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

Proceeding	91266269
Party	Plaintiff Pai Skincare Limited
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Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Erik J. Osterrieder
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Date	12/02/2020
Attachments	First Amended Notice of Opposition.pdf(60142 bytes) Exhibit.pdf(21610 bytes)

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

PAI SKINCARE LIMITED,	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91266269
	§	
TARA BRANDS, LLC,	§	
Applicant.	§	Ser. No. 88/666,964
	§	Mark: FAI
	§	Pub. for Opp. Date: August 4, 2020

FIRST AMENDED NOTICE OF OPPOSITION

Opposer Pai Skincare Limited (“Pai”), through its undersigned attorney, timely files this Amended Notice of Opposition (“Notice”) as of right in order to oppose registration of FAI by Applicant Tara Brands, LLC (“Applicant” or “Tara Brands”), wherein FAI is the subject of Application No. 88/666,964 (“the ‘964 Application”), which is currently under an extension of time to oppose until December 2, 2020 that was timely filed by Pai on August 28, 2020, in order to correct a typo in the original notice of opposition’s prayer.

FACTS

1. Opposer is Pai Skincare Limited, d/b/a Pai Skincare and Pai, a private limited company organized under the laws of the United Kingdom, and having an associated address of 18 Colville Road, London, England, W3 8BL, United Kingdom. Pai was incorporated on July 26, 2006.

2. Applicant is Tara Brands, LLC, a private limited company organized under the laws of the Delaware, and having an associated address of 155 North Wacker Drive, Suite 4250, Chicago, IL 60606.
3. 155 North Wacker Drive, Suite 4250, Chicago, IL 60606 is not Applicant's principal place of business (*i.e.*, headquarters) where senior executives or officers ordinarily direct and control the entity's activities.
4. Applicant has applied to register FAI as a trademark used in association with "personal care products, namely, hair care preparations, hair styling preparations, non-medicated skin care preparations, non-medicated toiletries, fragrances and perfumery" in international class 003.
5. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, hair care preparations.
6. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, hair styling preparations.
7. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, non-medicated skin care preparations.
8. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, non-medicated toiletries.
9. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, fragrances.
10. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, perfumery.
11. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, hair care preparations prior to March 1, 2009.

12. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, hair styling preparations prior to March 1, 2009.
13. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, non-medicated skin care preparations prior to March 1, 2009.
14. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, non-medicated toiletries prior to March 1, 2009.
15. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, fragrances prior to March 1, 2009.
16. Applicant has not used FAI as a trademark in US commerce in association with personal care products, namely, perfumery prior to March 1, 2009.
17. Applicant is a company formed October 24, 2016.
18. Applicant is an inactive company and/or not in good standing with the State of Delaware.
19. Applicant has had less than \$10,000 in gross sales for FAI-branded goods in the US.
20. Applicant has had less than \$100,000 in gross sales for FAI-branded goods in the US.
21. Applicant has had less than \$10,000 in gross sales for FAI-branded goods throughout the world.
22. Applicant has had less than \$100,000 in gross sales for FAI-branded goods throughout the world.
23. Applicant is not the owner of the FAI mark under application.
24. In the US, Opposer owns and uses trademark registration number 4683780 for the PAI word mark that is associated with the following international class 003 goods: cosmetics; non-medicated skin care preparations, namely, creams, lotions, and gels; non-medicated skin care preparations; non-medicated cosmetic sun protective lotions, creams and preparations for the

skin; skin cleansing and moisturizing creams, oils, and lotions; soaps, namely, hand soap, body soap, beauty soap, liquid soap, body wash containing soap; body powder; after-shave lotion; non-medicated sun tanning, sun screen and sun care creams, gels, oils, lotions and preparations; after sun preparations, namely, creams, gels, oils and lotions; skin bronzing and skin coloring preparations, namely, creams, gels, oils and lotions; anti-sunburn preparations not for medical purposes; non-medicated ointments for prevention and treatment of sunburns; soaps; bath gel; essential oils; lotions, creams and non-medicated preparations for care of the face, feet, body, scalp, nails and hair; non-medicated bath preparations; shaving preparations; skin cleansers; skin toners; antiperspirants; personal deodorants; make-up; concealers for spots and blemishes; foundation make-up base; face powder; mascara; eyebrow pencils; eye shadow; liquid eyeliner; blushers; eyeliner pencils; skin bronzers; lipstick; lip liner pencils; lip gloss; hair conditioner; hair shampoo; hair care preparations; hair coloring preparations; hair spray; eye care preparations, namely, eye cream and gel eye masks; non-medicated depilatory and exfoliating preparations, namely, creams; nail care preparations; nail strengtheners; nail creams; nail varnish for cosmetic purposes; nail varnish remover; artificial nails; cotton wool, namely, balls for cosmetic purposes; massage oils; essential oils for use in aromatherapy oils; ethereal oils; aromatherapy oils, namely, essential oils for aromatherapy use; fragrances and perfumery; sachets and colognes; room fragrances; fragrance room sprays; potpourri; incense.

