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

Proceeding no.	91276101
Party	Plaintiff Bundoo Khan USA, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ARREHMAN ARRAHEEM CORPORATION, Applicant/Petitioner v. BUNDOO KHAN USA, LLC, Registrant/Oppose	Opposition No: 91276101 (parent) Cancellation No.: 92080482 Cancellation No.: 92081962

BUNDOO KHAN USA, LLC'S REPLY BRIEF IN SUPPORT OF MOTION TO COMPEL FURTHER RESPONSES TO INTERROGATORIES AND PRODUCTION OF DOCUMENTS

Registrant/Opposer Bundoo Khan USA, LLC ("Oppose") submits the following reply brief in support of its previously filed motion to compel Applicant/Petitioner Arrehman Arraheem Corporation's ("Applicant") further responses to Opposer's First Set of Interrogatories and to produce documents responsive to Opposer's First Set of Requests for Production of Documents.

I. THE COMMON INTEREST DOCTRINE DOES NOT APPLY

In this consolidated proceeding, Opposer has alleged that it is the exclusive United States licensee for the BUNDOO KHAN mark, having been granted these exclusive rights pursuant to a written agreement executed by Bundoo Khan's family. Applicant contends that Opposer does not possess the rights it has alleged, and contends that other members of the Bundoo Khan family, including Haji Akbar, did not participate in the licensing of the Bundoo Khan mark to Opposer. See Opposition, Section A.

In discovery requests, Opposer sought information related to Applicant's communications with members of the Bundoo Khan family. Initially, Applicant objected to these requests as calling for information protected by the attorney-client privilege and the attorney work-product privilege. In its opposition to Opposer's motion to compel, Applicant

asserts for the first time that the information sought by the discovery requests at issue are protected by the common interest doctrine.[1]

The common interest privilege is not an independent privilege, but rather is a doctrine which specifies the circumstances under which the disclosure of privileged information to a third party does not waive the underlying privilege. As a result, the common interest privilege is more appropriately characterized as a "nonwaiver" doctrine, rather than as an independent privilege. *Citizens for Ceres v. Superior Court*, 217 Cal.App. 4th 889, 914 (2013); *Oxy Resources California LLC v. Superior Court*, 115 Cal.App. 4th 874, 888 (2004).

A party asserting the common interest privilege must show that: (1) the communications at issue were made in furtherance of a joint defense effort; (2) the statements were designed to further that effort; and (3) the privilege was not waived. *In re Sealed Case*, 29 F.3d 715, 719, n. 5 (D.C. Cir. 1994). The party asserting the application of the privilege bears the burden of establishing that it applies and that each of the foregoing elements is satisfied. *United States v. Ruehle*, 583 F.3d 600, 608 (9th Cir. 2015); *Vicor Corp. v. Vigilant Ins. Co*., 674 F.3d 1, 17-19 (1st Cir. 2012). Application of the common interest privilege must be narrowly construed. *Mondis Tech, Ltd. v. LG Elecs., Inc*., 2011 U.S. Dist. LEXIS 47807, *19 (E.D. Tex. May 4, 2011).

Here, Applicant has failed to meet its burden of establishing that that the common interest applies to communications Applicant (or its counsel) has had with members of the Bundoo Khan family.

A. <u>There is No Evidence That Applicant and Members of the Bundoo Khan Family Are Engaged in a Joint Defense Effort</u>

The common interest doctrine only applies if Applicant and the members of the Bundoo Khan family that Applicant is in communications with are engaged in a joint defense effort.

[1] Applicant objected to the discovery requests at issue as calling for information protected by the attorney-client privilege or attorney work-product doctrine. During the meet and confer process, counsel for Applicant withdrew its objection based on the attorney-client privilege. The common interest doctrine was not asserted in Applicant's written responses or during the meet and confer process. The application of this doctrine was raised for the first time in opposition to Opposer's motion to compel.

Applicant has completely failed to establish the existence of such a joint effort. The only allegation is that Applicant and the members of the Bundoo Khan family that Applicant is communicating with share a common foe – the Opposer. Indeed, there is no evidence that the interests of Applicant and the members of the Bundoo Khan family Applicant is speaking with are aligned.

