, but addresses the record only to the extent necessary to support the Board's analysis and findings, and does not repeat or address all of the parties' arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings,<sup>2</sup> and the arguments submitted in connection with the subject motions.

### **I. Proceedings Consolidated**

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1105 (TTAB 2016) (consolidation is discretionary with the Board and may be ordered *sua sponte*); *M.C.I. Foods Inc. v.*

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docket entry number where such material or testimony is located should be included in any citation.

<sup>2</sup> Counsel for Opposer/Petitioner is reminded that text in all submissions to the Board must be double-spaced. *See* Trademark Rule 2.126(a)(1). The Board expects Opposer/Petitioner's future submissions to conform to this rule.

Opposer/Petitioner is also reminded that, subject to certain exceptions inapplicable here, exhibits attached to pleadings are not in evidence. *See* Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c) (exhibits to pleadings are not in evidence and instead "must be identified and introduced in evidence as an exhibit during the period for the taking of testimony").

Opposition No. 91276101 and Cancellation No. 92080482

*Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008) (proceeding involved identical parties, identical registrations and related issues); *S. Indus. Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); *see also* 9A Wright & Miller, Fed. Prac. & Proc. Civ. § 2383 (3d ed. April 2022 update).

It has come to the Board's attention that Opposition No. 91276101 and Cancellation No. 92080482 involve the same parties and common questions of law and fact. In view thereof, although issue has not yet been joined in these proceedings, it is appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a), applicable to these proceedings under Trademark Rule 2.116(a). *See* TBMP § 511.

Accordingly, because the parties to these proceedings are identical and the issues involved are similar or related, Opposition No. 91276101 and Cancellation No. 92080482 are hereby consolidated and, **except for any amended pleading filed by Bundoo Khan USA and the Answer to be filed in each proceeding**, each case may be presented on the same record and briefs. *See, e.g., Hilson Research Inc. v. Soc. for Human Res. Mgmt.*, 27 USPQ2d 1423 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file for these now consolidated proceedings will be maintained in Opposition No. **91276101** as the "parent" case. From this point on, except as noted above, only a single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but caption all consolidated proceeding numbers, listing and identifying the parent case first. Inasmuch as these

proceedings are being consolidated prior to joinder of the issues in each proceeding, should these proceedings survive the pending or any future motions to dismiss, Arrehman must file an Answer in each respective proceeding. The Answer must be filed through ESTTA, the Board's Electronic System for Trademark Trials and Appeals. *See* Trademark Rules 2.106(b)(1) and 2.114(b)(1).

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.<sup>3</sup>

## **II. Arrehman's Motions to Dismiss<sup>4</sup>**

### **A. Legal Standard**

A motion to dismiss under Rule 12(b)(6) is a test of the sufficiency of the complaint. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1016 (TTAB 2018); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014).

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<sup>3</sup> The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

<sup>4</sup> Because the Notice of Opposition includes one or more claims alleged in the Petition for Cancellation and the motions to dismiss, therefore, address some of the same issues, the Board addresses both motions to dismiss in the same order, except as indicated. Further, the page numbers identified with “\_\_ TTABVUE \_\_” relate to the pleading and proceeding which are the subject of the particular section of the order.

To state a claim upon which relief can be granted, and thus survive a motion to dismiss under Fed. R. Civ. P. 12(b)(6), the plaintiff (here, Bundoo Khan USA) need only allege facts which, if proved, would establish that it has: 1) an entitlement to a statutory cause of action under Trademark Act Section 13 and 14; and 2) a valid statutory ground for either opposing registration of the applied-for mark or cancelling the involved registration. *See Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982).

Further, a complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the plaintiff must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Id.* (citing *Twombly*, 550 U.S. at 555). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. *See Twombly*, 550 U.S. at 556-57. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010); *see also* TBMP § 309.03(a)(2).

For purposes of determining a motion to dismiss, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 USPQ2d at 1041; *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Doyle*, 101 USPQ2d at 1782. Furthermore, "[u]nder the simplified notice pleading of the Federal Rules of Civil Procedure, the allegations of a complaint should be construed liberally so as to do substantial justice." *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Moreover, the purpose of a motion to dismiss is not to address the merits of the case. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (A motion to dismiss is a test solely of the legal sufficiency of the plaintiff's pleadings.); *see also* TBMP §§ 503.01 and 503.02.

## **B. Petition for Cancellation**

### **(1) False Suggestion of a Connection under Trademark Act Section 2(a)**

Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), bars registration of a mark that falsely suggests a connection with institutions or persons, living or dead. In order to state a sufficient claim of false suggestion of a connection under that section, a plaintiff must allege the following:

- (1) The defendant's mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- (2) The defendant's mark would be recognized as such, in that it points uniquely and unmistakably to the person or institution named or identified;

(3) The person or institution named or identified in the mark is not connected with the goods sold or services performed by the defendant under the mark at issue; and

(4) The fame or reputation of the named or identified person or institution is of such a nature that when the defendant's mark is used in connection with its goods or services, a connection with the person or institution named or identified would be presumed.<sup>5</sup>

*See Univ. of Notre Dame du Lac v. J.C. Gourmet Food, Imports Co., Inc.*, 703 F.2d 1371, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1031 (TTAB 2015); *Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013); *Petróleos Mexicanos v. Intermix*, 97 USPQ2d at 1405; *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

Additionally, the plaintiff must allege either plaintiff's prior use of the defendant's mark, or the equivalent thereof as a designation of its identity or "persona," or an association of the same with the plaintiff prior in time to the defendant's use. *See, e.g., In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990) ("the phrase 'falsely suggest a connection with' in Section 2(a) necessarily requires by implication that the person or institution with whom a connection is suggested must be the prior user") (internal citations omitted); *see also Ala. Bd. of Trs. v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 410-11 (TTAB 1986) (at the time the involved registration issued to respondent, the term "BAMA" uniquely identified the petitioner so that

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<sup>5</sup> The fame or reputation of the plaintiff must be determined as of the time respondent's registration issued. *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1416 (TTAB 2008).

when respondent's mark is used on particular goods, a connection with the plaintiff is presumed).

