

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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March 26, 2024

Opposition No. 91276101
Cancellation No. 92080482

Bundoo Khan USA, LLC

v.

Arrehman Arraheem Corporation

Cancellation No. 92081962

Arrehman Arraheem Corporation

v.

Bundoo Khan USA, LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Bundoo Khan USA's ("Bundoo") motion (filed December 6, 2023) to compel discovery. 30 TTABVUE.¹ The motion has been fully briefed.

Opposition No. 91276101

Arrehman Arraheem Corporation ("Arrehman") seeks to register the standard character mark BUNDU KHAN KABAB HOUSE BEST BBQ JUST FOR YOU for

¹ TTABVUE citations in this order are to the Board file in Opposition No. 91276101, the parent case in these consolidated proceedings, unless otherwise noted.

“Restaurant and catering services” in International Class 43.² In the second amended notice of opposition, Bundoo opposes registration of that mark on the ground of false suggestion of a connection with Bundoo under Trademark Act Section 2(a), 15 U.S.C. § 1052(a). 20 TTABVUE. Arrehman, in its answer, denies the salient allegations of the second notice of opposition and asserts affirmative defenses. 28 TTABVUE.

Cancellation No. 92080482

Arrehman owns a registration for the standard character mark BINDU KHAN KABAB HOUSE for “Restaurant and catering services” in International Class 43.³ In the amended petition to cancel, Bundoo opposes registration of that mark on the ground of false suggestion of a connection with Bundoo under Trademark Act Section 2(a), 15 U.S.C. § 1052(a). Cancellation No. 92040482, 9 TTABVUE. Arrehman, in its answer, denies the salient allegations of the amended petition to cancel and asserts affirmative defenses. 29 TTABVUE.

Cancellation No. 92081962

Bundoo owns a registration for the mark MAK AL HAAJ BUNDOO KHAN for “[r]estaurant services, including sit-down service of food and take-out restaurant

² Application Serial No. 90327658, filed November 18, 2020, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging September 2, 2020 as the date of first use anywhere and of first use in commerce. The application includes a disclaimer of KABAB HOUSE.

³ Registration No. 4011592, issued August 16, 2011, based on an assertion of use in commerce under Trademark Act Section 1(a) and alleging August 6, 2004 as the date of first use anywhere and February 16, 2005 as the date of first use in commerce. The registration includes a disclaimer of KABAB HOUSE and statements that “[t]he wording ‘BUNDU KHAN’ has no meaning in a foreign language” and that “[t]he name ‘BUNDU KHAN’ does not represent and/or identify a particular living individual.”

services” in International Class 43.⁴ In the petition to cancel, Arrehman seeks cancellation of that registration on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), with its previously used marks BUNDU KHAN KABAB HOUSE and BUNDU KHAN KABAB HOUSE BEST BBQ JUST FOR YOU for “restaurant and catering services.” Cancellation No. 92081962, 1 TTABVUE. Bundoo, in its answer, denied the salient allegations of the petition to cancel and asserted affirmative defenses. Cancellation No. 92081962, 6 TTABVUE.

Motion to compel granted in part

By its motion to compel, Bundoo seeks further responses to interrogatory nos. 24 and 25 and production of documents responsive to document request nos. 11, 13 and 38. 30 TTABVUE 5-12. Bundoo further requests that Arrehman be compelled to produce documents responsive to document request nos. 1-3, 16, 18, 22, 25, 27-31, 35, 38-39, 41 and 46-48 immediately and not on a rolling basis. 30 TTABVUE 12. The Board finds as an initial matter that Bundoo made a good faith effort to resolve the parties’ discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(f)(1).

Arrehman asserts that Bundoo’s motion is intended to distract from its own discovery abuse in this case. 32 TTABVUE 5-6. However, each party has a duty to respond to an adversary’s discovery requests during the time allowed therefor under

⁴ Registration No. 6623887, issued January 18, 2022, based on an assertion of use in commerce under Trademark Act Section 1(a) and alleging November 11, 2021 as the date of first use anywhere and of first use in commerce. The registration includes a statement that the mark “has no meaning in a foreign language” and that “[t]he name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.”

the applicable rules, irrespective of that adversary's failure to respond to pending discovery requests. *See* TBMP § 403.03 (2023) and cases cited therein.