25. In the US, Opposer owns and uses trademark registration number 4683780 for a PAI logo that is associated with the following international class 003 goods: soaps, namely, hand soap, body soap, beauty soap, liquid soap, body wash containing soap; cosmetics, namely, lotions, creams, gels and preparations for moisturizing the skin, cosmetic sun protective

lotions, creams and preparations for the skin; skin cleansing and moisturizing creams, oils, lotions and preparations; essential oils; lotions, creams and preparations for cosmetic care of the face, feet, body, facial cleansers, toners; concealers for spots and blemishes for skin, face, body; hair conditioner; shampoo; cosmetic eye care preparations; massage oils; aromatherapy oils, namely, essential oils for aromatherapy use.

26. Repeating and incorporating paragraphs 24 and 25, one or both of Opposer's registered marks were used prior to Applicant's alleged mark in the '964 Application.
27. Repeating and incorporating paragraphs 24 and 25, Applicant's alleged mark in the '964 Application is likely to be confused with one or both of Opposer's registered marks.
28. Opposer has used PAI as a trademark in the US as a mark associated with hair care preparations in international class 003 one or more years prior to Applicant's use of and application for registration of its alleged mark, FAI.
29. Opposer has used PAI as a trademark in the US as a mark associated with hair styling preparations in international class 003 one or more years prior to Applicant's use of and application for registration of its alleged mark, FAI
30. Opposer has used PAI as a trademark in the US as a mark associated with non-medicated skin care preparations in international class 003 one or more years prior to Applicant's use of and application for registration of its alleged mark, FAI
31. Opposer has used PAI as a trademark in the US as a mark associated with non-medicated toiletries in international class 003 one or more years prior to Applicant's use of and application for registration of its alleged mark, FAI

32. Opposer has used PAI as a trademark in the US as a mark associated with fragrances in international class 003 one or more years prior to Applicant's use of and application for registration of its alleged mark, FAI.
33. Opposer has used PAI as a trademark in the US as a mark associated with perfumery in international class 003 one or more years prior to Applicant's use of and application for registration of its alleged mark, FAI.
34. Opposer owns trademark registrations for PAI in association with personal care products in international class 003 on all continents except Antarctica.
35. PAI and FAI are similar in appearance, sound, connotation and/or commercial impression.
36. FAI has no meaning when translated into English from another language.
37. PAI and FAI are associated with identical or similar goods in international class 003.
38. PAI and FAI goods have similar established, likely-to-continue trade channels.
39. The conditions under which and buyers to whom the sales are made are similar for PAI and FAI goods.
40. Opposer's mark, PAI, is famous at least in the US.
41. Before applying to register FAI in the US for personal care products in international class 003, Applicant knew about the existence of the PAI brand.
42. As of the filing of this Notice, there are no FAI-branded products at any webpages at <https://taraformula.com/>.
43. As of the filing of this Notice, there have never been any FAI-branded products at <https://taraformula.com/>.
44. The mark under the registration has not acquired distinctiveness as of this Notice's filing date.