Further, the designation at issue must uniquely identify the plaintiff in the United States. *See Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1416 (although petitioner, the celebrity model "Twiggy," abandoned use in the United States of her personal name mark and was unable to prevail on likelihood of confusion or dilution claims, she had sufficient fame in the United States when respondent's mark was registered for clothing that she prevailed on claim of false suggestion of a connection with her persona as purchasers would presume an association with her).

Notably, the plaintiff is not required to plead or ultimately prove that it used the designation at issue as a trademark or service mark itself. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1633 (TTAB 2015) ("The fact that Kate Middleton, the Duchess of Cambridge, has never used PRINCESS KATE as her name or identity does not obviate the false suggestion of a connection refusal. ... All that is required is that the mark sought to be registered clearly identifies a specific person (*i.e.*, Kate Middleton)."); *Bd. of Trs. of the Univ. of Ala. v. BAMA-Werke Curt Baumann*, 231 USPQ at 410-11 ("Section 2(a) was intended to protect the name of an individual or institution, which may not be a technical trademark or trade name assertible under Section 2(d)"; "BAMA" uniquely pointed to the identity of the University of Alabama even though the school had not adopted it as a trademark and had only sporadically referred to itself as BAMA, in large part due to the public's association of the term with the school).



**(a) First Element of the Section 2(a) Claim**

As discussed, a properly pleaded claim of false suggestion of a connection must clearly allege that the defendant's mark is the same as, or a close approximation of, the name or identity previously used by another person or institution.

Accepting all of Bundoo Khan USA's well-pleaded allegations to be true, and construing the Petition for Cancellation in the light most favorable to it, Bundoo Khan USA alleges, in part, that it "is the exclusive licensee and franchisee of the original BUNDOO KHAN restaurant, based in Karachi, Pakistan[ and] [b]ased on its license and franchise agreement, Bundoo Khan USA is entitled and has the exclusive right to use and enforce the BUNDOO KHAN trademark in the United States." *See* Pet'n, ¶ 2; *see also* ¶¶ 1 and 7, 1 TTABVue 3-4 (below).

1. Bundoo Khan USA is the owner of Registration No. 6,623,887 for the mark MAK AL HAAJ BUNDOO KHAN covering "restaurant services, including sit-down service of food and take-out restaurant services," issued on January 18, 2022.

2. Bundoo Khan USA is the exclusive licensee and franchisee of the original BUNDOO KHAN restaurant, based in Karachi, Pakistan. Based on its license and franchise agreement, Bundoo Khan USA is entitled and has the exclusive right to use and enforce the BUNDOO KHAN trademark in the United States.

7. On or around February 13, 2021, Plaintiff entered into a "Master Franchise Agreement" with the original owners of the BUNDOO KHAN restaurant in Karachi, Pakistan. This Agreement gives Plaintiff the exclusive right to use the BUNDOO KHAN trademark in the United States in connection with restaurant services and also provides Plaintiff with the right to sub-license or further franchise the BUNDOO KHAN mark in the United States. These rights were granted exclusively to Plaintiff by the original BUNDOO KHAN owners in Karachi, Pakistan.

In the subject motion to dismiss, Respondent argues that Bundoo Khan USA's claim under Trademark Act Section 2(a) fails under *Nike, Inc. v. Palm Beach Crossfit*

*Inc.* because Bundoo Khan USA is not Bundoo Khan, the individual. Essentially, Respondent argues that Bundoo Khan USA cannot plead that Respondent's mark is the same as, or a close approximation of, the name or identity previously used by Petitioner Bundoo Khan USA insofar as Bundoo Khan USA alleges that the involved mark creates a false association with Bundoo Khan (or the original restaurant), who is not Bundoo Khan USA. 4 TTABVue 4. In response, Bundoo Khan USA asserts that under *Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 1377 (Fed. Cir. 2021), Bundoo Khan USA has sufficiently pleaded that Respondent's mark is the same as or a close approximation of the persona of Bundoo Khan and his family and of Bundoo Khan USA.

The factual allegations in the Petition for Cancellation differ from the cases cited by both parties and, therefore, those cases may be distinguished from this matter. With respect to *Nike*, Nike failed to assert that "the public would recognize Applicant's marks as pointing uniquely to Opposer (or to Michael Jordan), or that Applicant's Handstand marks are a close approximation of Opposer's (or Michael Jordan's) identity or 'persona,' an element necessary to a false suggestion of a connection claim." *Nike*, 116 USPQ2d at 1031-32. Further, Michael Jordan was a living person who was not a plaintiff in that case. *Id.* Rather, Nike pleaded that the public had come to associate the JUMPMAN DESIGN with the goods and services of Nike. *Id.* Thus, while Nike alleged that the JUMPMAN DESIGN mark functioned as a trademark for its goods, it did not sufficiently allege that the applicant's mark would point uniquely to Nike as required under Trademark Act Section 2(a).

Regarding *Piano Factory*, that case addressed on appeal, in relevant part, whether the plaintiff had standing to bring the cancellation proceeding, *see Piano Factory*, 11 F.4th at 1376, and whether the Board properly exercised jurisdiction in the case because other potential parties were not joined as plaintiffs. *See id.* The Court held that because plaintiff Schiedmayer Celesta was the sole corporate successor to the German Schiedmayer companies, and because Ms. Schiedmayer was the sole owner of Schiedmayer Celesta, and there were no Schiedmayer companies or individuals that appeared to have interests that conflict with the interests of Schiedmayer Celesta, it was proper for the Board to go forward with the cancellation proceeding without requiring the joinder of any other entities. *See* 11 F.4th at 1376.

Respondent's reliance on *Nike* is misplaced. Unlike *Nike*, wherein a rendering or design of living person, Michael Jordan, was involved and Mr. Jordan was not a plaintiff, in the instant case, Bundoo Khan USA alleges that Bundoo Khan is deceased.<sup>6</sup> In view thereof, for purposes of pleading, any surviving right to protect Bundoo Khan's persona under Trademark Act Section 2(a) would necessarily fall to Bundoo Khan's successors-in-interest and, in this case, to its alleged exclusive licensee in the United States. "An exclusive licensee may be the plaintiff in an opposition or cancellation proceeding before the Board. There is no requirement in that case that the licensor also be joined as a party plaintiff." *Avia Grp. Int'l Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992); *cf. Informix Software, Inc. v. Oracle*

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<sup>6</sup> BUNDOO KHAN is a deceased individual that has no relation to Registrant. Registrant is not a relative of BUNDOO KHAN and has no other affiliation or connection to BUNDOO KHAN or his relatives. Pet'n ¶ 10, 1 TTABVUE 4.

