

ESTTA Tracking number: **ESTTA1286631**

Filing date: **05/22/2023**

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

Proceeding no.	91276101
Party	Plaintiff Bundoo Khan USA, LLC
Correspondence address	FARAH P. BHATTI BUCHALTER, A PROFESSIONAL CORPORATION 18400 VON KARMAN AVE SUITE 800 IRVINE, CA 92612 UNITED STATES Primary email: fbhatti@buchalter.com Secondary email(s): ipdocket@buchalter.com, hblan@buchalter.com, mseror@buchalter.com 949-224-6272
Submission	Opposition/Response to Motion
Filer's name	Matthew Seror
Filer's email	mseror@buchalter.com
Signature	/mlseror/
Date	05/22/2023
Attachments	Opp to Motion to Dismiss 5.22.23.pdf(155834 bytes)

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

<p>BUNDOO KHAN USA, LLC</p> <p style="text-align: center;"><i>Petitioner-Opposer</i></p> <p style="text-align: center;">v.</p> <p>ARREHMAN ARRAHEEM CORP.</p> <p style="text-align: center;"><i>Registrant-Applicant</i></p>	<p>OPPOSITION NO. 91276101</p> <p>CANCELLATION NO. 92080482</p>
--	---

BUNDOO KHAN USA, LLC’S OPPOSITION TO MOTION TO DISMISS

Petitioner/Opposer Bundoo Khan USA, LLC (“Bundoo USA”) hereby opposes the motion to dismiss (the “Motion”) filed in this consolidated proceeding by Registrant/Applicant Arrehman Arraheem Corporation (“Arrehman”).

I. INTRODUCTION

Arrehman’s instant motion to dismiss Bundoo USA’s Second Amended Notice of Opposition (“Opposition”) is premised on misconstruing, and in some instances ignoring, binding precedence, prior orders of the Board, and on the use of inaccurate and misleading, quotes from the authorities cited therein. Arrehman’s position and arguments cannot withstand scrutiny. And this is all the more the case on a motion to dismiss, where the plead allegations are presumed true. See *Advanced Cardiovascular Sys, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (citations omitted); TBBP § 503.02. Because Bundoo USA’s Opposition sufficiently pleads its alleged claims, the Motion must be denied.

II. FACTUAL BACKGROUND

On May 11, 2022, Bundoo USA instituted this action and opposed the registration of Arrehman's registration for the mark BUNDU KHAN KABAB HOUSE BEST BBQ FOR YOU. Bundoo USA filed a First Amended Opposition on September 7, 2022. On November 30, 2022, Arrehman filed a motion to dismiss Bundoo USA's amended opposition.

On September 6, 2022, Bundoo USA filed a petition to cancel Registration No. 4011592 (BUNDU KHAN KABAB HOUSE) ("Cancellation Proceeding"). Arrehman is also the registered owner of the mark at issue in the Cancellation Proceeding. On October 14, 2022, Arrehman filed a motion to dismiss the Cancellation Proceeding.

On March 6, 2023, the Board issued an order on Arrehman's Motion to Dismiss in this proceeding and the Cancellation Proceeding ("March 6, 2023 Order"). The March 6, 2023 Order also consolidated this proceeding and the Cancellation Proceeding.

On March 31, 2023, and pursuant to the March 6, 2023 Order, Bundoo USA filed a Second Amended Opposition in this Proceeding and an Amended Petition to Cancel in the Cancellation Proceeding. This Motion follows.¹

III. BUNDOO USA'S SECOND AMENDED OPPOSITION IS SUFFICIENTLY PLEAD

Arrehman's Motion argues that Petitioner's opposition claim, which is premised of Section 2(a) of the Trademark Act ("Section 2(a)"), is insufficiently plead for two reasons: (1) the facts demonstrating the fame and recognition of the Bundoo Khan name and persona in the United States reference the acts of third parties, and not Bundoo USA; and (2) the facts demonstrating the fame and recognition of the Bundoo Khan name and persona relate only to

¹ Arrehman has not filed a response to the Amended Petition for Cancellation in the Cancellation Proceeding.

conduct occurring outside the United States. Motion, pg. 3. Arrehman is wrong on the law and the facts.

