

ESTTA Tracking number: **ESTTA1186923**

Filing date: **01/26/2022**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer information

Name	Retail Royalty Company
Granted to date of previous extension	01/26/2022
Address	101 CONVENTION CENTER DRIVE LAS VEGAS, NV 89109 UNITED STATES
Attorney information	SETH A. WALTERS SAUNDERS & SILVERSTEIN LLP 14 CEDAR STREET, SUITE 224 AMESBURY, MA 01913 UNITED STATES Primary email: trademarks@sandsip.com Secondary email(s): swalters@sandsip.com +1.978.463.0110
Docket no.	1139.799.55

Applicant information

Application no.	90332530	Publication date	09/28/2021
Opposition filing date	01/26/2022	Opposition period ends	01/26/2022
Applicant	Balance Athletica, LLC 5303 HAVANA STREET, #150 DENVER, CO 80239 UNITED STATES		

Goods/services affected by opposition

Class 025. First Use: 2018/08/00 First Use In Commerce: 2018/08/00 All goods and services in the class are opposed, namely: Bottoms as clothing; Capri pants; Leggings; Pants; Shorts; Tights; Athletic bottoms; Athletic pants; Athletic shorts; Athletic tights; Crop pants; Gym pants; Gym shorts; Jogging pants; Lounge pants; Sports pants; Stretch pants; Yoga pants

Grounds for opposition

The mark comprises matter that, as a whole, is functional	Trademark Act Section 2(e)(5)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)

Attachments	20220126 RRC Notice of Opposition Balance Athletica As Filed.pdf(622497 bytes)
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Signature	/Seth A. Walters/
Name	SETH A. WALTERS
Date	01/26/2022

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

RETAIL ROYALTY COMPANY,

Opposer,

v.

BALANCE ATHLETICA, LLC,

Applicant.

Opposition No. _____



Mark:

Serial No.: 90/332,530

Filing Date: November 20, 2020

NOTICE OF OPPOSITION

Opposer Retail Royalty Company, a Nevada corporation with an address at 101 Convention Center Drive, Las Vegas, Nevada 89109 (“Opposer”), believes that it will be damaged by the registration of the above-identified design (hereinafter, the “Y-Stitching Design”), which is the subject of Application Serial No. 90/332,530, filed by Balance Athletica, LLC, a Colorado limited liability company with an address at 5303 Havana Street, #150 Denver, Colorado 80239 (“Applicant”), and opposes the same.

As grounds for its Opposition, Opposer alleges the following, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

Opposer and Opposer’s Use of Stitching Designs in Connection with Apparel

1. Opposer, together with its affiliated companies, owns the leading lifestyle brands AMERICAN EAGLE OUTFITTERS and AERIE. Opposer is a leading provider of a broad range of clothing, accessories, and other goods and services relating to the apparel, lifestyle, sports, fitness, and fashion industries. In addition to designing, marketing, and selling its clothing, accessory, and

other products, Opposer also operates hundreds of brick-and-mortar retail apparel and lifestyle stores and an incredibly popular online e-commerce platform at <ae.com>.

2. Opposer has long used and continues to use a variety of stitching designs on its apparel products, including various stitching designs along the rear, yoke, and rise of bottoms, including, *inter alia*, pants, leggings, and shorts.

3. For example, Opposer currently markets and sells a wide variety of leggings and shorts which feature stitching designs along the rear, yoke, and rise of the garments, as demonstrated in the below representative product images.



Representative images of Opposer's products featuring prominent stitching designs along rear, yoke, and rise

Third-Party Uses of Stitching Designs in Connection with Apparel

4. A significant number of third-party entities also commonly use similar stitching designs for functional, aesthetic, and/or ornamental purposes on bottoms, including stitching along the rear, yoke, and rise of pants, leggings, and shorts.

5. Shown below is a small sampling of representative examples of third-party uses of stitching designs similar to the Y-Stitching Design in connection with bottoms, including pants, leggings, and shorts, available for sale from a wide variety of retailers and brands such as Nike, Gymshark, and Fabletics, to name a few.



Bombshell Sportswear



Gymshark



Flamingo



Konquer All



Astoria Activewear



Intus Apparel



Born Primitive



Ryderwear



Fabletics



Nike



Jed North



Kor Fitness



ChicMe



Don't Sweat It Babe



Applicant’s Attempt to Register the Y-Stitching Design

6. On November 20, 2020, Applicant filed U.S. Application Ser. No. 90/332,530 to register the Y-Stitching Design (reproduced below) for “Bottoms as clothing; Capri pants; Leggings; Pants; Shorts; Tights; Athletic bottoms; Athletic pants; Athletic shorts; Athletic tights; Crop pants; Gym pants; Gym shorts; Jogging pants; Lounge pants; Sports pants; Stretch pants; Yoga pants” in International Class 25 (the “Application”).



Y-Stitching Design
U.S. Appln. Ser. No. 90/332,530

7. Applicant alleges a date of first use and a date of first use in commerce of at least as early as August of 2018.

8. The Application describes the Y-Stitching Design as follow: “The mark consists of a stitching design that forms a central vertical line that extends up the rear area of a garment and splits into two lines that extend up and curve outward toward opposing sides of the garment near the waist area forming a “Y” shape. The dotted and broken lines are not part of the mark and serve only to show the position of the mark on the goods.”

