

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: June 5, 2017

Opposition No. 91232930

*Giorgio Armani S.p.A., Milan, Swiss Branch
Mendrisio*

v.

Young Carter

Benjamin U. Okeke, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a timely discovery and settlement conference on June 1, 2017. *See* TBMP § 401.01. At Opposer's request, a member of the Board participated in the conference. *See* Trademark Rule 2.120(a)(2)(i). Participating were Opposer's counsel Paolo A. Strino, Applicant's counsel Michael D. Stewart, and the assigned interlocutory attorney, Benjamin U. Okeke.

The Board apprised the parties of general procedural rules and guidelines that govern *inter partes* proceedings, including

- the Board's liberal granting of motions to suspend for settlement efforts,
- the requirement that a party serve its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) prior to serving discovery requests (*see* Trademark Rule 2.120(a)(3)),

- the requirement that a motion to compel initial disclosures must be filed within thirty days after the deadline therefor (*see* Trademark Rule 2.120(f)(1)),
- the requirement that a motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset (*see* Trademark Rule 2.120(f)(1)), and
- the requirement that a motion for summary judgment must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset (*see* Trademark Rule 2.127(e)(1)).

Standard Protective Order

The Board also reminded the parties that its Standard Protective Order is automatically applicable to this proceeding pursuant to Trademark Rule 2.116(g). The standard protective order is online at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

Although they are not required to do so, the parties may elect to exchange executed copies of the order. If the parties wish to modify the order in any manner, they must file a motion for the Board's approval of the modification(s).

Pleadings

The Board reviewed the pleadings with the parties:

A. Notice of Opposition

Giorgio Armani S.p.A., Milan, Swiss Branch Mendrisio ("Opposer"), opposes registration of the following mark:



in Application Serial No. 87017841 (“the ’841 application”), filed by Young Carter (“Applicant”), for use in connection with “boxer briefs; boxer shorts; denim jackets; denims; hats; long-sleeved shirts; shorts; shorts for adults only; sneakers; sweaters for adults only; t-shirts for adults only; tank-tops; basketball sneakers; clothing for athletic use, namely, padded shorts; crew neck sweaters; fight shorts for mixed martial arts or grappling; fleece shorts; panties, shorts and briefs; short-sleeved or long-sleeved t-shirts; underwear, namely, boy shorts; v-neck sweaters; walking shorts,” in International Class 25.¹ By way of its notice of opposition, Opposer alleges that registration should be denied based upon a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution under Section 43(c), 15 U.S.C. § 1125.

- *Standing*

Opposer alleges that it owns Registration No. 3362601 for the following design mark:



1 TTABVue 8-9, ¶ 7. The allegation of Opposer’s ownership of its registration is sufficient to plead Opposer’s standing to bring this opposition against the ’841 application. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d

¹ The application was filed April 28, 2016, under Trademark Act Section 1(b), 15 U.S.C. 1051(b), alleging Applicant’s intent to use the mark in commerce.

² Issued January 1, 2008, from an application filed September 29, 2005, for “clothing, namely, shirts, shorts, hats, skirts, pants, jackets; headgear, namely, caps, hats, beanies, visors; footwear,” in International Class 25. Opposer’s combined Declaration of Use and Incontestability was accepted and acknowledged on December 16, 2014.

1058 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Moreover, Opposer's submission of a copy of its pleaded registration record from the Trademark Status and Document Retrieval database ("TSDR"), showing the current status and title of the registration establishes Opposer's standing to bring this action. 1 TTABVUE 12-17.

Opposer also claims common law usage of its design mark with "a variety of products, including but not limited to haute couture, ready-to-wear, leather goods, shoes, watches, jewelry, accessories, eyewear, cosmetics and home interiors." 1 TTABVUE 5, ¶ 7. However, if Opposer wishes to rely on prior use of its design mark at common law, it must amend its notice of opposition to provide fair notice of its intent to so rely by identifying each mark claimed and the goods and services being claimed for use in connection with those marks. *See* TBMP § 506.01 (Jan. 2017) (purpose of pleadings is to provide fair notice of the claims and defenses asserted). *See* Fed. R. Civ. P. 15(a); TBMP § 507. Opposer's use of the phrases "... above-listed trademarks ...," "... variety of products ..." and "... including but not limited to ..." in identifying goods, services, and marks for which it is claiming prior use in paragraph 7 are inappropriate because they are not all-inclusive. *See id.*

- *Priority*

As previously noted, Opposer attached a copy of its registration record from the TSDR database showing current status and title of its pleaded registration. By properly making its pleaded registration of record, Opposer has removed Section 2(d)

priority as an issue in this proceeding as to its pleaded registered mark and the goods covered by that registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

- *Likelihood of Confusion*

Paragraphs 9 and 11-12 of the notice of opposition allege sufficient facts that if proven would entitle Opposer to the relief it seeks under Trademark Act Section 2(d). That is, Opposer has alleged the similarity of the applied-for mark with its registered and previously used mark and the relatedness of the goods covered by those marks.³ 1 TTABVUE 5-6, ¶¶ 9 and 11-12. Opposer concludes that registration of Applicant's mark is "likely to cause confusion, to cause mistake, and to deceive the trade and public, who is likely to believe that Armani is the source of Applicant's products or that such products are approved, endorsed, sponsored, produced under license, or somehow associated with Opposer." *Id.* at 6, ¶ 12.

