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COPYRIGHT CLAIMS BOARD **DOCKET NO.: 23-CCB-0211**

JOSEPH ROONEY,

Claimant,

v.

ALEXANDRA VON PARIS
and
ROUTE ONE APPAREL, LLC,

Respondents.

RESPONDENTS' ANSWERS TO INTERROGATORIES

Respondents, by and through their undersigned attorneys, hereby respond to the Claimant's interrogatories (the "**Interrogatories**"), incorporating into each specific objection the general objections set forth below and reserving the right to modify and supplement his responses and objections, as follows:

GENERAL OBJECTIONS

1. Respondents make the following general objections and reservations, applicable to their answers to each numbered item of the Interrogatories and to any production of documents pursuant to such Interrogatories.

2. Respondents object to the Interrogatories to the extent they purport to require the disclosure of information beyond the scope of discovery permissible under applicable law. Respondents reserve all objections to relevance and materiality. Respondents answer, and any identification or production of documents indicated in those answers, shall neither waive nor prejudice any objections asserted by Respondents, including without limitation objections as to the admissibility of any document or category of documents at trial.

3. Respondents object to the Interrogatories to the extent they are overly broad, vague, unduly burdensome, harassing and/or seek information that is neither relevant to the subject matter of this action nor reasonably calculated to lead to the discovery of admissible evidence.

4. Respondents object to the Interrogatories to the extent they purport to require the production of documents, if any, prepared in anticipation of litigation, subject to a claim of attorney-client, joint defense or other privilege, or protected from discovery under the work product doctrine or any other applicable privilege. To the extent that Respondents inadvertently disclose information arguably protected from discovery under the attorney-client privilege, joint defense privilege, work product doctrine or any other applicable privilege, such inadvertent disclosure is not a waiver of any such privilege.

5. Respondents object to the Interrogatories to the extent they seek information not relevant to the allegations in the pleadings or the time frame in the pleadings.

6. Respondents object to the Interrogatories to the extent they call for production of documents in the possession, custody or control of Respondents and/or their counsel, and therefore are unduly burdensome and harassing, and compliance therewith would be unnecessarily disruptive and expensive.

7. Respondents object to the Interrogatories to the extent they call for the production of documents in the possession, custody or control of people or entities other than Respondents on the grounds that such production is beyond the scope of applicable law, and would be unduly burdensome and expensive.

8. Respondents object to the Interrogatories to the extent that they are contention Interrogatories which prematurely seek information that is in the domain of the other parties to this lawsuit and cannot be answered unless and until the parties complete discovery.

9. These general objections are applicable to each and every one of the following responses, and failure to repeat an objection in response to a specific interrogatory shall not be deemed a waiver of the objection. When Respondents specifically repeat one or more of these general objections in response to a specific interrogatory, such specific response shall not be considered a waiver of these general objections.

10. These general objections and responses are made subject to, and without waiving or intending to waive, but on the contrary intending to reserve and reserving, all of Respondents rights under the CCB Rules, including Respondents' right to object to any other discovery procedures involving or related to the subject matters of the Interrogatories.

11. The answers set forth below are made without in any manner waiving the right to revise, correct, supplement or clarify any responses. Respondents specifically reserve the right to supplement its responses in accordance with the CCB Rules.

12. Respondents have not completed their investigation of all the facts of this case or discovery in or analysis of this matter, and have not completed preparation for trial. Accordingly, all of the following answers are provided without prejudice to Respondents right to introduce at trial any evidence that is subsequently discovered relating to proof of presently known facts and to produce and introduce all evidence whenever discovered relating to the proof of subsequently discovered material facts. Moreover, facts, documents and things now known may be imperfectly understood and, accordingly, such facts, documents and things may not be included in the following answers. Respondents reserve the right to refer to conduct discovery

with reference to, or offer into evidence at the time of trial any and all facts, documents and things notwithstanding the initial answers and objections interposed in these responses.

