

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
General Email: TTABInfo@uspto.gov

mbm/jv

August 6, 2024

Opposition No. 91288868

Retail Royalty Company

v.

Adi Ben-Shahar

Jacob Vigil, Interlocutory Attorney:

On August 1, 2024, the Board participated in the parties' discovery conference pursuant to Trademark Rule 2.120(a)(2)(i), 37 C.F.R. § 2.120(a)(2)(i). Present during the conference were Stephanie Bald and A.J. Schumacher, counsel for Opposer, Adi Ben-Shahar, Applicant appearing pro se, and Administrative Trademark Judge Mary Beth Myles and Interlocutory Attorney Jacob Vigil for the Board. The Board participated in the conference at Opposer's request. This order sets forth a summary of the significant points addressed during the conference. Conferences with the Board may not be recorded.

I. Pro Se Party

Applicant is currently appearing pro se. Applicant was advised that he has the option to retain counsel at any time. Applicant was also advised that, due to the nature of the proceedings, legal counsel was strongly advised. The parties were

notified that the Board is unable to provide legal advice to either party and can only provide guidance regarding procedural issues. Applicant will be required to familiarize himself with all Board procedures, rules, and regulations governing the case, including but not limited to the Trademark Rules of Practice and the Federal Rules of Civil Procedure, where appropriate.

II. Board's Jurisdiction

The Board is an administrative tribunal that is empowered solely to determine the right to register, and has no authority to determine the right to use a mark or any infringement or unfair competition issues. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 102.01 (2024). The Board also does not possess injunctive powers to prohibit a party from using its mark, and cannot award monetary damages or attorney's fees. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, Opp. No. 91118482, 2011 TTAB LEXIS 280, at *8 (TTAB 2011).¹

III. Other Litigation/Settlement

The parties informed the Board there are currently no other related Board proceedings or federal or state court actions between them that may have a bearing on this case. In the event that a civil action or separate Board proceeding between the parties is instituted, the parties were asked to promptly advise the Board by

¹ As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, the citation form in this order is in a form provided in TBMP § 101.03. This order cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this order employs citation to the **Lexis** database. Practitioners should also adhere to the practice set forth in TBMP § 101.03.

paper filed in the proceeding so that it can determine whether suspension or consolidation is appropriate. *See* TBMP §§ 510.02(a) and 511; Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

The parties informed the Board that they had previously engaged in settlement discussions, but those discussions were no longer active. The parties were reminded that to the extent they continue to engage in settlement discussions in the future, any stipulations to suspend the proceeding should be filed promptly because, absent suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines set by the Board. *See Atlanta-Fulton Cnty. Zoo, Inc. v. De Palma*, Opp. No. 91098819, 1998 TTAB LEXIS 9, at *6 (TTAB 1998) (“[I]t is well established that the mere existence of settlement negotiations alone does not justify a party’s inaction or delay.”). The Board typically will grant a consented or joint motion to suspend proceedings for a reasonable period of time in order to allow the parties to engage in settlement negotiations.² *See* TBMP § 510.03(a); *see also* Trademark Rule 2.117(c), 37 C.F.R. § 2.117(c). The parties are further advised that proceedings may only be suspended for settlement with the consent of both parties and that either party may request resumption of the proceedings at any time. *Id.*

² The parties are advised, however, that the Board will not suspend proceedings indefinitely for settlement negotiations. After a period of time, the Board may require the parties to file a detailed report on the progress of their settlement activities. While the Board encourages settlement efforts, it also has an interest in seeing its cases conclude in a timely manner.

IV. Pleadings

As part of its participation in the discovery conference, the Board reviews the sufficiency of the parties' pleaded claims and defenses.

A. Notice of Opposition

Turning first to the notice of opposition, Applicant seeks registration of the mark ARIÉ, in standard characters, for use with a variety of goods and services in International Classes 3, 9, 18, 25, 35, 40, and 42.³

Opposer opposes registration of Applicant's mark on the grounds of priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution by blurring under Trademark Act Sections 2 and 43(c), 15 U.S.C. §§ 1052 and 1125(c).⁴ In support thereof, Opposer pleads ownership of fifteen registrations for the mark AERIE, in standard characters, for use with a variety of goods and services in International Classes 3, 9, 14, 18, 24, 25, 26, 35, and 36.

³ Application Serial No. 97387702, filed April 28, 2022, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intent to use the mark in commerce.

⁴ 1 TTABVUE.

Citations to the record in this order are to TTABVUE, the Board's electronic docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. The parties should cite to the record using TTABVUE throughout this proceeding. *See RxD Media, LLC v. IP Application Dev. LLC*, Opp. No. 91207333, 2018 TTAB LEXIS 37, at *11 (TTAB 2018) (Board prefers citation to the TTABVUE record), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361 (4th Cir. 2021); *Turdin v. Trilobite, Ltd.*, Conc. Use No. 94002505, 2014 TTAB LEXIS 17, at *6 n.6 (TTAB 2014) (citation to the Board's TTABVUE docket electronic database by the entry and page number (e.g., 1 TTABVUE 2) is recommended).