9. On February 23, 2021, the United States Patent and Trademark (“USPTO”) Examining Attorney who examined the Application issued it a first Nonfinal Office Action (the “Office Action”) under Sections 1, 2, and 45 of the Lanham Act because the Y-Stitching Design as used on the specimen of record “is merely a decorative or ornamental feature of applicant’s clothing and, thus, does not function as a trademark to indicate the source of applicant’s clothing and to identify and distinguish applicant’s clothing from others.”

10. As the Examining Attorney found in initially refusing registration, the Y-Stitching Design is a “design consisting of three curved lines forming an overall “Y” shape, located directly on the upper back of a pair of leggings where stitching customarily appears.” In addition to appearing in a location in which it is customary for third-party designers, manufacturers, and retailers of clothing bottoms to place similar stitching designs, the Y-Stitching Design “is displayed in a relatively large size on the clothing such that it dominates the overall appearance of the goods” and consists solely of “stitching that is used in a merely decorative manner that would be perceived by consumers as having little or no particular source-identifying significance.” The Examining Attorney also found that the Y-Stitching Design “appears incapable of functioning as a source-identifier for applicant’s goods” and, as a result, concluded that “neither an amendment under Trademark Act Section 2(f) nor an amendment to the Supplemental Register [could] be recommended.”

11. On August 23, 2021, Applicant filed its response to the Office Action. In its response, Applicant alleged that the Y-Stitching Design had acquired distinctiveness and could therefore be registered under Section 2(f) of the Lanham Act. On September 28, 2021 the Application was published for opposition with a Section 2(f) Acquired Distinctiveness Claim made in whole.

12. Registration of the Y-Stitching Design would be *prima facie* evidence of the purported validity of the Y-Stitching Design, of Applicant's ownership of the Y-Stitching Design, and of Applicant's exclusive right to the use of the Y-Stitching Design for the goods set forth in the Application.

13. As such, registration of the Y-Stitching Design would damage and injure Opposer by impeding Opposer's ability to use design elements: (i) that are purely functional and/or ornamental; (ii) that are commonly used in the apparel industry and not perceived by consumers as source identifying; and (iii) that Opposer has long used in connection with its own products.

COUNT ONE
Functionality – 15 U.S.C. §§ 1052, 1091, 1064, 1115

14. Opposer repeats and realleges each and every allegation set forth in each of the preceding paragraphs.

15. The Y-Stitching Design is purely functional matter which cannot be protected as a trademark.

16. The Y-Stitching Design offers both utilitarian and aesthetically functional advantages which are essential to the purpose of Applicant's products and which affect the cost or quality of said products.

17. Registration of the Y-Stitching Design should therefore be denied because it is purely functional matter which is barred from registration and should therefore be barred from registration as required by at least Sections 2, 14, 23, and 33 of the Lanham Act, 15 U.S.C. §§ 1052, 1064, 1091, and 1115.

COUNT TWO
Ornamental – 15 U.S.C. §§ 1051, 1052, 1127

18. Opposer repeats and realleges each and every allegation set forth in each of the preceding paragraphs.

19. In the alternative, the Y-Stitching Design is a design element that is decorative or ornamental when used in connection with apparel, including the goods identified in the Application, namely, clothing bottoms, pants, shorts, tights, and leggings.

20. Consumers do not perceive the Y-Stitching Design as having any source-identifying significance.

21. Registration of the Y-Stitching Design should be denied because it is decorative or ornamental and does not distinguish Applicant's goods from the goods of others, in violation of at least Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1127.

COUNT THREE
Nondistinctive – Failure to Prove Acquired Distinctiveness – 15 U.S.C. §§ 1051, 1052, 1127

22. Opposer repeats and realleges each and every allegation set forth in the preceding paragraphs 1–17.

23. In the alternative, the Y-Stitching Design is a nondistinctive decorative or ornamental design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness.

24. Registration of the Y-Stitching Design should be denied because it is not inherently distinctive and the limited information of record relating to Applicant's use of the Y-Stitching Design is insufficient to demonstrate that the Y-Stitching Design has acquired distinctiveness as required by at least Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051,1052, and 1127.

COUNT FOUR

Nondistinctive – Incapable of Acquiring Distinctiveness – 15 U.S.C. §§ 1051, 1052, 1127

25. Opposer repeats and realleges each and every allegation set forth in each of the preceding paragraphs.

26. In the alternative, the Y-Stitching Design is a design element that is nondistinctive ornamental design and/or purely functional matter that is incapable of acquiring distinctiveness.

27. Registration of the Y-Stitching Design should be denied because it is not inherently distinctive and cannot acquire distinctiveness as required by at least Sections 1, 2, 14, 23, 33, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1064, 1091, 1115, 1127.

CLAIM FOR RELIEF

28. By reason of the foregoing, Applicant's registration of the Y-Stitching Design will cause injury and damage to Opposer and its right to use stitching designs as described above.

WHEREFORE, Opposer believes that it will be damaged by the registration of the mark shown in Application Serial No. 90/332,530 and respectfully requests that the present opposition be sustained and that the registration sought by Applicant be refused.

Dated: January 26, 2022

Respectfully submitted,

By: /Seth A. Walters/
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