13. Subject to and without waiving these general objections and the specific objections noted below, Respondents respond to Claimant's Interrogatories in accordance with its understanding of their fair meaning.

SPECIFIC ANSWERS AND OBJECTIONS TO INTERROGATORIES

1. Give the full name of each person you plan to use in the proceeding as a witness. Include their phone number, mailing address, and email address, if you know it. Include a brief description of the topics on which they may give a witness statement in this proceeding.

Answer to No. 1: **Respondents object to Interrogatory No. 1 to the extent it seeks information protected under the attorney-work product doctrine. Notwithstanding the objection and without waiving it, the Respondents may call the following as witnesses:**

- **Alexandra Von Paris, Route One Apparel, LLC, 1030 Cromwell Bridge Road, Towson, MD 21286, 443-499-9004, ali@routeoneapparel.com, may give testimony regarding the: (i) nature and history of the relationship between the parties, (ii) absence of any confidentiality agreement or contract between the parties; (iii) Respondent's license with McCormick & Company, Inc. related to Old Bay; (iv) parties' collaboration on works and a proposed product; (v) date of product launch, sales, revenue, and costs; (vi) lack of originality and use of Old Bay material and IP on packaging, and (vii) the similarity between the copyright and the accused phrases.**

- **Respondents may also use testimony from Claimant Joseph Rooney, and Rob Johnson of McCormick & Company, Inc., 24 Schilling Road, Hunt Valley, MD 21031, (410) 771-7301, on the same topics listed above.**

2. Name any other person who may have important information related to the claims, counterclaims, or defenses in the proceeding. Include their phone number, mailing address, and email address, if you know it.

Answer to No. 2: **None known at this time. Respondents reserve the right to supplement at a later date if new information is learned.**

3. Is any agreement or other relationship between the parties relevant to the claim? If yes, describe the agreement or other relationship.

Answer to No. 3: **Respondents object to the term "relevant" as it calls for a legal conclusion. Notwithstanding the objection and without waiving it, Claimant sought out Respondents to collaborate on a product and its packaging as he did not have a license. He**

sought help and Respondents provided it. By email dated February 23, 2022, Claimant even admits in writing to Respondents "Rob and I spoke last week and he encouraged me to reach out to you to discuss working together on a 2.0 version that is new and improved. I've attached photos of the final product that I built and *the packaging you and I previously collaborated on."* (emphasis added). This claim lacks merit as Claimant has admitted that the parties worked on the packaging together (which is where the subject work was published) and it was not his work solely. Also, Respondent Route One Apparel, LLC ("Route One") is a party to a License Agreement and Amendment with McCormick & Company, Inc., originally dated August 21, 2017 (the "License"). Claimant is not a party or beneficiary to the License.

4. Are you aware of any relevant document that exists or once existed, that is responsive to a request for the production of documents, but that is not in your possession? If yes, for each such document, provide a summary of its contents and, if it was once in your possession, explain when and why it was disposed, destroyed, lost, or otherwise became unavailable.

Answer to No. 4: **Respondents object to the term "relevant" as it calls for a legal conclusion. Notwithstanding the objection and without waiving it, there are none known at this time. Respondents reserve the right to supplement at a later date if new information is learned.**

5. Describe the process of the creation of your work, including:

Answer to No. 5:

(a) Who conceived of the work, and on what date?

After McCormick & Company, Inc. ("McCormick"), the owner of Old Bay seasoning, rejected Claimant's request for a license, Claimant sought a business relationship with Route One. The subject "work" was created collaboratively over several months by all parties through numerous exchanges of emails, ideas and discussions beginning on or about January 22, 2018 on a potential portable Old Bay seasoning canister. For example, Claimant repeatedly sought collaborative input on the packaging by emails stating: (i) "What other thoughts do you have on the packaging"; (ii) "I would really appreciate it if you reconsidered your decision so that we can continue our partnership"; and (iii) "we can grab lunch and talk about rejoining forces."

