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

Proceeding	91217154
Party	Plaintiff Nasty Pig, Inc.
Correspondence Address	JOEL KARNI SCHMIDT COWAN LIEBOWITZ & LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036 UNITED STATES spc@cll.com, jks@cll.com, mxe@cll.com
Submission	Opposition/Response to Motion
Filer's Name	Joel Karni Schmidt
Filer's e-mail	jks@cll.com, spc@cll.com, mxe@cll.com, trademark@cll.com
Signature	/Joel Karni Schmidt/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/085,785
Filed: October 8, 2013
For Mark: DIRTY PIG
Published in the Official Gazette of March 4, 2014

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NASTY PIG, INC.,	:	
Opposer,	:	Opposition No. 91217154
v.	:	
JANOSKIANS LLC,	:	
Applicant.	:	
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**OPPOSER’S OPPOSITION TO APPLICANT’S MOTION
FOR LEAVE TO AMEND ANSWER TO ADD ADDITIONAL AFFIRMATIVE
DEFENSES AND PETITION TO CANCEL**

Opposer Nasty Pig, Inc. (“Opposer”) respectfully submits this memorandum of law in opposition to the October 12, 2015 motion of Applicant Janoskians, LLC (“Applicant”) [Dkt. 20] for leave to amend the Answer to add additional affirmative defenses and a petition to cancel Opposer’s registrations for the mark NASTY PIG.

MEMORANDUM IN OPPOSITION TO MOTION

PRELIMINARY STATEMENT

Subsequent to the close of discovery and on the eve of trial, Applicant filed the instant motion for leave to amend its Answer to assert additional affirmative defenses and counterclaims seeking to cancel Opposer’s registrations for the mark NASTY PIG (“Opposer’s NASTY PIG Mark”) on the grounds that the mark is generic, merely descriptive, scandalous and was procured by fraud. Opposer’s NASTY PIG Mark, which was coined and adopted by Opposer 20 years

ago, has no descriptive significance nor does it have any readily identifiable meaning, let alone the meaning being ascribed to it by Applicant. Having already evidenced its bad faith by engaging in obstructionist discovery tactics that resulted in unnecessary motion practice,¹ Applicant now seeks to further waste the Board's and the parties' resources by belatedly moving for leave to file what amounts to a legally deficient petition to cancel. The Board should reject the instant motion which represents nothing more than a further delay tactic.

As a threshold matter, Applicant's motion to amend should be denied as untimely under Federal Rule 15(a). It is beyond dispute that the purported factual basis for the amendments – which consists of screenshots from two publicly available websites – was available to Applicant at the time it filed its Answer over *15 months* ago in July 2014. Applicant provides no reasonable explanation why its proposed amendments were not included within its Answer, nor why it failed to seek leave to add the proposed cancellation claims at any time during the intervening 15 months. Applicant was obligated to investigate promptly any potential counterclaims, and cannot now feign ignorance when the information upon which it relies was readily available at the inception of this case.

Moreover, the proposed amendments – seeking cancellation of Opposer's registrations on four purported grounds – would dramatically expand and alter the nature and character of this proceeding. The parties' discovery conducted over the past 15 months has concerned only the sole active claim, namely, Opposer's Section 2(d) claim for likelihood of confusion. With discovery already concluded and trial about to commence, Opposer would be prejudiced by such a drastic change to the pleadings at this advanced stage of the case.

¹ Applicant has attempted to thwart Opposer's legitimate efforts at obtaining discovery at every turn. For example, on June 12, 2015, the Board granted Opposer's motion to compel Applicant's interrogatory responses after Applicant had unjustifiably refused for months to propound said responses. [Dkt. 18].

The instant motion should thus be denied due to Applicant's excessive and unexplained delay in filing this motion and the ensuing prejudice to Opposer.

In addition to Applicant's undue delay in moving to amend, each of Applicant's proposed counterclaims should be denied as futile.

First, Applicant's claim of genericness is specious. Applicant makes no allegation that the mark NASTY PIG represents the genus of Opposer's registered clothing and related goods and services, nor could Applicant plausibly make such an allegation. Put simply, the registered clothing and related goods and services are not pigs.

Second, because Opposer's U.S. Reg. No. 2,800,386 for Opposer's NASTY PIG Mark issued over five years ago, Applicant's proposed counterclaim alleging that the mark is merely descriptive is time-barred under 15 U.S.C. § 1064. Moreover, Applicant fails to assert a plausible claim of descriptiveness against Opposer's U.S. Reg. No. 4,809,230 for Opposer's NASTY PIG Mark as the mark does not immediately describe a characteristic or quality of the registered clothing and related goods and services.