In this case, Applicant's concern is whether its use of BUNDOO KHAN by Applicant draws an association with the persona of Bundoo Khan in contravention of Section 2(a) of the Trademark Act. To the contrary, the interests of the Bundoo Khan family members Applicant is speaking to appear to center around whether other members of the Bundoo Khan family were permitted to grant Opposer the exclusive license that was granted.[2] These interests are not "common" and therefore insufficient to support the application of the common interest doctrine. *Leader Techs., Inc. v. Facebook, Inc.*, 719 F.Supp. 2d 373, 376 (D. Del. 2010), citing *In re Regents of the Univ. of California*, 101 F.3d 1386, 1390 (Fed. Cir. 1996) (to qualify for the common interest doctrine the interests of the parties must be identical. Similar is not enough.)

Tellingly, and despite offering the declarations of both Haji Akbar and Afshan Khan (a principal of Applicant) in opposition to the motion to compel, neither declarant attests to any joint defense effort – much less any evidence that the interests of Applicant and Haji Akbar are identical. See Exhibits 1 and 2 to Applicant's Opposition to Motion to Compel.

B. <u>There is No Evidence That the Alleged Privileged Communications or Statements Were Designed to Further the Joint Defense Effort</u>

While Applicant's failure to establish the existence of a joint defense effort as between itself and members of the Bundoo Khan family is fatal to its assertion of the common defense doctrine, so too is Applicant's failure to establish that the communications at issue were

[2] While Applicant is attempting to manufacture a dispute as amongst Bundoo Khan family members as to the validity of Opposer's rights, this is a red herring insofar as Opposer's rights are actually immaterial to this dispute. Applicant's applied for mark can be refused, and its existing marks cancelled, if those marks inappropriately draw an association with the persona of Bundoo Khan. The viability of Opposer's exclusive license has no bearing on that inquiry and Opposer has standing in these proceedings due to Applicant's marks being cited against Opposer's mark during the prosecution of Opposer's mark.

designed to further that effort. *In re Regents of the Univ. of California*, 101 F.3d 1386, 1389 (Fed. Cir. 1996), quoting *In re Grand Jury Subpoena Duces Tecum*, 406 F.Supp. 381, 386 (S.D.N.Y. 1975) (the disclosure must have been made with the purpose of securing, advancing, or supplying legal representation.)

Applicant has failed to establish that any disclosure made to members of the Bundoo Khan family were in connection with "securing, advancing or supplying" legal advice. Moreover, one of the elements Opposer must establish to prevail in this case is that Applicant has no connection with the family of Bundoo Khan. Applicant's Opposition to the now pending motion to compel, and the submission of the Haji Akbar declaration in support of its Opposition goes directly to this element and Opposer should be entitled to take discovery on this issue. In addition, to the extent Applicant is attempting to secure a relationship with Haji Akbar which could afford Applicant with rights to use the Bundoo Khan name, that is not only relevant and discoverable, that alone is fatal to Applicant's common interest doctrine assertion. *Mondis Tech, Ltd. v. LG Elecs., Inc.*, 2011 U.S. Dist. LEXIS 47807, *18-19 (E.D. Tex. May 4, 2011); *Rembrandt Tech., L.P. v. Harris Corp.*, 2009 Del. Super. LEXIS 46 at *7, n. 73. (When parties are negotiating their rights and relationships to one another, they would be adverse to each other and could not possibly have a common legal enterprise at that point.)

Again, it is Applicant's burden to establish the applicability of the common interest doctrine. Applicant has not done so and therefore it should be ordered to produce all information and documents responsive to the discovery requests at issue.

II. APPLICANT SHOULD BE ORDERED TO PRODUCE ALL RESPONSIVE DOCUMENTS RELATED TO THE IDENTIFICATION OF ITS CUSTOMERS.

This case involves claims that Applicant's use of BUNDOO KHAN draws an association with the persona of Bundoo Khan, a deceased individual. Opposer has alleged that Mohammed Khan, one of Applicant's principals, has personally told customers of Applicant that he is related to Bundoo Khan. If this is true, it is certainly probative to these proceedings because it not only supports Opposer's position of an association between Applicant's use of BUNDOO KHAN and

the persona of Bundoo Khan, but also Applicant's intent in fostering that association. The testimony of witnesses establishing the foregoing is clearly relevant, and Applicant does not contend otherwise.