Claimant and Respondents were not parties to a confidentiality agreement, non-disclosure agreement, or any other contract between them. It took close to 4 months for Claimant to even send a red-line version of a proposed contract back to Respondents.

There is no originality in the work at issue on the product. Claimant even admitted in emails that he believed that a similar product on the market for another food seasoning called "*Siracha to Go*" could be used for Old Bay, as well as the "to go" slogan. The Siracha product he referenced to Route One is shown here:



The prototype created by Claimant was a near duplicate of the Siracha product.

Notably, Route One's final portable Old Bay product (shown below) has a completely different name and the packaging is different as well. It was not called "Old Bay 2 Go."



It also did not incorporate a funnel, which was a centerpiece to Claimant's prototype.

The collaborative work is not original as it contains numerous slogans and phrases that already existed in the public domain, including actual phrases from Old Bay's website and product reviews. For example, Claimant's Copyright TXu002329132 includes the phrase *"For over 75 years, OLD BAY. . ."*. This phrase was apparently lifted by Claimant word-for-word from Old Bay's website (even putting the trademarked name OLD BAY in all caps) which states:

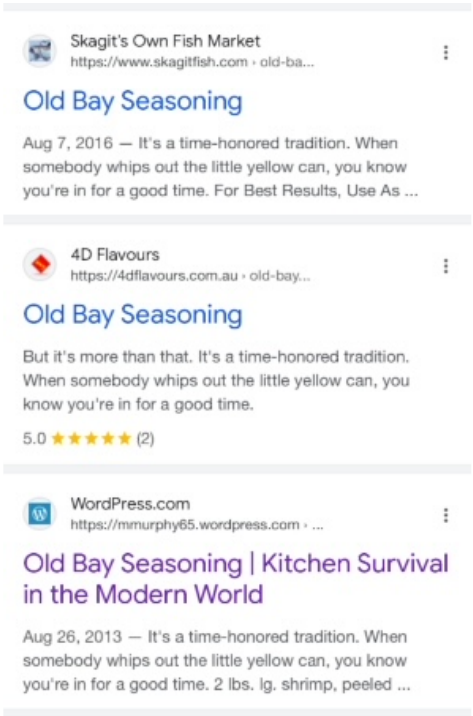


Old Bay

An iconic flavor that embodies the spirit of Maryland. For more than 75 years, OLD BAY has provided food lovers with bold flavor solutions for seafood, side dishes and more through its unique blend of 18 herbs and spices.

Another McCormick web page includes the same language Claimant used to reference the Chesapeake Bay area: *See* https://www.mccormickforchefs.com/en-us/products/old-bay/old-bay-seasoning: which states "*Born in the heart of the Chesapeake Bay area, OLD BAY has been a time-honored brand and world-famous seasoning for over 75 years.*"

Other product reviews on websites that predate the work refer to Old Bay as the "time-honored" tradition.



Indeed, Claimant even admitted by email: "I put together a sample of something that I was thinking would look good on the back of the packaging. It'll need some work but I think it's a good start. For inspiration I used the story at the following link: http://www.oldbay.com/OLD-BAY-Story.aspx"

The rest of the copyrighted slogan states you can "*clip OLD BAY mini to your keychain, backpack, purse…*", but this phrase is a method of operation, procedure, or process which is excluded from copyright protection by statute. As such, the language which simply states what you can clip a product to is precluded by statute. The subject work also includes the use of a trademarked term owned by Old Bay and licensed to Respondent only.

After the parties failed to reach an written agreement for the manufacturing, distribution and sale of the product, the Claimant and Respondent parted ways on or about June 5, 2018. Four years later, in 2022, after the parties collaborated without an NDA agreement, and unbeknownst to Respondents, Claimant sought and obtained a copyright. Claimant cannot benefit from this type of attempted "gotcha."

Accordingly, the slogans and language in the work used by Respondents were not properly protected by copyright.

(b) If it is a joint work, identify each joint author (including their phone number, mailing address, and email address, if you know it) and describe what each joint author contributed to your work?

