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June 27, 2023

Opposition No. 91276101 (parent)
Cancellation No. 92080482
Cancellation No. 92081962

Bundoo Khan USA, LLC

v.

Arrehman Arraheem Corporation

By the Trademark Trial and Appeal Board:

This consolidation proceeding now comes up for consideration of the following motions: (1) Arrehman Arraheem Corporation's (Arrehman) filing (filed March 29, 2023) captioned as "Notice of Related Proceedings" which the Board construes as a motion to suspend;¹ (2) Arrehman's motion (filed May 10, 2023) to consolidate this

¹ 19 TTABVUE. In this order, the Board cites to the proceeding record by the TTABVUE docket entry number and TTABVUE page number, in accordance with the guidance provided in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 702.05 and 801.01 (2022). The Board expects that the parties will use this method of citing to the record throughout this proceeding. Except for those involving the motion to consolidate, all TTABVUE entries in this order will refer to those located in the parent proceeding, Opposition No. 91276101.

proceeding with Cancellation No. 92081962;² and (2) Arrehman's motion (filed May 1, 2023) to dismiss the Section 2(a) claim in the petition to cancel and notice of opposition of Bundoo Khan USA LLC (Bundoo) under Fed. R. Civ. P. 12(b)(6).

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 and the arguments submitted in connection with the subject motions.

Bundoo's amended pleading of March 31, 2023 is accepted into the record and is now the operative pleading.³

I. Motion to Suspend

In Arrehman's "Notice of Related Proceedings" it notifies the Board that Bundoo "has filed two federal lawsuits asserting rights in marks that are confusingly similar to Arrehman's registered mark."⁴ Arrehman submitted copies of the complaints for these two district court proceedings.

On April 14, 2023, Bundoo filed an opposition to Arrehman's notice. Bundoo argues that "[t]hese proceedings are completely unrelated to the current proceedings pending at the Trademark Trial and Appeal Board";⁵ that Arrehman is not a party to

² The Board notes that such motion is fully briefed in the electronic file of Opposition No. 92081962, 7-9 TTABVUE.

³ 20 TTABVUE. The Board's order of March 6, 2023 allowed Bundoo time to submit amended pleadings in Opposition No. 91276101 and Cancellation No. 92080482.

⁴ 19 TTABVUE 5 – 16.

⁵ 21 TTABVUE 2.

either of the referenced federal actions, and therefore the parties to these actions are not the same parties as are before the Board in this proceeding”;⁶ and that “the issues raised in each of the referenced matters are different than the issues raised in the Opposition and Cancellation proceedings pending before the Trademark Trial and Appeal Board.”⁷

The Board’s well-settled policy is to suspend proceedings when the parties are involved in a civil action which may have a bearing on the Board case. Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). *See New Orleans Louisiana Saints LLC v. Who Dat?*, 99 USPQ2d 1550, 1552 (TTAB 2011) (“[T]he civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board.”). To the extent a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is binding upon the Board. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 20145, 2053 (“When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB’s analysis, the TTAB gives preclusive effect to the court’s judgment.”).

After carefully reviewing the civil court papers submitted by Arrehman, the Board finds that the civil court’s decisions will not likely have a bearing upon the above-captioned proceedings. The Board observes that Arrehman is not a party in the civil

⁶ *Id.*

⁷ *Id.*

actions. Nor are the subject marks of this proceeding involved in the civil action. The motion to suspend is denied.

A. Motion to Consolidate

In support of its motion to consolidate, Arrehman argues that the proceedings involve the same parties, same counsels, and similar marks. Arrehman further argues that common questions of law and fact are involved and that consolidation of Opposition No. 92081962 with the already consolidated proceeding “will result in considerable savings in time, effort and expense.”⁸

In response, Bundoo states that it opposes consolidation because “the legal issues and theories implicated in this proceeding are different than those implicated in the already consolidated proceeding...” and because “there is no legitimate basis for delaying the adjudication of this proceeding which will most certainly occur if the proceedings are consolidated.”⁹

In reply, Arrehman argues that “this proceeding and the Consolidated Proceedings are disputes between identical parties regarding the same issue—whether or not Arrehman’s use/registration of the Bundu Khan mark is prohibited under Lanham Act, Section 2(a)”;¹⁰ that “there is no requirement that the issues be identical”;¹¹ and Bundoo’s “complaint that consolidation would delay these

⁸ Opposition No. 92081962, 7 TTABVUE 3.