Opposer also alleges acquisition of prior common law rights in the mark AERIE for use with “apparel, footwear, and accessories, as well as retail store services and online retail store services,”⁵ as well as “sunglasses, cosmetics, personal care and wellness products, bras and bra accessories, fragrances, jewelry, bags, hair accessories, blankets, and towels.”⁶ Although Opposer uses the wording “including, but not limited to” in Paragraph 7, the Board considers the common law rights properly pleaded only as to the specifically listed products.

The Board finds that Opposer adequately pleaded its entitlement to a statutory cause of action and a legally sufficient likelihood of confusion claim by alleging that use of Applicant’s subject mark in connection with the goods and services identified in the subject Application is likely to cause confusion with Opposer’s respective pleaded registered mark, AERIE, and prior common law rights in AERIE.⁷ *See Nike, Inc. v. Palm Beach Crossfit, Inc.*, Opp. No. 91218512, 2015 TTAB LEXIS 314, at *7, *11 (TTAB 2015).

The Board also finds that Opposer adequately pleaded a legally sufficient dilution by blurring claim by alleging ownership of a famous mark, Applicant’s use of a mark that allegedly dilutes Opposer’s famous mark, its mark became famous prior to Applicant’s use in commerce, and Applicant’s use is likely to dilute the distinctive quality of Opposer’s famous mark.⁸ *See Nike*, 2015 TTAB LEXIS 314, at *14.

⁵ 1 TTABVUE 10 (¶ 5).

⁶ *Id.* at 15 (¶ 7).

⁷ *Id.* at 26.

⁸ 1 TTABVUE 27.

B. Applicant's Answer

Turning to the answer, Applicant timely filed an answer to the notice of opposition which responds to the allegations therein, and includes three affirmative defenses.⁹ In his answer, Applicant admitted to Paragraphs 17-20 regarding information about Applicant, details of the subject Application, the date of publication in the Official Gazette, and Opposer's filing of an extension of time to oppose the Application, and denied the remaining allegations in the notice of opposition. The Board finds Applicant's answer sufficient in that it fairly responds to the substance of the allegations in the notice of opposition. *See* Trademark Rule 2.106(b)(2), 37 C.F.R. § 2.106(b)(2); TBMP § 311.02(a).

With respect to the three affirmative defenses,¹⁰ while these are not true affirmative defenses, to the extent they amplify the denials in Applicant's answer, they are permissible. *See ProMark Brands Inc. v. GFA Brands, Inc.*, Opp. No. 91194974, 2015 TTAB LEXIS 67, at *5 n.11 (TTAB 2015).

V. Standard Protective Order

The parties were reminded that the Board's Standard Protective Order is automatically in effect for this proceeding pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g).¹¹ *See* TBMP § 412.01. Because of the automatic imposition of the

⁹ 6 TTABVUE.

¹⁰ The Board previously struck the fourth and fifth affirmative defenses. 9 TTABVUE.

¹¹ The standard protective order is available on the Board's web site at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

It is not necessary for the parties to sign copies of the Board's protective order for it to take effect, although the parties may desire to do so for other reasons. *See* TBMP §§ 412.01, 412.03.

protective order, parties cannot withhold properly discoverable information on the basis of confidentiality. *See Intex Rec. Corp. v. The Coleman Co.*, Opp. No. 91220432, 2016 TTAB LEXIS 47, at *7 (TTAB 2016); TBMP § 412.01.

When responding to discovery, a party seeking to designate information as “Confidential” or “Confidential – For Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive)” has a duty to make a meaningful good faith effort to designate only that information that warrants the designated level of protection, if any. *See Blackhorse v. Pro Football Inc.*, Can. No. 92046185, 2011 TTAB LEXIS 142, at *7 (TTAB 2011); TBMP § 412.01(a).

Applicant was advised that, because he is representing himself pro se, he will not be able to view materials properly designated as “Confidential – For Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive).” If Opposer is asked to produce documents that are properly designated as “Confidential – For Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive),” it needs to specifically state that it has documents it is withholding on that basis so that Applicant is on notice. If the parties or their attorneys disagree as to whether certain information is properly designated for protection, the parties are obligated to negotiate in good faith to resolve the dispute. *See* TBMP § 412.01(b). If the parties are unable to resolve their differences, the party challenging the designation may file a motion seeking a determination of the status of the information. *Id.*

VI. Discovery and Motions Practice

The parties are reminded that they must make their initial disclosures as required by Fed. R. Civ. P. 26(a)(1) prior to seeking discovery, absent modification of this requirement approved by the Board. *See* Trademark Rule 2.120(a)(3), 37 C.F.R. § 2.120(a)(3). Moreover, the parties may not file a motion for summary judgment until they have made their initial disclosures, except for one asserting issue preclusion, claim preclusion, or lack of jurisdiction by the Board. *See* Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1). For additional information about initial disclosures, please see TBMP § 401.02.