45. The co-existence in the United States of Opposer's use of PAI and Applicant's use of FAI for personal care products creates a likelihood of confusion for one or more customers as to whether Opposer or Applicant is the source of said goods.
46. Applicant knows of at least one instance of actual confusion by a person as a result of Opposer's use of PAI and Applicant's use of FAI as marks for any type of personal care products.
47. One or more trademark searches were conducted before Applicant applied to register its alleged mark, FAI.
48. Trademark search results have been provided and/or discussed with Applicant before it applied to register its alleged mark, FAI.
49. One or more opinions, whether verbal or written, were provided to Applicant before it applied to register its alleged mark, FAI.
50. Applicant files federal income taxes in the United States.
51. Applicant knew Opposer used PAI for personal care products before it applied to register its alleged mark, FAI.
52. In the '964 Application, Nawaf Arhamah swore to the declarations therefor.
53. On October 24, 2019, Nawaf Arhamah swore under 18 U.S.C. § 1001 that "applicant is entitled to use the mark in commerce" at the time of filing the application for registration of FAI.
54. On October 24, 2019, Nawaf Arhamah swore under 18 U.S.C. § 1001 that "applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application" for registration of FAI.

55. On October 24, 2019, Nawaf Arhamah swore under 18 U.S.C. § 1001 that “applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application as of the application filing date” of the application for registration of FAI.
56. On October 24, 2019, Nawaf Arhamah swore under 18 U.S.C. § 1001 that “[t]o the best of the signatory’s knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive” at the time of filing the application for registration of FAI.
57. On October 24, 2019, Nawaf Arhamah swore under 18 U.S.C. § 1001 that “[t]o the best of the signatory’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support” at the time of filing the application for registration of FAI.
58. With regard to any of paragraphs 53-57, Applicant knew that Opposer used PAI as a mark for personal care products.
59. With regard to any of paragraphs 53-57, there was no reasonable inquiry to support Applicant’s allegations and other factual contentions made in the application for the registration of FAI.
60. With regard to any of paragraphs 53-57, Nawaf Arhamah made one or more false declarations.
61. The application was filed through with one or more fraudulent misrepresentation(s) made to the USPTO.

62. Applicant has not possessed a bona fide intention to use FAI at all times beginning at the filing of the application to register FAI through the filing date of this Notice.
63. Opposer asserts that Applicant knowingly committed fraud on the USPTO through its assertion of facts in the application underlying the registration for the alleged mark in regard to Applicant's right to apply for the alleged mark and/or its stated intention to use of the purported mark. With intent to deceive at least insofar as, but not limited to, believing that a likelihood of confusion would result by Applicant's use of the alleged mark in view of Opposer's earlier use of a confusingly similar mark or having no rational belief for believing otherwise, and in knowing Opposer's earlier use and superior rights in a confusingly similar mark with intent to procure a registration to which it is not entitled, Applicant fraudulently represented in its application that Applicant: possessed the right to apply for the alleged mark, FAI; intended to use the alleged mark in commerce on all the goods stated in the registration's underlying application; conducted an inquiry reasonable under the circumstances, that the allegations and other factual contentions made in its application have evidentiary support; and/or when used on or in connection with the alleged goods, that no other person, firm, corporation (*e.g.*, Opposer) or association has the right to use the alleged mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.
64. Opposer was using a confusingly similar mark, *i.e.*, PAI, as compared to FAI in association with providing personal care products in U.S. commerce prior to and at the time Applicant signed its oath for its alleged mark, FAI. Furthermore, through its prior use on the same

goods, Opposer had and has superior rights in a confusingly similar mark as compared to Applicant.

65. At the time that Applicant signed its oath for its alleged mark, FAI, Applicant knew that Opposer had superior rights in a confusingly similar mark for at least some of the same goods as compared to Applicant. Furthermore, and as a result of this knowledge, Applicant either believed that a likelihood of confusion would result from Applicant's use of FAI or had no reasonable basis for believing otherwise.

66. Applicant, in failing to disclose the beliefs and/or facts supporting these beliefs found at least at paragraphs 64 and 65 herein, which are incorporated herein by this reference, intended to procure a registration for FAI to which it is not entitled.

67. By service of this Notice, Applicant has received Opposer's spoliation/preservation letter. Exhibit.

Counts

Count One – Likelihood of Confusion Under Section 2(d)

68. Incorporating by this reference any and all other paragraphs herein, Applicant's alleged mark, FAI, is likely to be confused, under Section 2(d), with Opposer's mark, PAI, and, therefore, Pai requests that the Board refuse registration of FAI.

Count Two – Fraudulent Assertion of False Facts in the Application Underlying the Application Regarding Its Alleged Right to Apply for and to Seek Registration for and Use of the Alleged Trademark

69. Incorporating by this reference any and all other paragraphs herein, Applicant knowingly committed one or more acts of fraud on the USPTO through its assertion of alleged facts in its application through its alleged right to apply for and/or register the alleged mark, FAI.