Respondents object to the term "joint work" as it calls for a legal conclusion. Notwithstanding the objection and without waiving it, ***see*** **Answer to 5(a) above; During their collaborative process, the parties provided suggestions for language to appear on the product packaging to each other as well as comments and edits. As stated, the statements used to describe the product were already in the public domain, and included slogans and phrases from advertising and product reviews for Old Bay, and McCormick which are not copyrightable.**

(c) To the extent you used the claimant's work in any way to help you create your work, state how you used claimant's work, and what, if anything, is different as between your work and claimant's work?

See **Answers to 5(a) and (b) above.**

6. If you believe that you had permission or rights to use claimant's work, describe in detail how you received such permission and the nature of such rights, including a description of any relevant communications, licenses, or agreements (including if through a work made for hire agreement) and the dates and the people or entities involved in such communications, licenses, or agreements.

Answer to No. 6:

***See* Answer to 5 above. Again, Claimant's allegations relate to a work titled "Old Bay 2 Go Slogan" which merely contains slogans which are not typically copyrightable. In addition, the alleged copyrighted phrase contains statements that have long been in the public domain and are not copyrightable as they are not original. Furthermore, Old Bay is a licensed trademark which Respondent has a license to use and Claimant does not. So no permission was necessary.**

However, as a licensee of the trademark "Old Bay" from its owner, Respondent has permission to use any slogan using the "Old Bay" trademark and Claimant has no rights to use the "Old Bay" trademark in any manner whatsoever. It is copyright misuse to do so and the defense of copyright misuse bars Claimant from prevailing on an action for infringement of the misused copyright.

Respondents' use also constitutes "fair use" as the packaging incorporates original ideas from the "Old Bay" trademark owner as well as Respondent and thus uses only non-copyrightable text. While the use of the alleged copyright work was on product packaging, the use was not for commercial gain as any gain commercially was from use of the "Old Bay" trademark or more importantly the product itself which has been in the market for more than 75 years. In addition, the packaging did not use the slogan "Old Bay 2 Go" that was copyrighted and had many original designs that transformed the previous work and any use of the alleged copyrighted work was purely factual or covered material that is not deemed original pursuant to copyright law. The product has been pulled from the market and nothing in the alleged copyrighted work impacted the market. Rather, it was the "Old Bay" trademark covered the product which would drive any market demand. The product was only sold on-line on Respondent's website and the alleged work was not even viewable by a consumer during a website purchase as there were no packaging photos.

7. If you had seen claimant's work before creating your work, describe where and how you saw claimant's work.

Answer to No. 7: ***See* Answer Nos. 5 through 7 above.**

8. If you had never seen claimant's work before creating your work, state that here. Also describe any basis for believing that you did not have an opportunity to see claimant's work (also known as "access").

Answer to No. 8: ***See* Answer Nos. 5 through 7 above.**

9. State in detail in what ways you believe the claimant's work is different or not substantially similar to your work.

Answer to No. 9: ***See* Answer Nos. 5 through 7 above.**

10. If you have brought a claim or counterclaim for a declaration of noninfringement, describe how you found out that the party(ies) alleging infringement believed that you were

infringing their work, and any actions you took relating to the work upon hearing of their allegations?

Answer to No. 10: **No claim has been filed by Respondents, but Respondents have discussed Claimant's copyright filing and this matter with McCormick and its counsel which advised counsel that "McCormick will separately be looking into potential options for protecting the IP in Rooney's copyright . . . ".**

11. To the extent the sale, publication, display, distribution, and/or performance of your work or copying of claimant's work has stopped, state when and how it stopped. To the extent it has not stopped, state that here and describe how such actions are continuing.

Answer to No. 11: **After learning of the Claimant's assertions, Route One diligently stopped the production, distribution and sale of its product and it was removed from Route One's website on or about November 22, 2022. McCormick was notified of its removal by email.**

12. Has your work been published? If yes, when and where was it first published and where and when has it been published since?