Third, Applicant's proposed counterclaim alleging that Opposer's NASTY PIG Mark is scandalous, which must be judged according to contemporary U.S. attitudes and in the context of the registered goods and services, also fails to state a claim. First, the fact that it purportedly took Applicant's attorneys over 15 months to locate two obscure online references to the term "nasty pig" renders wholly implausible Applicant's conclusory allegation that a "substantial composite of the public" perceives Opposer's NASTY PIG Mark as having a readily identifiable meaning. Moreover, even if the coined mark NASTY PIG had the specific meaning ascribed to it by Applicant, the suggestion that a meaning referring to consensual gay sex is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the

conscience or moral feelings; or calling out for condemnation” is blatantly homophobic and directly contradicted by the United States Supreme Court’s holding in *Lawrence v. Texas*, 539 U.S. 558 (2003) that consensual gay sex is a protected liberty right under the substantive due process clause of the Fourteenth Amendment. The Board should not countenance such a patently offensive claim.

Fourth, Applicant’s proposed counterclaim for fraud fails to satisfy Fed. R. Civ. P. 9(b) in that it rests on purely conclusory allegations and fails to plead requisite elements such as an intent to deceive. Applicant’s two purported grounds for fraud are also baseless. Applicant has alleged no false statements since Opposer never made any representations to the USPTO regarding the meaning of the mark NASTY PIG in connection with the prosecution of its registrations. Nor, as a matter of law, was there any omission by Opposer that could give rise to a claim for fraud based merely upon its execution of the application oath.

PROCEDURAL HISTORY AND BACKGROUND

Opposer is the owner of two federal registrations for Opposer’s NASTY PIG Mark, namely, U.S. Registration No. 2,800,386, issued on December 30, 2003, and U.S. Registration No. 4,809,230, issued on September 8, 2015. (Proposed Counterclaims ¶¶ 2-3). Opposer’s registrations cover clothing, jewelry, leather goods, and other goods and accessories, as well as the provision of retail store services and computerized online retail services in these fields. (*Id.*)

The instant opposition was instituted by Opposer on July 2, 2014 asserting a claim under Section 2(d) of the Lanham Act that there is a likelihood of confusion between Opposer’s NASTY PIG Mark and Applicant’s applied-for mark DIRTY PIG for various clothing goods in International Class 25. [Dkt. 1]. On July 22, 2014, Applicant filed its Answer in which it asserted affirmative defenses principally involving equitable doctrines (*e.g.*, laches) and

allegations of third-party use. [Dkt. 4]. Applicant's Answer did not assert any counterclaims.
(*Id.*)

In the fall of 2014, the parties served their respective First Set of Interrogatories and First Set of Requests for Production of Documents and Things. Declaration of Scott P. Ceresia ("Ceresia Decl.") ¶ 2. Opposer served its written substantive responses to Applicant's requests on November 14, 2014, and subsequently served its document production by mailing said documents to Applicant's counsel's offices in New Jersey on December 4, 2014. *Id.* ¶ 3.

Applicant continually has sought to thwart Opposer's legitimate efforts in obtaining discovery in support of its claims in this proceeding, causing Opposer to incur unnecessary cost and expense.

First, Applicant unjustifiably refused to serve responses to Opposer's interrogatories, even after Opposer in good faith amended its interrogatories to address Applicant's argument that the interrogatories exceeded the 75 numerical limitation provided in 37 C.F.R. § 2.120(d). *Id.* ¶ 4. Opposer was thus forced to file a motion to compel, which the Board granted on June 12, 2015 upon finding that Opposer's interrogatories did not exceed the numerical limitation [Dkt. 18]. Applicant finally served its interrogatory responses on July 13, 2015, nine months after the initial interrogatories had been served in October 2014. *Id.* ¶ 7.

Further, despite Opposer's service of its document production in early December 2014, Applicant refused to reciprocally mail its responsive documents to the offices of Opposer's counsel, insisting instead that Opposer's New York counsel travel approximately 2,500 miles across the country to inspect and copy Applicant's documents at its offices located in Vernon, California. *Id.* ¶ 8. Applicant persisted in such refusal even after Opposer had generously offered to pay for all necessary copying and shipping expenses, thus forcing Opposer to seek

relief from the Board. *Id.* ¶ 9. After the Board denied Opposer’s motion for an order regarding the method of Applicant’s document production [Dkt. 13], Opposer reached out to Applicant’s counsel to coordinate the logistics of inspection and copying at Applicant’s offices. *Id.* ¶ 10. On April 8, 2015, notwithstanding Applicant’s prior refusal and the ensuing motion practice, Applicant did an abrupt about-face by stating it would serve the production electronically—precisely the method of production Opposer had requested in the first instance. *Id.* ¶ 11.