*Corp.*, 927 F.Supp. 1283, 1286 (N.D. Cal. 1996) (an exclusive licensee stands in the shoes of the trademark owner, and can sue for infringement on behalf of the owner). In view of the foregoing, the Board finds *Nike* does not prevent Bundoo Khan USA, as the exclusive licensee of the descendants of Bundoo Khan, from asserting a claim under Trademark Act Section 2(a).

Accordingly, the foregoing allegations are sufficient to support, if proven, Bundoo Khan USA's position as plaintiff in this proceeding and to set forth the bases for Bundoo Khan USA's entitlement to a statutory cause of action. *See Petroleos Mexicanos v. Intermix*, 97 USPQ2d at 1405 ("With respect to the Section 2(a) ground for cancellation, petitioner is not required to allege proprietary rights in its name for standing purposes.") (citing *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385 (TTAB 1991)); *Chicago Bears Football Club Inc. v. 12<sup>th</sup> Man/Tennessee LLC*, 83 USPQ2d 1073, 1075 (TTAB 2007) ("Because of opposers' proof of ownership or licensed use of the registered marks for BEARS and CHICAGO BEARS, we find that opposers each have established their standing to oppose."); *see also Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1118 n.8 (TTAB 2009) (evidence of a licensee's use of a mark sufficient to establish standing); *J.L. Prescott Co. v. Blue Cross Labs. (Inc.)*, 216 USPQ 1127, 1128 (TTAB 1982) (exclusive licensee has standing).

Furthermore, once entitlement to a statutory cause of action is sufficiently alleged (and established) for one claim, it is established for all claims. *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011); *Enbridge, Inc. v. Excelerate*

*Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (citing *Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983)).

Notwithstanding the foregoing, the Board finds that Bundoo Khan USA's allegations do not sufficiently allege that Respondent's mark is the same as, or a close approximation of, the name or identity **previously used** by Bundoo Khan (emphasis added):

4. Over the years, the BUNDOO KHAN name and brand rose to prominence and became well-known as the best Pakistani barbeque available. After Mr. Khan's death in 1987, his children carried on the legacy of his restaurant and food by operating shops in Karachi, Pakistan then expanding to Faisalabad, Pakistan and Dubai, UAE. The use of the BUNDOO KHAN mark by Mr. Khan and his family **long pre-dated any use by Registrant of its BUNDOO KHAN KEBAB HOUSE mark.**

5. Given the long-existing use of the BUNDOO KHAN mark, first by Mr. Khan himself and later by his family, the BUNDOO KHAN mark and brand is **known by a substantial percentage of consumers in the United States**, particularly those of Pakistani descent or lineage and those in geographic areas of the United States with large Pakistani communities – such as in the Los Angeles, California and Houston, Texas metropolitan areas.

8. As a result of the recognition of the BUNDOO KHAN mark as used by the original owners and now as a result of Bundoo Khan USA's use in the United States, **the BUNDOO KHAN mark has long become well known to consumers in the United States**, has become widely associated with Bundoo Khan USA and its Licensor, and points uniquely and unmistakably to Bundoo Khan USA and Bundoo Khan USA's Licensor.

18. Given the fame and goodwill associated with the BUNDOO KHAN mark, Registrant's use of a virtually identical mark would unquestionably be recognized by consumers as pointing to the original Bundoo Khan. This is all the more true given the fact that the services being offered by Registrant are virtually identical to the services offered by the original Bundoo Khan and his restaurants and the efforts by Registrant to foster such a connection. ...

Even though Bundoo Khan USA is not required to plead that it used BUNDOO KHAN as a service mark in the United States prior to Respondent, *see In re Nieves &*

*Nieves LLC*, 113 USPQ2d at 1633, Bundoo Khan USA has failed to clearly allege that Bundoo Khan USA's designation BUNDOO KHAN uniquely pointed to the persona of Mr. Khan **in the United States, prior to** Respondent's use of its registered mark (or constructive date of first use). *See Hornby*, 87 USPQ2d at 1416 (“[W]e [have not] considered her activities in countries outside the United States; there is no evidence in the record that information about such activities reached or had an impact on U.S. consumers;” petitioner prevailed on her claim of false suggestion of a connection with her persona, due to continuing fame and reputation of her persona, “Twiggy,” within the United States).

Accordingly, Bundoo Khan USA's pleading of the first element of its Trademark Act Section 2(a) claim is insufficient.<sup>7</sup>

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<sup>7</sup> The Board hastens to point out that, in paragraph 16 of the Petition, Petitioner alleges that “[t]he BUNDU KHAN KEBAB HOUSE mark is identical to Petitioner's BUNDOO KHAN mark.” 1 TTABVUE 5. Alleging that the parties' “marks” are identical is not the same as alleging that Respondent's mark is the same as or a close approximation of **the identity** of Petitioner's licensor. Rather, the allegation in paragraph 16 relates to a claim of likelihood of confusion under Trademark Act Section 2(d) and is not viewed as part of Petitioner's Trademark Act Section 2(a) claim. Similarly, Petitioner's allegation that “the primary significance of the BUNDOO KHAN mark is to identify the source of the goods being offered under the mark,” *see* Pet'n ¶ 6, 1 TTABVUE 4, relates to Petitioner's use of the designation as a service mark, not as the designation for the previously used persona or identity of Petitioner. *See Buffett v. Chi-Chi's, Inc.*, 226 USPQ at 429 (prior trademark use not required for false suggestion claim). So that the adverse party and the Board have adequate notice of the pleaded claims, the better practice is to delineate allegations under claim headings and not to conflate allegations. *See* TBMP § 309.03(a)(2). In any event, cancellation of the involved registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), is time barred, therefore, allegations related to likelihood of confusion directed to the involved registration will not be considered. *See* Trademark Act Section 14(3), 15 U.S.C. § 1064(3) (after the five year anniversary of the issuance of a registration, the grounds by which that registration may be cancelled are limited).