⁹ Opposition No. 92081962, 8 TTABVUE 2.

¹⁰ Opposition No. 92081962, 9 TTABVUE 2.

¹¹ *Id.* at 3.

proceedings is without merit...Both this and the Consolidated Proceedings are at the same stage of litigation, as discovery has not begun in either.”¹²

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Wis. Cheese Grp., LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1889 and n.7 (TTAB 2007). Consolidation is discretionary with the Board. *See, e.g., Wis. Cheese Grp.*, 118 USPQ2d at 1264. In determining whether to consolidate proceedings, the Board weighs the savings in time, effort, and expense which may be gained from consolidation against any prejudice or inconvenience which may be caused thereby. *World Hockey Ass’n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975). *See also* TBMP § 511.

The three proceedings involve the same parties and the same counsels. Both proceedings concern related marks and involve similar claims. Accordingly, it is foreseeable that the cases may involve overlapping discovery, witnesses, and evidence. The Board finds that consolidation is warranted to avoid duplicative and/or piecemeal discovery. *See One Jeanswear Grp. Inc. v. Yogaglo, Inc.*, 127 U.S.P.Q.2d 1793 (T.T.A.B. 2018) (“Given that the opposed marks are identical and the grounds for opposition are similar, much of the discovery and evidence at trial will likely be the same in both cases. Absent consolidation, the parties would likely continue with

¹² *Id.*

duplicative and/or piecemeal discovery and prosecution in the separate proceedings.”).

Accordingly, the motion to consolidate is granted. Opposition No. 91081962 is hereby consolidated with Opposition No. 91276101 and Cancellation No. 92080482 and may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Any amended pleading filed by Bundoo and the answer in response, however, should be filed in each individual proceeding.¹³

The Board file will continue to be maintained in Opposition No. 91276101 as the “parent case.” From this point on, 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.¹⁴

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.

¹³ 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).

¹⁴ 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.

II. Motion to Dismiss

The Board turns back to consider the motion to dismiss filed in parent Opposition No. 91276101.

In support of its motion, Arrehman argues that Bundoo’s “false suggestion of a connection basis for opposition/cancellation must be dismissed because [Bundoo] has failed to plead that Arrehman’s mark ‘uniquely identifi[es] the plaintiff **in the United States prior to** [Arrehman’s] use of its registered mark.” Specifically, Arrehman asserts that Bundoo fails to state a claim for false suggestion of a connection under Section 2(a) because “(1) the facts relied upon by [Bundoo] regarding United States activities relate only to activities of third parties and (2) the facts relied upon by [Bundoo] regarding the alleged original Mr. Bundoo Khan relate only to facts that occurred outside the United States.”¹⁵

In response, Bundoo argues that “[a]s set forth in the Board’s March 6, 2023 Order, [Bundoo] not required to allege its own use of the Bundoo Khan name or persona in order to state a Section 2(a) claim” and that “[a]s such, the Board has already considered and dispensed with the first premise upon which Arrehman’s Motion is based.”¹⁶ Bundoo further argues with regard to Arrehman’s second contention that the pleading(s) relies only on conduct outside the U.S. that “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” and “the fame and recognition of the Bundoo

¹⁵ 22 TTABVUE 5.

¹⁶ 25 TTABVUE 4.

Khan name and persona outside the United States (which Petitioner also pleads) is relevant to, and probative of, [Bundoo's] Section 2(a) claim.”¹⁷

In reply, Arrehman argues that Bundoo is “trying to plead around the ‘well-known mark doctrine’ which the Board...[has] already dismissed” and that Bundoo “continues to ignore that it cannot support a false association claim with activities taking place outside the United States.”¹⁸ Arrehman asserts that “vague references to uses of Bundoo Khan by unnamed third-parties do not suffice to state a plausible claim for false association” and that [Bundoo's] false association claims should therefore be dismissed, with prejudice.”¹⁹

The parties are reminded that 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;
- (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

¹⁷ *Id.*

¹⁸ 26 TTABVUE 2.

¹⁹ *Id.*

in connection with its goods or services, a connection with the person or institution named or identified would be presumed.²⁰

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 parties should note that plaintiff must ultimately establish that 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 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

²⁰ The fame or reputation of the plaintiff must be determined as of the time defendant's registration issued. *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1416 (TTAB 2008).