Answer to No. 12: **Respondents object to the term "published" as it calls for a legal conclusion. Notwithstanding the objection and without waiving it, the first order for manufacturing and sale of Respondents' product was on or about April 9, 2020 (Order #140947. It was sold on-line on Route One's website.**

13. To the extent you believe the other party(ies) was not harmed due to any infringement of claimant's work, state your basis for believing that here.

Answer to No. 13: **There was no protected work and thus no infringement. It was also created by all parties collaboratively. Regardless, Respondents had permission under the License to use the Old Bay trademarked material. Also, consumers could not even view the subject work when purchasing the product as the product was only offered on the Route One website and the subject work was on the back of the packaging. But even if the CCB were to determine that there was infringement, there was little to no profit.**

14. Have you sold copies of your work? If yes, describe such sales in detail including how you went about selling your work and in what medium, how many sales, and the price you charged for the work or each copy of the work.

Answer to No. 14: **The product with the subject work was offered for sale on the Route One website on or about January 9, 2020. The first order had a price of $25 but all subsequent orders (beginning with #141114) were $14.99. Route One sold approximately 12,828 units.**



15. If you are responding to an infringement claim or counterclaim, state:

Answer to No. 15:

(a) The revenues and profits you have received, including any royalties received, directly related to the sale, licensing or use of any allegedly infringing material(s) in this proceeding.

Order name	Net quantity	Gross sales	Discounts	Returns	Net sales	Tax	Total sales
	12,828	$208,415.38	-$105,030.11	-$741.88	$102,643.39	$2,318.84	$104,962.23
#140947	1	$25.00	$0.00	$0.00	$25.00	$0.00	$25.00
#141114	1	$14.99	$0.00	$0.00	$14.99	$0.90	$15.89

(b) The deductible expenses, such as the cost of producing the allegedly infringing material(s) directly related to that sale, licensing, or use, broken down into categories of expenses.

Cost on the product listing are $1.30 which includes vendor's shipping costs. Storage/warehousing costs add approximately $1.00 per unit. Shipping/packaging materials are approximately $4.00 - $5.00 per unit. Total deductible expenses = $6.30 to $7.30 per unit.

(c) The elements of profit for that sale, licensing or use, that you believe resulted from factors other than the allegedly infringing material, such as from the aspects of your work not included in the claimant's work.

The subject Old Bay Product was sold through Respondent's website at www.routeoneapprael.com. Respondent creates fashionable, affordable, and fun products that let its customers make a "STATE-ment" – and celebrate everything special and unique about their hometown, alma mater, workplace, or sports team. To that end, Respondent has licenses from legendary Maryland businesses and teams including Old Bay, Utz, Domino Sugar, Morton Salt, National Bohemian, Pabst, Hoop tea, Baltimore Orioles, Baltimore Ravens, Washington Capitals, UMBC, and University of Maryland. These licenses drive fans of these teams and local brands to the website to browse and purchase products. Claimant has never had a license with any of these entities or the ability to sell products with their intellectual property. Respondents developed a product that was entirely different than Claimant's prototype and did not use the phrase "Old Bay 2 Go". While the use of the alleged copyright work was on the back of the product packaging, it was created collaboratively, and the use was not for commercial gain as any gain was from use of the "Old Bay" trademark, or more importantly the product itself which has been in the market for more than 75 years. Old Bay is an iconic brand that is owned and advertised by a Fortune 500 company.

Sales of Old Bay are a result of more than 75 years of market presence and its extensive advertising. McCormick's SEC filings and Income Statement show that it spent $198,100,000 on advertising in 2023 and it maintains 118 employees in its in-house marketing department.

For example, Old Bay prominently advertises at professional sporting events and on TV.



Importantly, the Respondents' website did not even display the work at issue and the rear of the packaging so the ad-text was not even seen by customers. There is no evidence that the work in question resulted in any sales.

16. Review the Response you filed in this proceeding. For each defense you have checked in the Response Form, as well as any other defenses you wish to raise, list those defenses here, and separately for each one, describe in detail your basis for believing you have such a defense.