**(b) Second Element of Section 2(a) Claim**

Bundoo Khan USA must also allege that **Respondent's mark** would be recognized as the name or identity previously used by Bundoo Khan USA's Licensor, in that it points uniquely and unmistakably to Bundoo Khan, **not** that "BUNDOO KHAN mark has long become ... widely associated with Bundoo Khan USA and its Licensor, and points uniquely and unmistakably to Bundoo Khan USA and Bundoo Khan USA's Licensor," as alleged in paragraph 8 of the Petition. 1 TTABVUE 4. Further, the conclusory allegation in paragraph 13 does not satisfy the second element.

4. Over the years, the BUNDOO KHAN name and brand rose to prominence and became well-known as the best Pakistani barbeque available. After Mr. Khan's death in 1987, his children carried on the legacy of his restaurant and food by operating shops in Karachi, Pakistan then expanding to Faisalabad, Pakistan and Dubai, UAE. The use of the BUNDOO KHAN mark by Mr. Khan and his family long pre-dated any use by Registrant of its BUNDU KHAN KEBAB HOUSE mark.

5. Given the long-existing use of the BUNDOO KHAN mark, first by Mr. Khan himself and later by his family, the BUNDOO KHAN mark and brand is known by a substantial percentage of consumers in the United States, particularly those of Pakistani descent or lineage and those in geographic areas of the United States with large Pakistani communities – such as in the Los Angeles, California and Houston, Texas metropolitan areas.

8. As a result of the recognition of the BUNDOO KHAN mark as used by the original owners and now as a result of Bundoo Khan USA's use in the United States, **the BUNDOO KHAN mark** has long become well known to consumers in the United States, has become widely associated with Bundoo Khan USA and its Licensor, and **points uniquely and unmistakably to Bundoo Khan USA and Bundoo Khan USA's Licensor.**

13. **Registrant's use of BUNDU KHAN** falsely suggests a connection with the deceased person BUNDOO KHAN.

Accordingly, the second element of the Trademark Act Section 2(a) claim is also insufficiently pleaded.

**(c) Third Element of the Section 2(a) Claim**

Regarding the third element of a Trademark Act Section 2(a) claim, i.e., that **the person or institution named or identified in the mark is not connected with the goods sold or services performed by the defendant** under the mark at issue, Bundoo Khan USA alleges, the following:

9. Only Bundoo Khan USA and those entities that are authorized by Bundoo Khan USA may use the BUNDOO KHAN mark in the United States.

10. BUNDOO KHAN is a deceased individual that has no relation to Registrant. Registrant is not a relative of BUNDOO KHAN and has no other affiliation or connection to BUNDOO KHAN or his relatives.

11. The immediate family members of BUNDOO KHAN, specifically his sons and grandsons, have continued the legacy of BUNDOO KHAN as it relates to restaurant services and are continuing to run the original restaurants and provide rights to others to do the same under their strict quality control standards. ...

14. Registrant does not have the permission of Bundoo Khan USA, or the family members of BUNDOO KHAN to use the BUNDOO KHAN trademark or name.

15. Registrant has never received any consent, written or otherwise, from Bundoo Khan USA or Bundoo Khan USA's Licensor to register the BUNDU KHAN KEBAB HOUSE trademark or to claim ownership of Bundoo Khan USA's BUNDOO KHAN mark.

21. Registrant's use and registration of the trademark BUNDU KHAN KEBAB HOUSE are without Bundoo Khan USA's consent or permission, or that of Bundoo Khan's family.

1 TTABVUE 4-5.



None of the foregoing allegations state that Bundoo Khan is not connected with **the services performed by Respondent under the involved mark**. The allegations only explain why the two parties are not connected. Accordingly, the third element of Bundoo Khan USA's Trademark Act Section 2(a) claim is also insufficiently pleaded.

**(d) Fourth Element of the Section 2(a) Claim**

Bundoo Khan USA must allege that the fame or reputation of the named or identified person or institution, i.e., Bundoo Khan, is of such a nature that when the Respondent's mark **is used in connection with its services**, a connection with the Bundoo Khan would be presumed.

Bundoo Khan USA sets forth the fourth element of a claim under Trademark Act Section 2(a) by alleging in paragraph 18, “[g]iven the fame and goodwill associated with the BUNDOO KHAN mark, Registrant's use of a virtually identical mark would unquestionably be recognized by consumers as pointing to the original Bundoo Khan.”  
1 TTABVue 5.

However, Bundoo Khan USA has not alleged **when the Respondent's mark is used in connection with its services**, a connection with the Bundoo Khan would be presumed. Accordingly, the fourth element of Bundoo Khan USA's Trademark Act Section 2(a) claim is also insufficiently pleaded.

Accordingly, Respondent's motion to dismiss the Petition for Cancellation on the ground that Bundoo Khan USA's claim under Section 2(a) of the Trademark Act is insufficiently pleaded is **granted**.

## (2) Dilution Claim

The Board notes that Bundoo Khan USA alleges the following:

22. Bundoo Khan USA is harmed by the continued registration of Registrant's BUNDU KHAN KEBAB HOUSE mark. First of all, Registrant's use of its BUNDU KHAN KEBAB HOUSE mark is likely to dilute the significance and secondary meaning of Bundoo Khan USA's BUNDOO KHAN mark. In addition, the negative consumer experiences occurring at Registrant's locations tend to further dilute and impair Bundoo Khan USA's rights and the goodwill of the BUNDOO KHAN brand. The foregoing dilution by blurring and dilution by tarnishment is causing, and is likely to continue causing, significant harm to Bundoo Khan USA.

1 TTABVUE 5.

To allege a claim of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), a plaintiff must plead the following in a Board proceeding, namely:

- (1) the plaintiff owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes plaintiff's famous mark;
- (3) the defendant's use of its mark began **after** plaintiff's mark became famous; and
- (4) defendant's use of its mark is likely to cause dilution by blurring.

*Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030 (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012)).

Additionally, to properly plead a dilution claim under the facts alleged in the Petition, Bundoo Khan USA must also assert facts that would demonstrate at trial the recognition and fame of the BUNDOO KHAN mark in the United States. *See Fiat Grp. Automobiles S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1113 (TTAB 2010) ("pleading

only use of such a mark outside the United States without any pleading of widespread recognition of the mark within the United States as signifying a particular source of goods, even if such source is anonymous, is an insufficient basis for a claim of dilution”).