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).

The Board has carefully reviewed the amended pleading. Arrehman is essentially arguing that Bundoo has failed to allege that any prior use “uniquely identifies” Bundoo such that a connection is presumed as required for a Section 2(a) claim. Arrehman’s position is that Bundoo’s Section 2(a) claim fails because in the notice of

opposition/petition to cancel (a) all alleged uses of the Bundu Khan name in the United States prior to Arrehman's use were uses made by unknown third-parties; and (b) all alleged uses by anyone allegedly associated with Bundu (or its related entities) were uses that took place outside the United States. The Board disagrees and finds that, for pleading purposes, Bundoo has sufficiently alleged that Arrehman's mark points uniquely and unmistakably to Bundu Khan by stating that "[b]ecause the Bundoo Khan name is only associated and connected with Pakistan barbeque in the minds of consumers, including consumers in the United States, use of the name by [Arrehman] clearly creates a connection with Bundoo Khan the individual." ...” See Notice of Opposition, ¶20; see also Petition to Cancel ¶19.

In this instance, the Board has already made clear that a term may be considered the identity of a person even if his or her name or likeness is not used. All that is required is that the mark sought to be registered clearly identifies a specific person or persons (in this case, Bundu Khan). *Nieves*, 113 USPQ2d at 1644; see also *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (“[W]hile the general public in the United States may or may not have seen the upcoming Olympic games referred to precisely as ‘Sydney 2000,’ we have no doubt that the general public in the United States would recognize this phrase as referring unambiguously to the upcoming Olympic Games in Sydney, Australia, in the year 2000.”).

Further the Board emphasizes that “the phrase ‘falsely suggest a connection with’ necessarily requires by implication that the entity with whom a connection is suggested must be the prior user; that is to say,...a subsequent user has no rights **in**

a term as against a prior user thereof.” *In re Mohawk Air Services, Inc.* 196 USPQ 851, 854-55 (TTAB 1977). In this case, Bundoo essentially alleges that it is the prior user of the term Bundoo Khan because it is the “is the exclusive licensee and franchisee of the Bundoo Khan name and brand....” See Notice of Opposition, ¶ 9; see also Petition to Cancel ¶ 7. Bundoo’s interest in the name Bundoo Khan does not depend on the adoption and use of the technical trademark at issue. Hence, Arrehman’s arguments that the pleadings at issue fail because Bundoo relies on activities of third parties is not well taken. In the same vein, Arrehman’s arguments that the pleadings also fail because Bundoo similarly relies on activities that occurred outside the United States is not well taken, at least for pleading purposes. Again, a party’s interest in such a name or designation does not depend for its existence on the adoption and use of a technical trademark. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food, Imports Co., Inc.*, 217 USPQ at 508-509. Thus, Bundoo, as the opposer in this proceeding, “may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner.” *Buffett*, 226 USPQ at 429 (citing *Univ. of Notre Dame du Lac*, 217 USPQ at 509).

In view of the foregoing, Arrehman’s motion to dismiss is denied.

Proceedings Resumed

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 pleadings in Opposition No. 91276101 and Cancellation 92080482. Therefore, Arrehman is allowed until July 26, 2023 to file an answer in each of these proceedings. The trial schedule for this consolidated proceeding is now reset as follows:

Deadline for Discovery Conference	8/25/2023
Discovery Opens	8/25/2023
Initial Disclosures Due	9/24/2023
Expert Disclosures Due	1/22/2024
Discovery Closes	2/21/2024
Plaintiff's Pretrial Disclosures Due	4/6/2024
Plaintiff's 30-day Trial Period Ends	5/21/2024
Defendant's Pretrial Disclosures Due	6/5/2024
Defendant's 30-day Trial Period Ends	7/20/2024
Plaintiff's Rebuttal Disclosures Due	8/4/2024
Plaintiff's 15-day Rebuttal Period Ends	9/3/2024
Plaintiff's Opening Brief Due	11/2/2024
Defendant's Brief Due	12/2/2024
Plaintiff's Reply Brief Due	12/17/2024
Request for Oral Hearing (optional) Due	12/27/2024

Important Trial and Briefing Instructions

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).