Answer to No. 16:

The following defenses apply:

- **Non-infringement.**
- **Claimant's allegations relate to a work titled "Old Bay 2 Go Slogan". Slogans are not typically copyrightable. 37 C.F.R. § 202.1, and Respondents did not use that slogan anyway.**
- **The alleged copyrighted phrase contains statements that have long been in the public domain and are not copyrightable. There is no originality in the subject slogan, and thus, it is not actionable.**
- **The Claimant does not own the material used or the copyright in the work at issue.**

- **Old Bay is a licensed trademark owned by McCormick which Respondent has licensed. It cannot be copyrighted by Claimant or any other another person or entity.**

- **Respondent is the licensee of the trademark "Old Bay" from its owner. Given McCormick's ownership of the term and the "Old Bay" trademark, Respondent has permission to use any slogan using the "Old Bay" trademark and Claimant has no rights to use the "Old Bay" trademark in any manner whatsoever. It is copyright misuse to do so. The defense of copyright misuse "bars a culpable plaintiff from prevailing on an action for the infringement of the misused copyright." *Lasercomb Am., Inc. v. Reynolds,* 911 F.2d 970, 972 (4th Cir.1990). *See Mitchell Bros. Film Group v. Cinema Adult Theater,* 604 F.2d 852, 865 n. 27 (5th Cir.1979), *cert. denied,* 445 U.S. 917, 100 S.Ct. 1277, 63 L.Ed.2d 601 (1980) (recognizing the copyright misuse defense). The defense is a recognition that while "copyright law [seeks] to increase the store of human knowledge and arts by awarding ... authors with the exclusive rights to their works for a limited time ... the granted monopoly power does not extend to property not covered by the ... copyright." *Lasercomb,* 911 F.2d at 976.**

- **Copyright misuse, waiver, unclean hands, estoppel, and laches all apply in this case. *See Logical Operations Inc. v. 30 Bird Media,* LLC, 354 F. Supp. 3d 286, 296 (W.D.N.Y.2018)("Other principles include "scènes-à-faire" and the "merger" doctrine. The former "teaches that elements of a work that are 'indispensable, or at least standard, in the treatment of a given topic'—like cowboys, bank robbers, and shootouts in stories of the American West—get no protection." *Zalewski,* 754 F.3d at 102; *see, e.g., Civility Experts Worldwide v. Molly Manners, LLC,* 167 F.Supp.3d 1179, 1196 (D. Colo. 2016) (finding selection of topics in instructional manuals on manners and etiquette unprotected scènes-à-faire where any such manual "will likely cover these sorts of topics"). The merger doctrine "instructs that some ideas can only be expressed in a limited number of ways—single words or colors for example. When expression is so limited, idea and expression 'merge.' Expressions merged with ideas cannot be protected, lest one author own the idea itself." *Zalewski,* 754 F.3d at 102-03; *see, e.g., Nat'l Nonwovens, Inc. v. Consumer Prods. Enters., Inc.,* 397 F.Supp.2d 245, 256-57 (D. Mass. 2005) (unadorned step-by-step instruction on boiling wool felt implicated merger doctrine, because of limited number of ways in which to convey the relevant information).") All claims are also barred under the doctrines of waiver, unclean hands, estoppel and laches.**

Dated: May 20, 2024

COLE SCHOTZ P.C.

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CERTIFICATION OF DISCOVERY RESPONSES

I, Alexandra Von Paris, certify that the enclosed material is accurate, complete and truthful to the best of my knowledge.

/s/ Alexandra Von Paris	May 20, 2024
Signature	**Date**

Proof of Delivery

I hereby certify that on Thursday, November 14, 2024, I provided a true and correct copy of the Exhibit to Sur-Reply to the following:

Joseph Rooney, represented by Joseph Rooney, served via ESERVICE at joe@epgdenver.com

Signed: /s/ Gary H Leibowitz