In interrogatory no. 24, Bundoo seeks a description of communications that Arrehman has had with the family of Bundoo Khan regarding Arrehman's use of the name Bundu Khan or Bundoo Khan. 30 TTABVUE 25. Arrehman objects to this interrogatory, asserting attorney-client and work product privileges. 30 TTABVUE 52. In interrogatory no. 25, Bundoo seeks information regarding communications between Arrehman and third parties concerning Arrehman's involved marks. 30 TTABVUE 25. Arrehman objects to this interrogatory, asserting attorney-client and work product privileges and identifies cease and desist letters that it has sent. 30 TTABVUE 53.

The information requested in these interrogatories is relevant to Bundoo's false suggestion of a connection claims and is therefore discoverable. *See* Fed. R. Civ. P. 26(b). In particular, such information goes to whether Bundu Khan or Bundoo Khan is connected with Arrehman's involved services under its involved marks. *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). Further, an identification of documents, as opposed to their substantive content, is not privileged. *See Goodyear Tire & Rubber Co. v. Tyrco Indus.*, 186 USPQ 207, 208 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975); TBMP § 414(1).

To the extent that Arrehman is withholding information based on a claim of privilege, a party withholding responsive documents on the basis of a claim of privilege must “(i) expressly make the claim; and (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed – and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.” Fed. R. Civ. P. 26(b)(5)(A)(i)-(ii); TBMP § 406.04(c). Although Fed. R. Civ. P. 26(b)(5) does not specify exactly how the party asserting privilege/protection must particularize its claim, parties in Board proceedings generally use privilege logs, which identify: (1) each document withheld, (2) an identification of the claimed privilege/protection, (3) the name of the persons making/receiving the communication, (4) the date and place of the communication, and (5) the document’s general subject matter. *See* TBMP § 406.04(c). Arrehman does not appear to have served a privilege log.

In its brief in opposition, Arrehman relies upon the common interest doctrine as a basis for withholding documents. 32 TTABVUE 3-4 and 6-8. The common interest doctrine or joint defense rule is an exception to ordinary waiver of privilege rules that allows attorneys for different clients pursuing a common legal strategy to communicate with each other.⁵ *See Waymo LLC v. Uber Techs., Inc.*, 870 F.3d 1350, 124 USPQ2d 1222, 1228 (Fed. Cir. 2017). Our primary reviewing court has stated

⁵ The parties rely largely on precedents from district courts and United States Courts of Appeal for circuits other than the Federal Circuit. The Board relies mainly on precedents of our primary reviewing court, the United States Court of Appeals for the Federal Circuit, and its own precedents because these precedents more specifically address registration issues. *See Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1506 n.2 (TTAB 2008).

that it is insufficient merely to demonstrate that a confidential communication took place between parties who alleged share a common interest. *See id.* Rather, to invoke the common interest doctrine, a party must demonstrate that the communications at issue: (1) are protected from disclosure by claim of privilege, and (2) were made in pursuit of common legal claims or defenses. *See id.* Bearing in mind that this proceeding is concerned solely with the registrability of the parties' marks and that no third-party marks are involved in these proceedings, Arrehman has failed to demonstrate that the communications at issue are part of a common defense. Accordingly, the Board finds that the common interest doctrine is inapplicable herein and Arrehman must serve amended substantive responses to these interrogatories.

In document request no. 11, Bundoo seeks documents evidencing communications between Arrehman and Habib Wanker relating to Bundoo. 30 TTABVUE 34. In document request no. 38, Bundoo seeks documents sufficient to show use of the involved mark on advertising, marketing and promotional materials. 30 TTABVUE 38. Arrehman's responses that it will produce non-privileged responsive documents are acceptable. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000); TBMP § 408.02 (“[A] proper written response to each request requires the responding party to state that there are responsive documents and that they either will be produced or will be withheld on a claim of privilege; to state an objection with appropriate reasons; or to state that no responsive documents exist.”). If Arrehman has not done so already, Arrehman is allowed until **thirty days** from the date of this order to produce documents responsive to these requests.