Having established that the identification of Applicant's customers is relevant and probative, the questions becomes whether there is a basis for not ordering Applicant to provide responsive information and documents. Applicant argues in its opposition that producing these documents is "unreasonable, harassing, overly burdensome, and simply unrealistic." See Opposition pg. 7, lines 1-2. While the foregoing is offered as **argument** in its Opposition, Applicant offers no **facts** establishing or explaining why Opposer's requests are "unreasonable harassing, overly burdensome, and simply unrealistic." Only the unsupported argument in the Opposition is provided. Indeed, in the declaration of Applicant's principal offered in support of its Opposition, no mention is made of these requests, how burdensome it would be to comply with the requests, or anything of the sort. Perhaps all it would take is a few clicks in a computer program to create the requested information? Perhaps it would take an hour of time? This would not present the sort of burden that is sufficient to justify the refusal to provide such vital information. As the party seeking to avoid the production of documents, Applicant has the burden of establishing that the production of the requested documents imposes an undue burden. See T.M.B.P. § 402.02, citing to Fed. R. Civ. Pro. 26(b)(2)(B) and *Frito-Lay North America v. Princeton Vanguard*, LLC, 100 USPQ 2d 1904, 1910 (TTAB 2011) ("the party resisting discovery must show that the material sought is 'not reasonably accessible because of undue burden or cost.'"). The bare assertion that a request is overly burdensome is insufficient and "meaningless boilerplate." *Fischer v. Forrest*, 2017 U.S. Dist. LEXIS 28102, * 8 (S.D. N.Y. 2017) ("[S]uch objections are improper unless based on particularized facts.").When arguing that a discovery request is burdensome, the party challenging the discovery request bears the burden of setting forth **facts** to support such an assertion. Applicant has failed to do so in this case, both in response to the actual discovery request and in opposition to the motion.

Because Applicant has failed to offer any facts or evidence to support its contentions that Opposer's discovery requests are "unreasonable, harassing, overly burdensome, and simply unrealistic" the Board should overrule those objections and order a full production of all responsive documents be made by Applicant.

III. THE BOARD SHOULD ORDER APPLICANT TO PRODUCE ALL RESPONSIVE DOCUMENTS WHICH ARE THE SUBJECT OF THE MOTION

Applicant contends that certain portions of Opposer's motion to compel is moot because Applicant has produced additional responsive documents following the filing of the motion to compel. Oppose acknowledges that additional documents have been produced by Applicant (albeit only after Oppose was forced to file its motion). But Opposer disagrees with the contention that this renders certain portions of the motion moot for two reasons. First, Applicant has yet to provide supplemental discovery responses confirming that all responsive documents have now been produced. Absent such a representation, it is possible that all responsive documents which are the subject of Opposer's Motion have not been produced. Second, Applicant's broad (yet vague) assertion that the requests which are the subject of Opposer's motion are "mostly moot" fails to adequately specify which requests it believes it has fully complied with and which remain at issue. See Opposition, pg. 4, line 4. Given this uncertainty, Opposer requests that the Board order all documents responsive to the discovery requests which are the subject of Opposer's motion be produced. If Applicant has produced all such documents, then no further action on its part is necessary and it should not object. But if Applicant has not yet produced all responsive documents, such an order ensures that all responsive documents will be produced.

IV. THE REMAINING PORTIONS OF APPLICANT'S OPPOSITION ARE IRRELEVANT TO THE ISSUES NOW BEFORE THE BOARD AND INFLAMMATORY

Applicant spends a considerable portion of its Opposition focusing on matters that are neither before the Board nor relevant to the issues before the Board. Considerable attention is paid to Applicant's contentions with respect to Opposer's discovery responses, or the testimony

(and objections) offered when Applicant deposed three of Opposer's witnesses. Suffice to say that Opposer disagrees with the characterizations offered by Applicant, and Applicant's attempt to distract from the motion to compel now pending before the Board. If and when these matters come before the Board, Opposer reserves the right to address them at that time, and will not waste the Board's time now with matters not germane to the motion to compel now pending.

V. CONCLUSION

For the reasons set forth herein, Opposer requests that the Board grant its motion to compel in its entirety.

Date: January 16, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that BUNDOO KHAN USA, LLC'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO COMPEL was served on Arrehman Arraheem Corporation at the email address of record below on January 16, 2024:

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