As set forth in the Board's March 6, 2023 Order, Bundoo USA is not required to allege its own use of the Bundoo Khan name or persona in order to state a Section 2(a) claim. "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" citing *In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1633 (TTAB 2015). As such, the Board has already considered and dispensed with the first premise upon which Arrehman's Motion is based.

As for its second contention, that the Opposition relies only on conduct outside the United States, that assertion is not only inaccurate but it ignores the fact that such conduct can play a role in adjudicating a Section 2(a) claim (as set forth in the authority Arrehman itself relies on). The Opposition alleges both the recognition and use of the Bundoo Khan name in the United States prior to Arrehman's first use, and the fame and recognition derived therefrom. See Opposition, ¶¶ 7, 8 (multiple restaurants using Bundoo Khan name in the United States that pre-date Arrehman), and 15 (The Bundoo Khan name/persona was referenced in well-circulated United States media publications, thereby leading to increased fame and recognition in the United States). Arrehman cannot simply ignore the allegations in the Opposition it finds inconvenient or contrary to its position. Moreover, as set forth in the *Hornby v. TJX Companies, Inc.* case that Arrehman itself relies upon, the fame and recognition of the Bundoo Khan name and persona outside the United States (which Petitioner also pleads) is relevant to, and probative of, Bundoo USA's Section 2(a) claim.

Because the allegations in the Opposition adequately and sufficiently allege a claim under Section 2(a), Bundoo USA respectfully requests that the Motion be denied.

A. Bundoo USA is Not Required to Allege Its Own Use of the Mark at Issue in the United States.²

In an attempt to re-tread on matters already decided by the Board in its March 6, 2023 Order, the Motion argues that the Opposition fails because it does not allege Bundoo USA's own use of the Bundoo Khan mark/persona before Arrehman's use. See Motion, pg. 2, 3 ("Petitioner fails to state a claim for false suggestion under Section 2(a) because: (1) the facts relied upon by Petitioner regarding United States activities relates **only** to activities of **third parties**") (emphasis in original). Essentially, Arrehman is seeking to dismiss the Opposition because Bundoo USA has failed to allege its own use of the Bundoo Khan mark in the United States prior to Arrehman's use.

In response to Arrehman's prior motion to dismiss filed in this proceeding and the Cancellation Proceeding, the Board held that Petitioner need not allege its own use of the mark or designation at issue to state a Section 2(a) claim: ("[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,**" (emphasis added); and "Notably, the plaintiff is not required to plead or ultimately

² In another attempt to re-argue matters previously ruled on by the Board, the Motion alleges that the Opposition fails because Bundoo USA does not have the ability to pursue the asserted Section 2(a) claim because the claimed mark does not point to or identify plaintiff. The Board has already held, in its March 6, 2023 Order, that Bundoo USA has standing to pursue the alleged Section 2(a) claim and the Motion provides no basis for the Board to re-visit that ruling. See March 6, 2023 Order, pgs. 11-12.

prove that it used the designation at issue as a trademark or service mark itself,” citing *In re Nieves, supra*. March 6, 2023 Order, at 8-9. Based on the above authorities, and the Board’s prior order, Bundoo USA is entitled to rely upon the use by third parties of the Bundoo Khan name or persona in support of its Section 2(a) claims. Indeed, in some instances, use by third parties can be extremely probative of demonstrating the relative fame and consumer recognition of a particular mark or designation. See *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1427 (TTAB 2008).

In an attempt to cast doubt on Bundoo USA’s reliance on third party uses of the Bundoo Khan name and persona in connection with its Section 2(a) claims, the Motion quotes *Hornby*, as standing for the proposition that “third-party registrations have no probative value.” See Motion, pg. 2. Arrehman’s use of this quote is extremely misleading for two reasons. First, Arrehman fails to include the whole quote, and the omitted portion greatly tempers the relevance of the quote to this matter. Second, Arrehman fails cite to other language taken from the same paragraph of the *Hornby* opinion which unquestionably holds that third party use can be relevant in the connection with a Section 2(a) claim such as those asserted here.