Count Three – No Bona Fide Intent to Use the Alleged Mark

70. Incorporating by this reference any and all other paragraphs herein, Applicant did not have a bona fide intention to use the alleged mark, FAI, at the time of filing the application and/or during prosecution for any or all of the goods of record.

PRAYER

WHEREFORE, because Pai Skincare Limited, d/b/a Pai Skincare and Pai, will be damaged by registration of Applicant's alleged mark under this opposition, Pai respectfully requests that the Board refuse registration of FAI.

Respectfully submitted,

Dated: December 2, 2020

By: /Erik J. Osterrieder/
Erik J. Osterrieder
Rao DeBoer Osterrieder, PLLC
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ATTORNEY FOR OPPOSER

CERTIFICATE OF TRANSMISSION

This is to certify that a true and correct copy of the foregoing **FIRST AMENDED NOTICE OF OPPOSITION** was transmitted, via ESTTA, to the Trademark Trial and Appeal Board, on the date of signing below:

Dated: December 2, 2020

/Erik J. Osterrieder/
Erik J. Osterrieder
Rao DeBoer Osterrieder, PLLC
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Houston, TX 77043
(281) 372-6114
erik@rdoip.com
ATTORNEY FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **FIRST AMENDED NOTICE OF OPPOSITION** was served via email on Applicant at:

Brian P. Kinder: bkinder@tklglaw.com

Dated: December 2, 2020

/Erik J. Osterrieder/
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Opposer,	§	
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v.	§	
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TARA BRANDS, LLC,	§	
Applicant.	§	Ser. No. 88/666,964
	§	Mark: FAI
	§	Pub. for Opp. Date: August 4, 2020

Our law firm represents Pai Skincare Limited in this opposition proceeding in which Tara Brands, LLC is applicant. This letter, provided to you as an exhibit to the original Notice of Opposition through service by the TTAB, requests your immediate action to preserve electronically stored information that may contain evidence important to the above legal matter.

This notice applies to you and your company's on- and off-site computer systems and removable electronic media plus all computer systems, services, and devices (including all remote access and wireless devices) used for your [company's] overall operation. This includes, but is not limited to, e-mail and other electronic communications; electronically stored documents, records, images, graphics, recordings, spreadsheets, databases; calendars, system usage logs, contact manager information, telephone logs, internet usage files, deleted files, cache files, user information, and other data. Further, this notice applies to archives, backup and disaster recovery tapes, discs, drives, cartridges, voicemail and other data. All operating systems, software, applications, hardware, operating manuals, codes, keys and other support information needed to fully search, use, and access the electronically stored information must also be preserved.

The importance of immediate action cannot be overstated. Electronically stored information is easily corrupted, altered, and deleted in normal daily operations. Even booting a drive, running an application, or reviewing a document can permanently alter evidence. An important method for preserving data in its original state is to have a forensic image (mirror image or clone image) made of pertinent hard drives of both office and home computers used for business and of network servers. This image captures all current data, including the background or metadata about each document. Simply copying data to a CD-ROM or other common backup medium is not adequate. For each captured image file, record and identify the person creating the image and the date of creation. Secure the file to prevent subsequent alteration or corruption and create a chain of custody log. Once the forensic data image file is created, the pertinent computer or other device can be placed back into operation.

This preservation notice covers the foregoing items and all information related thereto.

Current law and rules of civil procedure clearly apply to the discovery of electronically stored information just as they apply to other evidence, and confirm the duty to preserve such information for discovery. You and your company's officers, employees, agents, and affiliated organizations must take all reasonable steps to preserve this information until this legal matter is finally resolved. Failure to take the necessary steps to preserve the information addressed in this letter or other pertinent information in your possession or control may result in serious sanctions.

Further, to properly fulfill your preservation obligation, stop all scheduled data destruction, electronic shredding, rotation of backup tapes, and the sale, gift or destruction of hardware. Notify all individuals and affiliated organizations of the need and duty to take the necessary affirmative steps to comply with the duty to preserve evidence.

Sincerely,

Dated: December 2, 2020

/Erik J. Osterrieder/

Erik J. Osterrieder

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