- *Dilution*

Opposer's allegations also sufficiently plead a claim of dilution. Paragraphs 16 and 17, when read in conjunction with the previous paragraphs of the notice of opposition, allege sufficient facts to support a claim of dilution under Section 43(c) of the Trademark Act.⁴

³ To state a claim of likelihood of confusion under Trademark Act Section 2(d), Opposer must merely allege facts from which it may be inferred that Applicant's applied-for mark so resembles Opposer's previously used or registered marks that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the parties' goods and services. *See* 15 U.S.C. § 1052(d); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01.

⁴ A claim of dilution under Section 43(c) of the Trademark Act requires allegations that: (1) opposer's distinctive mark would be blurred or tarnished by use of applicant's similar mark; (2) opposer's mark is famous; and (3) opposer's mark became famous prior to the earliest date of use (or constructive use)

A. Answer

In its answer, Applicant denied the salient allegations of the notice of opposition, except that Applicant admitted Opposer's ownership of the pleaded registration, Opposer's priority of use, and the relatedness of the goods. 5 TTABVUE 2, ¶ 1. Additionally, Applicant pleaded the following five "affirmative defenses": 1) the commercial impression of the marks is different; 2) there are numerous third-party marks similar to Opposer's "Eagle-design" that currently coexist; 3) failure to police; 4) Opposer's mark is not famous; and 5) Opposer's mark does not serve to indicate source. *Id.* at 2-3, ¶¶ 4-8.

The Board, in its discretion, may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *Am. Vitamin Prods., Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *W. Worldwide Enters. Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990). Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). A party must allege sufficient facts beyond a tender of 'naked

that can be claimed by applicant. *See* 15 U.S.C. 1125(c); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001).

assertion[s]’ devoid of ‘further factual enhancement,’ to support its claims. *Cf. Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

Applicant’s unexplained fifth affirmative defense, merely alleging that “Opposer’s mark, by itself, does not serve to indicate the source of the goods to consumers,” does not aver any further factual matter to support that claim. Therefore, this affirmative defense is insufficiently pleaded and is accordingly **STRICKEN** from the answer.

Similarly, Applicant’s defense alleging that Opposer has failed to police its mark lacks any factual support in the pleading.⁵ Therefore, it has also been insufficiently pleaded and is accordingly **STRICKEN** from the answer.

Applicant’s first, second and fourth “affirmative defenses” are not actual affirmative defenses, but are merely amplifications of Applicant’s denials, and provide fuller notice of how Applicant intends to defend this opposition. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). While these are not appropriate affirmative defenses, the Board does not find it necessary to strike this language from the answer.

⁵ Under Trademark Act Section 45(2), 15 U.S.C. § 1127, a mark is deemed to be abandoned when the course of conduct of the owner of the mark causes the mark to lose its significance as an indication of origin. *See Woodstock’s Enter. Inc. (Cal.) v. Woodstock’s Enter. Inc. (Or.)*, 43 USPQ2d 1440, 1445-46 (TTAB 1997). *Cf. Univ. Book Store v. Univ. of Wis. Board of Regents*, 33 USPQ2d 1385, 1393 (TTAB 1994) (citing *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 336 (CCPA 1982) (“If there are numerous products in the marketplace bearing the alleged mark, purchasers may learn to ignore the ‘mark’ as a source indication. When that occurs, the conduct of the former owner, by *failing to police its mark*, can be said to have caused the mark to lose its significance as a mark.”)) (emphasis added).

With regard to an abandonment claim based on “failure to police,” Applicants must plead facts that show a course of conduct by Opposer that has caused its mark to lose its trademark significance. *Tbc Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) (citing *Colgate-Palmolive Co. v. Colton Razor Blade Co.*, 153 USPQ 370 (TTAB 1966)).

It is the Board's policy to allow amendment of pleadings found to be insufficient upon challenge. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997). In view of the unclear nature of the defenses being advanced in Applicant's third and fifth affirmative defenses, Applicant is allowed until **FIFTEEN DAYS** from the mailing date of this order to submit an amended answer repleading the third and fifth "affirmative defenses," if possible, justified and appropriate.⁶ If Applicant fails to file an amended answer within the time allowed, these defenses will stand stricken with prejudice and will be given no further consideration. The proceeding would then go forward as to the operative pleadings, absent Applicant's affirmative defenses stricken by this order.

Filings/Resources

Parties are now required to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA), available online at: <http://estta.uspto.gov>. *See* Trademark Rule 2.126(a). In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. *See* Trademark Rule 2.126(b).

Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure, online at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

⁶ Applicant is again cautioned to carefully consider the efficacy of maintaining these defenses and accompanying allegations.

The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, available online at: <http://www.law.cornell.edu/rules/frcp/>.

Accelerated Case Resolution (ACR)

The Board briefly explained the availability of and features of the “accelerated case resolution” (“ACR”) process. For further information, the Board refers the parties to TBMP §§ 528.05(a)(2), 702.04 and 705, as well as the link on the Board’s web page to a vast amount of ACR information and exemplary ACR proceedings.

The Board believes that the relevant facts of this proceeding are uncomplicated, and that the issues to be resolved are relatively narrow. Therefore, it appears that this matter is well suited for resolution by ACR. Therefore, the Board encourages the parties to discuss a modified proceeding and schedule that may be more time and cost efficient. In modifying the proceeding, the parties may seek to:

- 1) stipulate to facts, *e.g.* Opposer’s standing, priority, the relatedness of the goods, etc.;
- 2) limit the number of interrogatories, document requests, and depositions allowed during the proceeding;
- 3) stipulate to the amount of days after service of responses to document requests that the responding party would have to actually produce and serve any responsive documents;
- 4) stipulate that discovery depositions may be taken by telephone or video conference;
- 5) stipulate to forego any oral testimony at trial, submitting all testimony in the form of affidavits or declarations; or

- 6) stipulate to forego trial and oral hearing and submit the case for decision on briefs in summary judgment format accompanied by any evidence, which may be submitted in the form of declarations or affidavits, and stipulate that the Board may resolve any genuine disputes of material fact and issue a final ruling based on the parties' ACR submissions.

The parties are directed to review the Board's website regarding ACR at:

http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp; and

http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution__ACR__notice_from_TTAB_webpage_12_22_11.pdf.

If the parties agree to pursue ACR after exchange of disclosures or discovery (or wish to further discuss their options), they should notify the interlocutory attorney, preferably within **SIXTY DAYS** from the opening of the discovery period.

Contested Motions

The parties are reminded that uncooperative behavior during the discovery process will not be well-taken. *See HighBeam Mktg. LLC v. Highbeam Research LLC*, 85 USPQ2d 1902 (TTAB 2008); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving discovery issues). The Board requires the parties to make a good-faith effort to resolve all discovery issues prior to filing a motion to compel seeking relief from the Board.⁷ *See* TBMP § 408.01(c).

Similarly, the parties should confer before filing any motion to extend or suspend this proceeding. If either party files an unconsented motion to extend or suspend in

⁷ Prior to filing any such motion to compel the parties should first contact the assigned interlocutory attorney by telephone at 571-270-1524 to schedule a telephone conference. The parties should be prepared to discuss the "good faith effort" that has been made to resolve any discovery disputes prior to seeking the Board's intervention.

this case, the moving party must promptly contact the Board interlocutory attorney assigned to the case by telephone upon filing so that such motion can be resolved by telephone conference.⁸

Schedule

The parties were reminded that the next significant due date is **June 15, 2017, when the parties' initial disclosures are due.** See Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) regarding required initial disclosures. Neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) should occur until the parties have exchanged their initial disclosures as required by Fed. R. Civ. P. 26(f). See Trademark Rules 2.120(a)(3) and 2.127(e)(1).

The Board again thanks the parties for their participation in the conference. As a final matter, the Board reminds the parties of their duty to conduct themselves with decorum and courtesy and encourages open communication between the parties during this proceeding. Trademark Rule 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

The remaining disclosure, discovery, and trial dates are reset as follows:

Initial Disclosures Due	June 15, 2017
Expert Disclosures Due	October 13, 2017
Discovery Closes	November 12, 2017
Plaintiff's Pretrial Disclosures Due	December 27, 2017
Plaintiff's 30-day Trial Period Ends	February 10, 2018
Defendant's Pretrial Disclosures Due	February 25, 2018
Defendant's 30-day Trial Period Ends	April 11, 2018

⁸ Patent and Trademark Rule 1.2, 37 C.F.R. § 1.2, which requires all business with the USPTO be transacted in writing, is waived to the extent that Board attorneys or judges may accept from parties, or direct parties to present, oral recitations of procedural facts and presentations of argument.

Plaintiff's Rebuttal Disclosures Due	April 26, 2018
Plaintiff's 15-day Rebuttal Period Ends	May 26, 2018
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	July 25, 2018
Defendant's Main Brief Due	August 24, 2018
Plaintiff's Reply Brief Due	September 8, 2018

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD ("BOARD") RULES OF PRACTICE WILL BE EFFECTIVE JANUARY 14, 2017

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7, 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and *ex parte* appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website: <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule: <http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule: <http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>

- A chart summarizing the affected rules and changes:
<http://www.uspto.gov/sites/default/files/documents/Chart%20Summarizing%20Rule%20Changes%2012-9-16.pdf>

For all proceedings, including those **already in progress on January 14, 2017,**

some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.

- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.