Pursuant to Fed. R. Civ. P. 26(b)(1), “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case[.]” Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of the discovery period. *See* Trademark Rule 2.120(a)(3). Similarly, discovery depositions must be properly noticed and taken during the discovery period. *Id.*

The parties are reminded that they should not assert boilerplate or blanket objections in response to discovery requests. *See* Fed. R. Civ. P. 34(b)(2)(B) (party responding to a document request must “state with specificity the grounds for objecting to [a] request, including the reasons”); *Medtronic, Inc. v. Pacesetter Sys., Inc.*, Opp. No. 91064639, 1984 TTAB LEXIS 154, at *10 (TTAB 1984) (It is incumbent

upon a party who has been served with interrogatories to respond by articulating objections (with particularity) to those interrogatories believed to be objectionable, and by providing the information sought in those interrogatories believed to be proper.). If a party withholds information or documents in response to a discovery request based on the attorney/client privilege and/or work product doctrine, the party must produce a privilege log. *See Amazon Techs. Inc. v. Wax*, Opp. No. 91187118, 2009 TTAB LEXIS 712, at *12 n.6 (TTAB 2009); TBMP § 406.04(c).

The Board encourages the parties to consent to extensions of time to accommodate reasonable scheduling difficulties. However, absent a motion to extend a deadline, based on either the consent of the other party or the requisite showing of good cause, the parties are expected to adhere to the Board's schedule for this proceeding.

The parties should not file their initial disclosures, discovery requests, or discovery responses with the Board, except as permitted under Trademark Rule 2.120(k)(8), 37 C.F.R. § 2.120(k)(8), in connection with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.

The parties were reminded that they each have a duty not only to make a good faith effort to satisfy the legitimate discovery needs of their adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *See* TBMP § 408.01.

The parties should consult the "Discovery Guidelines" listed in TBMP § 414 before making or objecting to discovery requests. The Board expects parties to cooperate

with one another in the discovery process. *See* TBMP § 408.01. If either party plans to file a motion to compel discovery or a motion to test the sufficiency of a response or objection to a request for admission, the moving party must first confer with the other party in good faith to attempt to resolve or narrow the dispute, and then must demonstrate its good-faith efforts as part of its motion. *See* Trademark Rules 2.120(f)(1) and 2.120(i)(1); *see also* TBMP §§ 523.02, 524.02. The Board strongly encourages the parties to include at least one phone call in their meet and confer efforts. The obligation to meet and confer in good faith is a mutual obligation. *See, e.g., Amazon Techs.*, 2009 TTAB LEXIS 712 at *8-9 (citation omitted).

The Board urges the parties to confer early in the case regarding their respective discovery needs and the manner in which electronically stored documents will be produced. The parties are further encouraged to give as much notice as possible of planned depositions and to consider stipulating to conducting depositions via remote means, where permissible.

The parties are advised that any motion to compel or motion for summary judgment must be filed before the day of the deadline for Opposer's pretrial disclosures for its opening trial period. *See* Trademark Rules 2.127(e)(1) and 2.127(f)(1). Additional information regarding motion practice before the Board may be found in TBMP Chapter 500.

VII. Pretrial Disclosures and Trial Procedures

Many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. The Federal Rules of Evidence generally

apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods.

Pretrial disclosures are governed by Trademark Rule 2.121(e) and Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as required by Fed. R. Civ. P. 26(a)(3)(A)(iii). Additionally, a party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. *See* Trademark Rule 2.121(e). For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

VIII. Accelerated Case Resolution

The Board advised the parties that options exist for streamlining the case using the Board's Accelerated Case Resolution ("ACR") procedure, for which the standards of proof and manner of appeal remain the same as in a traditional Board proceeding.

For further information concerning the use of ACR, the parties are referred to TBMP § 702.04, and the information available on the TTAB page of the USPTO's website, <https://www.uspto.gov/trademarks/ttab>, under "[a]lternate resolution options." As discussed during the conference, the parties are encouraged to contact the assigned Interlocutory Attorney should they consider ACR in the future and desire assistance in developing an appropriate stipulation.

IX. Proceedings Resumed; Trial Dates Reset

Proceedings are resumed. Dates for disclosures, discovery and trial are reset as set forth in the schedule below:

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| Discovery Opens | 8/9/2024 |
| Initial Disclosures Due | 9/8/2024 |
| Expert Disclosures Due | 1/6/2025 |
| Discovery Closes | 2/5/2025 |
| Plaintiff's Pretrial Disclosures Due | 3/22/2025 |
| Plaintiff's 30-day Trial Period Ends | 5/6/2025 |
| Defendant's Pretrial Disclosures Due | 5/21/2025 |
| Defendant's 30-day Trial Period Ends | 7/5/2025 |
| Plaintiff's Rebuttal Disclosures Due | 7/20/2025 |
| Plaintiff's 15-day Rebuttal Period Ends | 8/19/2025 |
| Plaintiff's Opening Brief Due | 10/18/2025 |
| Defendant's Brief Due | 11/17/2025 |
| Plaintiff's Reply Brief Due | 12/2/2025 |
| Request for Oral Hearing (optional) Due | 12/12/2025 |

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, matters in evidence, the manner and timing of taking testimony, 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). 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).