Regarding a dilution by tarnishment claim, the plaintiff must allege that the defendant’s use of the involved mark would damage plaintiff’s reputation. Dilution by tarnishment is an “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” Trademark Act Section 43(c)(2)(C), 15 U.S.C. § 1125(c)(2)(C); *see also Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1172-73 (TTAB 2001); *Polaris Indus. Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000).

Bundoo Khan USA has failed to allege the requisite allegations for a dilution claim either by tarnishment or blurring. Accordingly, said claim is **STRICKEN**. *See* Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a).

### **(3) Claim under Article 6bis of the Paris Convention**

Bundoo Khan USA asserts the following, in relevant part, in the last paragraph of its pleading:

23. Registrant’s use and registration of BUNDU KHAN KEBAB HOUSE violates Article 6bis of the Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as revised at Stockholm, July 14, 1967, 21 U.S.T. 1583 (the “Paris Convention”), as made applicable by Sections 44(b) and (h) of the Lanham Act, 15 U.S.C. §§1126(b), (h), because Registrant’s BUNDU KHAN KEBAB HOUSE mark is used for identical services and is a reproduction or imitation of Bundoo Khan USA’s BUNDOO KHAN mark, which is well known in the United States, that is liable to create confusion with Bundoo Khan USA’s BUNDOO KHAN mark. Moreover, Registrant registered the mark in bad faith

knowing that it was a well-known mark and that Registrant did not have consent, permission or any right to use of the mark.

1 TTABVUE 6.

Article 6bis of the Paris Convention for the Protection of Industrial Property, July 14, 1967, U.S.T. 1583 (“Paris Convention”) confers protection for “well known” marks. Under this provision, member states must refuse to register, cancel any registration of, and prohibit the use of any mark which is “liable to create confusion” with a mark which is “well-known” for identical or similar goods [or services]. *Int’l Fin. Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1602 (TTAB 2002).

To the extent Bundoo Khan USA seeks to plead a claim against Respondent under Article 6bis, the Board has held that because the Paris Convention is not self-executing, Article 6bis does not afford an independent cause of action for parties **in Board proceedings**. See *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1591 (TTAB 2009) (absent use in the United States, Trademark Act Sections 44(b) or (h) do not provide the user of an assertedly famous foreign trademark with an independent basis for cancellation in a Board proceeding) (citing *Int’l Fin. Corp.*, 64 USPQ2d at 1603), *mark cancelled*, *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623 (TTAB 2014), *rev’d on other grounds*, 84 F.Supp.3d 490 (E.D. Va. 2015), *vacated and remanded*, 819 F.3d 697 (4th Cir. 2016), *cert denied*, 137 S. Ct. 1202 (2017), *aff’d on remand*, 338 F. Supp. 3d 1477 (E.D. Va. 2018), *district court decision vacated and remanded*, 2021 USPQ2d 126 (4th Cir. 2021) (Board decision upheld by 4th Circuit), *petition for rehearing en banc filed*, No. 18-2183, 18-2232 (4th Cir. March 2, 2021); *Belmora LLC v. Bayer Consumer Care AG*, 142 S.Ct. 483 (Nov. 15,

2021) (petition for writ of certiorari to the to the United States Court of Appeals for the Fourth Circuit denied); *cf.* 5 McCarthy on Trademarks and Unfair Competition § 29:4 (5th ed. December 2022 update). In view thereof, to the extent Bundoo Khan USA seeks to allege a claim under Article 6*bis* the Convention, said claim is **STRICKEN** and will be given no further consideration. *See* Fed. R. Civ. P. 12(f).

#### **(4) Misrepresentation of Source**

The Board also notes the following allegation:

19. Upon information and belief, Registrant has falsely claimed to customers that it is affiliated with BUNDOO KHAN and that one of its principals is the grandson of BUNDOO KHAN. These representations are false.

1 TTABVUE 5.

The Board construes the foregoing allegation as a putative claim of “misrepresentation of source,” which “refers to situations where it is deliberately misrepresented by or with the consent of the respondent that goods and/or services originate from a manufacturer or other entity when in fact those goods and/or services originate from another party.” *Belmora*, 110 USPQ2d at 1632 (quoting *Osterreichischer Molkerei-und Kasereiverband Registriete GmbH v. Marks & Spencer Ltd.*, 203 USPQ 793, 794 (TTAB 1979) and citing *Global Maschinen GmbH v. Global Banking Sys., Inc.*, 227 USPQ 862, 864 n.3 (TTAB 1985)).

To the extent Bundoo Khan USA seeks to allege a claim based on misrepresentation of source, although Bundoo Khan USA alleges that Respondent has falsely claimed to its customers that it is affiliated with Bundoo Khan, Bundoo Khan USA has failed to set forth sufficient allegations in support of such a claim.

Specifically, a plaintiff must plead the following three elements to set forth a viable claim for misrepresentation of source: (1) present use of the challenged mark by the defendant; (2) specific acts or conduct by the defendant that are deliberately aimed at passing-off its goods as those of the plaintiff; and (3) the nature of the injury to plaintiff as a result of defendant's deliberate conduct (i.e. damage to reputation or lost sales). See *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*6 (Fed. Cir. 2022); see also *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1632 (TTAB 2014) ("In order to prevail, Bundoo Khan USA must show that respondent took steps to deliberately pass off its goods as those of Bundoo Khan USA."), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and remanded*, 819 F.3d 697 (4th Cir. 2016), *cert denied*, 137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp. 3d 1477 (E.D. Va. 2018), *district court decision vacated and remanded*, 2021 USPQ2d 126 (4th Cir. 2021) (Board decision upheld by 4th Circuit), *petition for rehearing en banc filed*, No. 18-2183, 18-2232 (4th Cir. March 2, 2021); *Belmora LLC v. Bayer Consumer Care AG*, 142 S.Ct. 483 (Nov. 15, 2021) (petition for writ of certiorari to the to the United States Court of Appeals for the Fourth Circuit denied). Additionally, the respondent's use must be a "blatant misuse of the mark ... in a manner calculated to trade on the goodwill and reputation of [the plaintiff]." *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). Accordingly, to the extent Bundoo Khan USA seeks to allege a claim of misrepresentation of source, Bundoo Khan USA has failed to do so.<sup>8</sup>

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<sup>8</sup> Notably, "[t]he Fourth Circuit clarified in *Belmora* that both § 43(a) and § 14(3) extend beyond trademark protection, as the 'the plain language of § 43(a) does not require that a

**(5) Repleading Allowed**

Although the Board has granted Respondent's motion to dismiss Bundoo Khan USA's claims, it is the Board's general practice to allow a party an opportunity to correct a defective pleading. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993); TBMP § 503.03. Accordingly, at the conclusion of this order, Bundoo Khan USA will be allowed time to replead its claim(s).