In document request no. 13, Bundoo seeks documents which contain contact information for customers of Arrehman's restaurants that are operated under Arrehman's involved marks. It is well settled that such information is not discoverable, even under seal. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (customer names not discoverable); TBMP § 414(3). Arrehman need not produce documents responsive to this request.

With regard to Arrehman's remaining document production herein, the Board notes that Bundoo served its discovery requests more than six months ago. Accordingly, Arrehman's document production in response to document request nos. 1-3, 16, 18, 22, 25, 27-31, 35, 38-39, 41 and 46-48 should be complete by now.⁶ If Arrehman has not done so already, Arrehman is allowed until **thirty days** from the date of this order to produce documents responsive to these requests.

In sum, the motion to compel is granted with regard to interrogatory nos. 24 and 25 and document request nos. 1-3, 11, 16, 18, 22, 25, 27-31, 35, 38-39, 41 and 46-48. Arrehman is allowed until **thirty days** from the date of this order to serve supplemental substantive responses to interrogatory nos. 24 and 25 and to complete its document production in response to document request nos. 1-3, 11, 16, 18, 22, 25, 27-31, 35, 38-39, 41 and 46-48.

⁶ Bundoo's assertion that Arrehman has not served a supplemental response to document requests wherein it states that its document production is complete is unpersuasive. 33 TTABVUE 7. No such supplemental response is required in Board proceedings. Rather, a statement that document production is complete may be handled informally. Further, document production in Board proceedings is subject to the estoppel sanction of Fed. R. Civ. P. 37(c)(1). *See* TBMP § 527.01(e).

Proceedings resumed

Proceedings are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	5/25/2024
Discovery Closes	6/24/2024
Pretrial disclosures due for Bundoo Khan USA as plaintiff in Opposition No. 91276101 and Cancellation No. 92080482	8/8/2024
30-day trial period ends for Bundoo Khan USA as plaintiff in Opposition No. 91276101 and Cancellation No. 92080482	9/22/2024
Pretrial disclosures due for Arrehman Arraheem as defendant in Opposition No. 91276101 and Cancellation No. 92080482 and as plaintiff in Cancellation No. 92081962	10/7/2024
30-day trial period ends for Arrehman Arraheem as defendant in Opposition No. 91276101 and Cancellation No. 92080482 and as plaintiff in Cancellation No. 92081962	11/21/2024
Pretrial disclosures of Bundoo Khan USA due for rebuttal as plaintiff in Opposition No. 91276101 and Cancellation No. 92080482 and as defendant in Cancellation No. 9181962	12/6/2024
30-day trial period ends for Bundoo Khan USA for rebuttal as plaintiff in Opposition No. 91276101 and Cancellation No. 92080482 and as defendant in Cancellation No. 9181962	1/20/2025
Pretrial disclosures due for rebuttal of Arrehman Arraheem as plaintiff in Cancellation No. 9181962	2/4/2025
15-day trial period ends for rebuttal of Arrehman Arraheem as plaintiff in Cancellation No. 9181962	3/6/2025
Opening brief for Bundoo Khan USA as plaintiff in Opposition No. 91276101 and Cancellation No. 92080482	5/5/2025
Combined brief for Arrehman Arraheem as defendant in Opposition No. 91276101 and Cancellation No. 92080482 and as plaintiff in Cancellation No. 92081962	6/4/2025
Combined rebuttal brief for Bundoo Khan USA as plaintiff in Opposition No. 91276101 and Cancellation No. 92080482 and as defendant in Cancellation No. 9181962	7/4/2025
Rebuttal brief for Arrehman Arraheem as plaintiff in Cancellation No. 92081962	7/19/2025
Request for oral hearing (optional) due	7/29/2025

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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing.

Note: Parties are strongly encouraged to check the entire document before filing.⁷ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

⁷ To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.