The full quote from *Hornby* provides: “the three third-party registrations have no probative value in showing that the name “Twiggy” does not point uniquely to petitioner.” *Hornby, supra*, 87 USPQ2d at 1427. When viewed in context, this passage stands for the unremarkable proposition that third party usage cannot be used to show that a mark **does not** point to a specific persona. This can be due to a variety of factors, most significantly the use of the mark in connection with different goods or services.

Moreover, another passage taken from this same paragraph in *Hornby* sheds even more light on the use of third party usage, or registrations, in connection with Section 2(a) claims: “Third-party registrations can, of course, be used to show that a term has a particular significance within an industry, in the same way that dictionaries are used.” *Id.* This confirms the potential importance of third party registrations or uses of marks, names or designations, which can be relevant to show that the specific mark, name or designation has significance within a relevant industry. Here, the Opposition alleges that third parties were using the Bundoo Khan name/persona in connection with restaurants prior to Arrehman’s first use. This alleged third party usage is probative in this case to demonstrate the fame and recognition of the Bundoo Khan name/persona in the relevant industry, i.e. in connection with restaurants and food service, before Arrehman’s first use, and presumably shows that Arrehman used the BUNDU KHAN name in violation of Section 2(a).

As the Board has already held, Section 2(a) claims are not dependent upon Bundoo USA’s own prior use of the name or designation at issue. As a result, Bundoo USA’s Section 2(a) claim is sufficiently plead and the Motion should be denied.

B. The Opposition Does Not Rely Exclusively on Non-United States Conduct

The Motion also contends that the Opposition fails because the facts alleged “relate only to facts that occurred outside the United States.” Motion, pg. 3. This is simply inaccurate. The Opposition alleges that the Bundoo Khan name and persona were not only well-known in the United States prior to Arrehman’s first use, but that the name and persona were actually in use in the United States (specifically in Los Angeles and Chicago) and were the subject of widely circulated media publications in the United States. See Petition, ¶¶ 7, 8, 15, 16. These

allegations demonstrate the fame and recognition of the Bundoo Khan name and persona *in the United States* prior to Arrehman's use.

In addition, the Opposition details the origin story of Bundoo Khan and his fame abroad. See Petition, ¶¶ 3-6, 15. Arrehman casts aside these allegations and here again relies on a misleading quote from *Hornby* in support of its argument. See Motion, pg. 3 (“[Activities in countries outside the United States’ are not relevant to the Section 2(a) false association analysis.”) This is not actually what *Hornby* held. In *Hornby*, which was a decision on the merits and not at the motion to dismiss stage, the Board held that activities outside the United States were not considered in that case because there was no evidence that those activities reached or had an impact on United States consumers. See *Hornby, supra*, 87 USPQ2d at 1425. But *Hornby* does not stand for the proposition that all non-United States activities are without relevance. In fact, *Hornby* held the opposite, “Because evidence of fame or reputation in other countries may have relevance to the extent that consumers in the United States would be aware of [Twiggy] as a result of these activities, we will not exclude this evidence, but will give it only the probative weight to which it is entitled.” *Id.* at 1416.

Here, the Opposition alleges not only the fame, recognition and reputation of Bundoo Khan abroad, but also in the United States. The foregoing allegations, if established at trial, is probative of the fame, recognition and reputation of Bundoo Khan in the United States. As a result, the foregoing allegations are properly plead and can be used to establish Bundoo USA's Section 2(a) claim.

IV. CONCLUSION

For the reasons set forth herein, Bundoo USA respectfully requests that the Motion to Dismiss be denied.

Dated: May 19, 2023

Respectfully Submitted,

By: /mlseror/
Farah P. Bhatti
Matthew Seror
Buchalter, a Professional Corporation
18400 Von Karman Ave., Suite 800
Irvine, California 92612
Phone: (949) 224-6272
Email: fbhatti@buchalter.com
mseror@buchalter.com
ipdocket@buchalter.com
hblan@buchalter.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSITION TO MOTION TO DISMISS has been served on Sarah J. Ring, counsel for Applicant, by forwarding said copy on May 22, 2023, via email, to the correspondence address of record for Applicant Arrheem Arraheem Corporation sring@porterhedges.com, edeese@porterhedges.com.

/mlseror/

Matthew L. Seror