**C. Amended Notice of Opposition**

Turning to the Amended Notice of Opposition filed on October 18, 2022, 13 TTABVue 5, Bundoo Khan USA sets forth allegations in support of the following seven putative claims: false suggestion of a connection under Trademark Act Section 2(a), 15 U.S.C. § 1052(a); violation of Article 6bis of the Paris Convention; misrepresentation of source; deceptiveness under Trademark Act Section 2(a), 15 U.S.C. § 1052(a); false association under Trademark Act Section 43(a), 15 U.S.C. § 1125(a); dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c); and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).<sup>9</sup> The Board will consider Arrehman's arguments regarding

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plaintiff possess or have used a trademark in U.S. commerce as an element of the cause of action." *Meenaxi Enter.*, 38 F.4th 1067, \*9 (citing *Belmora*, 819 F.3d at 706).

<sup>9</sup> As noted, *supra* note 7, the better practice is to delineate clearly each separate claim and the supporting factual allegations. Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded. TBMP § 309.03(a)(2); *see also O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) ("claims must be separately stated ... We will not parse an asserted ground to see if any of the elements that go to pleading that ground would independently state a separate ground.").

Bundoo Khan USA's entitlement to a statutory cause of action and each of the alleged claims *seriatim*:

**(1) Entitlement to a Statutory Cause of Action**

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case before the Board. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \* 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must allege and ultimately demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277, at \*4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 189. Alleging, and ultimately “[proving entitlement to a statutory cause of action] in a Board opposition is a low threshold, intended only to ensure that the plaintiff has a real interest in the matter, and is not a mere intermeddler.” *Syngenta Crop Prot., Inc.*



*v. Bio-Chek LLC*, 90 USPQ2d at 1117 n.8 (citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)).

While at the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. *See, e.g., Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 50 USPQ2d at 1025.

One of Bundoo Khan USA’s putative claims in the opposition is likelihood of confusion. Entitlement to a statutory cause of action may be based on a claim of likelihood of confusion “that is not wholly without merit.” *See Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 189; *see also Cunningham v. Laser Golf Corp.*, 22 USPQ2d F.2d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations established “standing”); *Vital Pharm. Inc. v. Kronholm*, 99 USPQ2d 1708, 1712 (TTAB 2011) (“standing” established at trial where pleaded registrations had been made of record).

As discussed in further detail, *infra*, to allege a valid claim of likelihood of confusion under Section 2(d), the opposer need only allege prior use **OR** that it owns a registration which the applicant has not counterclaimed to cancel, and that the applicant’s mark so resembles the opposer’s mark as to be likely to cause confusion. *See* Trademark Act Section 2(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43-45 (CCPA 1981); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030.

Bundoo Khan USA alleges that it is the record owner of U.S. Trademark Registration 6623887 for the mark MAK AL HAAJ NUNDOO KHAN. Notice of Opp. ¶ 3, 13 TTABVUE 6. As discussed in further detail, *infra*, it also alleges sufficiently the likelihood of confusion element of a Trademark Act Section 2(d) claim. In view thereof, it has sufficiently set forth allegations that, if proven (and no counterclaim is filed), would establish its entitlement to a statutory cause of action.

To the extent Arrehman asserts that Bundoo Khan USA is the improper party to assert a claim under Trademark Act Section 2(a), the parties are referred to the Board's analysis in Section B(1)(a) of this order, *supra*.

**(2) False Suggestion of a Connection under Trademark Act Section 2(a)**

Arrehman argues that Bundoo Khan USA's claim for false association of a connection should be dismissed. Pleading a sufficient claim of false suggestion of a connection was discussed in detail, *supra*, in Section B(1) of this order. Bundoo Khan USA's allegations in support of its putative claim of false suggestion of a connection set forth in the Amended Notice of Opposition, while not identical to the allegations in the Petition for Cancellation, suffer from the same deficiencies discussed with respect to the Petition for Cancellation. For judicial efficiency, the Board will not repeat that discussion here. The parties are directed to the above-referenced analysis. In sum, the Board finds that Bundoo Khan USA's claim of false suggestion of a connection under Trademark Act Section 2(a) as set forth in the Amended Notice of Opposition is insufficiently pleaded. Accordingly, Applicant's motion to dismiss

Bundoo Khan USA's claim under Trademark Act Section 2(a) for false suggestion of a connection is **granted**.

**(3) Claim under Article 6bis of the Paris Convention**

For the reasons discussed in section B(3), supra, pertaining to the Petition for Cancellation, Bundoo Khan USA's allegations related to Article 6bis of the Paris Convention, Amended Not. of Opp. ¶¶ 7, 37, 13 TTABVUE 6, 11, do not set forth a cognizable claim for opposition in Board proceedings. Accordingly, to the extent Bundoo Khan USA seeks to set forth such a claim, said claim is **STRICKEN** and will be given no further consideration. *See* Fed. R. Civ. P. 12(f).

**(4) Misrepresentation of Source**

For the reasons discussed in section B(4), supra, pertaining to the Petition for Cancellation, Bundoo Khan USA's allegations in the Amended Notice of Opposition related to misrepresentation as to source, ¶¶ 26-27, 13 TTABVUE 10, are insufficient to set forth a claim of misrepresentation of source. Accordingly, to the extent Bundoo Khan USA has alleged such a claim, said claim is **STRICKEN**. *See* Fed. R. Civ. P. 12(f).

**(5) Deceptiveness Claim under Trademark Act Section 2(a)**

Bundoo Khan USA alleges the following in support of a deceptiveness claim:

40. Applicant's Claimed Mark so closely resembles Bundoo Khan USA's Mark that Applicant's Claimed Mark is likely to cause deception in violation of Section 2(a) of the Trademark Act and to materially alter consumers' decisions to acquire Applicant's services.

Under Trademark Act Section 2(a), registration may be refused to a mark that consists of deceptive matter. To plead a sufficient claim that a mark is deceptive under Trademark Act Section 2(a), the plaintiff must allege that:

- (1) the applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition or use of the goods or services;
- (2) prospective purchasers are likely to believe that the misdescription actually describes the goods or services; and
- (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods or services.

*See, e.g. In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009 (TTAB 2006).

Further, under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), a claim that the mark is deceptive must be based on factual allegations that the mark will lead consumers to draw a false conclusion about **the character, quality, function, composition or feature** of the goods or services with which the mark is used under circumstances where such a conclusion will be material to the consumer's decision to purchase the goods or services. *See Consorzio del Prosciutto di Parma v. Parma Sausage Prods. Inc.*, 23 USPQ2d 1894 (TTAB 1992) (issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods).

Bundoo Khan USA's putative claim of deceptiveness as related to the applied-for mark is not a cognizable claim. Rather, the referenced allegation is essentially akin to a false suggestion of a connection claim related to the persona of Bundoo Khan, rather than an allegation or claim that Respondent's mark is deceptive of the

character, quality, function, composition or feature of its services. Accordingly, to the extent Bundoo Khan USA seeks to set forth a claim of deceptiveness under Trademark Act Section 2(a), said claim is **STRICKEN** and will be given no further consideration. *See* Fed. R. Civ. P. 12(f).

**(6) Construed false designation of origin claim under Trademark Act Section 43(a)**

Bundoo Khan USA alleges the following:

46. Applicant's use of the BUNDU KHAN mark on Applicant's Services that are identical to the services of Bundoo Khan USA is likely to cause a false association, affiliation or connection as to the origin of Applicant's Claimed Mark in violation of Section 43(a) of the Trademark Act (15 U.S.C. §1125(a)).

13 TTABVUE 13.

To the extent Bundoo Khan USA seeks to assert a claim of false "affiliation, connection, or association" under Trademark Act Section 43(a), the Board construes said claim as alleging false designation of origin under that provision. It is well established that the Board has no jurisdiction over claims of unfair competition, as the Board's jurisdiction extends only to the right to federal trademark registration. *See Knickerbocker Toy Co., Inc. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972); *Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 USPQ2d at 1116 n.8 (claims under 15 U.S.C. § 1125(a) are outside the Board's jurisdiction); *Person's Co. Ltd. v. Christman*, 10 USPQ2d 1634, 1636 (TTAB 1989); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431 (TTAB 1985) (Board may not entertain any claim based on Section 43(a) of the Trademark Act); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162 (TTAB 1984) (unfair competition and Section 43(a) claims are

outside the jurisdiction of the Board). Trademark Act Section 43(a) provides a remedy “in a civil action” to anyone who is likely to be damaged by certain “uses. . . [of] any word, term, name, symbol, or device.” *Id.* Such actions are beyond the jurisdiction of the Board, which may determine only the right to registration of a mark, not liability resulting from the use of it. *See* J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition* §§ 20:21.50, 20.99 (5th ed. December 2022 Update).

Accordingly, to the extent Bundoo Khan USA seeks to set forth a claim of unfair competition under Trademark Act Section 43(a), said claim is **STRICKEN** and will be given no further consideration. *See* Fed. R. Civ. P. 12(f).

**(7) Dilution Claim under Trademark Act Section 43(a), 15 U.S.C. § 1125(c)**

Bundoo Khan USA alleges the following:

29. Applicant will be harmed by the registration of Applicant’s Claimed Mark as use of the mark is likely to dilute the significance and secondary meaning of Opposer’s BUNDOO KHAN trademark. In addition, the negative consumer experiences occurring at Applicant’s locations tend to further dilute and impair Opposer’s rights and the goodwill of the BUNDOO KHAN brand. The foregoing dilution by blurring and dilution by tarnishment is causing, and is likely to continue to cause significant harm to Opposer.

13 TTABVUE 10.

For the reasons discussed in section B(2), *supra*, pertaining to the Petition for Cancellation, particularly Bundoo Khan USA’s failure to allege that its registered mark became famous before Arrehman’s date of first use, the allegations in the Amended Notice of Opposition related to dilution are insufficient to set forth a sufficient claim of dilution, whether by blurring or tarnishment. Accordingly, to the

extent Bundoo Khan USA seeks to set forth such a claim, said claim is **STRICKEN**.  
*See* Fed. R. Civ. P. 12(f).

**(8) Likelihood of Confusion Claim under Trademark Act Section 2(d)**

**(a) Priority**

Trademark Act Section 2(d) states that a mark must be refused registration if it “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

In an opposition, where an opposer pleads (and ultimately establishes) a valid registration against an application, the issue of priority does not arise. In such case, the opposer does not have to prove prior use, and the filing date of the application underlying its registration is irrelevant. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *David Crystal, Inc. v. Shelburne Shirt Co., Inc.*, 465 F.2d 926, 175 USPQ 112, 113 (CCPA 1972) (“The question of priority does not arise against a registered trademark in an opposition proceeding”). **Only in an opposition proceeding where the applicant counterclaims for cancellation of opposer’s pleaded registration does the question of priority arise.** *See Ultratan Suntanning Centers Inc. v. Ultra Tan Int’l AB*, 49 USPQ2d 1313 (TTAB 1998); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, n.6 (CCPA 1974) (“prior use need not be shown

by an opposer relying on a registered mark unless the applicant counterclaims for cancellation”).

At this stage of the proceeding, Arrehman has not filed a counterclaim seeking cancellation of Bundoo Khan USA’s pleaded registration. In view thereof, priority is not at issue and Arrehman’s arguments pertaining to the well-known mark doctrine, discussed *infra*, are inapposite. Furthermore, to the extent Arrehman argues that the proceeding should be dismissed because Bundoo Khan USA cannot establish priority, that argument is based on the merits of the opposition and is inapplicable to a motion to dismiss which should address only the sufficiency of the plaintiff’s pleading. *See Libertyville Saddle Shop*, 22 USPQ2d at 1597.

Nonetheless, given the facts alleged in these proceedings and the parties’ respective positions, the Board is compelled to explain that, to the extent Bundoo Khan USA currently also relies in its pleading on the well-known mark doctrine to plead priority, those allegations do not support a claim of likelihood of confusion.

Specifically, Bundoo Khan USA alleges in relevant part that the mark BUNDOO KHAN is a “well-known mark,” and that said mark was used in Karachi, Pakistan in connection with restaurant services since 1948. Notice of Opp. ¶¶ 7-8, 13 TTABVue 6. Additionally, Bundoo Khan USA alleges, on information and belief, that Applicant did not use its mark in commerce prior to 1948, Notice of Opp. ¶ 15, *id.* at 8; and that BUNDOO KHAN has been recognized in the United States by a substantial percentage of consumers in the United States, particularly those of Pakistani descent or lineage. Notice of Opp. ¶¶ 10-11 and 13, 13 TTABVue 7-8.



Section 2(d) of the Trademark Act expressly requires pleading (and ultimately showing) either a mark registered in the USPTO or “a mark or trade name previously used in the United States...” In the Amended Notice of Opposition, Bundoo Khan USA largely relies on the asserted fame and recognition of its mark in the United States based on allegations of fame and recognition in Pakistan and elsewhere outside of the United States. In short, Bundoo Khan USA is relying on what has come to be known as the “well known mark” doctrine. “Under the ‘well known mark’ doctrine ... a party asserts that its mark, while as yet unused in the United States, has become so well known here that it may not be registered by another.” *Fiat Grp. Autos. S.p.A. v. ISM Inc.*, 94 USPQ2d at 1113 (citing *Franpovi SA v. Wessin*, 89 USPQ2d 1637, 1638 n.3 (TTAB 2009)).

However, the “well known mark” doctrine provides no basis for a Section 2(d) ground for opposition because it does not establish prior use of the mark in the United States as required by the statutory language of that section. *Sun Hee Jung v. Magic Snow, LLC*, 124 USPQ2d 1041, 1043-44 (TTAB 2017) (internal citations to *Bayer Consumer Care AG v. Belmora LLC* omitted). Recognition in the United States is not the same as use in the United States and, accordingly, Bundoo Khan USA’s implicit pleading of priority under Section 2(d) based on alleged renown of Bundoo Khan in the United States is insufficient. *See id.* As discussed supra, the Board does not recognize the well-known mark doctrine as an independent basis for establishing priority in *inter partes* proceedings. *See Bayer Consumer Care*, 90 USPQ2d at 1591; *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).

In view thereof, to the extent Bundoo Khan USA alleges priority of use based on the well-known mark doctrine, said allegations are **STRICKEN**. *See* Fed. R. Civ. P. 12(f).

**(b)Likelihood of Confusion**

Turning to Bundoo Khan USA’s allegations of likelihood of confusion, only a general allegation of likelihood of confusion is required. *See The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1640 n.21 (TTAB 2007) (“Opposer is not required to specifically plead every factual component of a likelihood of confusion claim.”); *see also Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030 (“Opposer need only allege it has valid proprietary rights that are prior to those of Applicant, or that it owns a registration which Applicant has not counterclaimed to cancel, and that Applicant’s mark so resembles Opposer’s mark as to be likely to cause confusion”). Bundoo Khan USA’s allegations in paragraphs 38, 42 and 43, 13 TTABVUE 12-13, clearly constitute sufficient pleading of likelihood of confusion.

Because Arrehman has not filed a counterclaim in this proceeding in connection with Bundoo Khan USA’s pleaded registration, Bundoo Khan USA’s allegation regarding its ownership of a trademark registration is sufficient to allege priority, its claim of likelihood of confusion is sufficiently pleaded. Accordingly, to the extent

Arrehman requests that the Board dismiss Bundoo Khan USA's claim under Trademark Act Section 2(d), said motion is **denied**.

**(9) Repleading Allowed**

Although the Board has granted Arrehman's motion to dismiss one of Bundoo Khan USA's claims, and has stricken other claims, it is the Board's general practice to allow a party an opportunity to correct a defective pleading. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d at 1208; *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d at 1714; TBMP § 503.03. Accordingly, the Board will allow Bundoo Khan USA time to replead its claims. *See infra*.

**III. Summary; Proceedings Resumed; Trial Dates Reset**

For the reasons discussed in this order, Arrehman's motion to dismiss filed in the opposition is **granted in part, and denied in part**; and Arrehman's motion to dismiss filed in the cancellation is **granted**.

As a general rule, when proceedings are consolidated, the trial schedule of the more recently instituted proceeding is adopted for the consolidated proceeding schedule. *See* TBMP § 511. However, in this consolidated proceeding, an answer has yet to be filed with respect to the only pleading in the cancellation and the most recent pleading in the opposition. Additionally, as mentioned *supra*, Bundoo Khan USA is allowed to replead in accordance with the case law and tenets discussed herein. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d at 1208. Bundoo Khan USA is allowed until **MARCH 31, 2023**, to submit amended pleadings in each proceeding, failing which the opposition and cancellation may be dismissed in whole or in part.

Arrehman is allowed until **APRIL 30, 2023**, to file an answer in each proceeding or a motion to dismiss in the parent case.

In view thereof, the trial schedule in this proceeding is reset as shown below. **AFTER** an amended pleading and an answer thereto is filed in each separate proceeding, all filings, including any future motion to dismiss, should only be filed in the parent opposition proceeding.

<b>Time to Answer</b>	<b>4/30/2023</b>
<b>Deadline for Discovery Conference</b>	<b>5/30/2023</b>
<b>Discovery Opens</b>	<b>5/30/2023</b>
<b>Initial Disclosures Due</b>	<b>6/29/2023</b>
<b>Expert Disclosures Due</b>	<b>10/27/2023</b>
<b>Discovery Closes</b>	<b>11/26/2023</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>1/10/2024</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>2/24/2024</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>3/10/2024</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>4/24/2024</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>5/9/2024</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>6/8/2024</b>
<b>Plaintiff's Opening Brief Due</b>	<b>8/7/2024</b>
<b>Defendant's Brief Due</b>	<b>9/6/2024</b>
<b>Plaintiff's Reply Brief Due</b>	<b>9/21/2024</b>
<b>Request for Oral Hearing (optional) Due</b>	<b>10/1/2024</b>

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Such briefs should utilize citations to the TTABVue record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).