Discovery in this matter closed on August 28, 2015. [Dkt. 18]. On October 12, 2015, several weeks after the close of discovery, and on the eve of the deadline for Opposer’s pretrial disclosures, Applicant filed the instant motion seeking leave to amend its Answer to assert additional affirmative defenses and counterclaims seeking to cancel Opposer’s two registrations for Opposer’s NASTY PIG Mark. [Dkt. 20]. Applicant’s claim that the mark NASTY PIG has a specific meaning in the relevant trade is based solely upon two obscure online references to the term that connote consensual gay sex acts. *See DeFrancesco Decl., Exs. A-B.* Applicant’s proposed defenses and counterclaims assert that Opposer’s registrations should be cancelled on four grounds: (1) the mark NASTY PIG is generic for the registered goods and services; (2) the mark NASTY PIG is merely descriptive of the registered goods and services; (3) the mark NASTY PIG is scandalous under Section 2(a); and (4) Opposer committed fraud on the USPTO by failing to disclose this alleged meaning of the mark NASTY PIG.

Although Applicant claims that it did not learn of this alleged meaning of the mark NASTY PIG until September 16, 2015, Applicant does not provide any credible explanation as to why it could not have asserted its proposed defenses and counterclaims based upon these publicly available materials when investigating such claims in connection with the filing of its Answer in July 2014. Applicant cannot escape that the publicly available information that

provides the sole basis for its amendments was available at the inception of this case and that instead Applicant waited approximately 15 months after the filing of its Answer, several weeks after the close of discovery and on the eve of Opposer's deadline for pretrial disclosures to seek leave to assert counterclaims which, if granted, would dramatically expand the scope and character of this proceeding. By adding several counterclaims seeking to cancel Opposer's registrations at this late stage in the proceeding, Opposer will be prejudiced by having to prepare defenses to claims that could have been previously raised or asserted at any time during the past 15 months.

Moreover, the statement by Applicant that Opposer has "concealed" information in discovery regarding the alleged meaning of the mark NASTY PIG (Br. at p. 8), is false. Opposer has produced documents concerning Opposer's adoption, selection and creation of the mark NASTY PIG—a mark that it coined twenty years ago. Ceresia Decl. ¶ 12. Opposer sharply disputes Applicant's new claim regarding this alleged meaning of the mark NASTY PIG found only in two recent and obscure online references, and it does not have any documents in its possession, custody or control concerning this alleged meaning. *Id.* ¶¶ 13-14.

ARGUMENT

I. Applicant's Motion for Leave to Amend is Untimely and Prejudicial

The granting of leave to amend a pleading is within the discretion of the Board and is allowed only "when justice so requires." Fed. R. Civ. P. 15(a). In exercising its discretion, the Board must consider such factors as "undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment,

etc.” *Foman v. Davis*, 371 U.S. 178, 182 (1962) (quoted with approval in *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (T.T.A.B. 1993)).

“The timing of the motion for leave to amend is **a major factor** in determining whether applicant would be prejudiced by allowance of the proposed amendment.” *Int’l Finance Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 1604 (T.T.A.B. 2002) (citing TBMP § 507.02) (emphasis added). Under *Foman v. Davis*, *supra*, undue delay alone is sufficient reason to deny an amendment because of its prejudicial effects on the non-moving party. *Id.* at 182. *Accord Media Online Inc. v. El Clasificado Inc.*, 88 U.S.P.Q.2d 1285, 1287 (T.T.A.B. 2008) (“A long delay in filing a motion for leave to amend may render the amendment untimely”).

Indeed, “[a]ny party who delays filing a motion for leave to amend its pleading and, in so delaying, causes prejudice to its adversary, is acting contrary to the spirit of Rule 15(a) and risks denial of that motion.” *Int’l Finance Corp.*, 64 U.S.P.Q.2d at 1604. Thus, motions for leave to amend are routinely denied where the moving party has unreasonably delayed in seeking to amend. *See, e.g., Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540, 1541 (T.T.A.B. 2001); *Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C.*, 41 U.S.P.Q.2d 1030, 1032-33 (T.T.A.B. 1996).

In the instant case, Applicant’s motion for leave to amend was not filed until nearly 15 months after its original Answer was filed in July 2014, six weeks after the close of discovery and on the eve of trial. The sole factual basis for Applicant’s proposed counterclaims regarding the alleged meaning of the mark NASTY PIG consists of screenshots from two **publicly available** websites (DeFrancesco Decl., Exs. A-B). Thus, Applicant was, or could have been made, aware of the facts giving rise to these proposed affirmative defenses and counterclaims at the time it filed its Answer over 15 months ago. This is not a case where the newly discovered

facts were uniquely in the possession of the opposing party. Apart from gamesmanship, there is no justification for Applicant's inordinate and prejudicial delay.

Applicant's claim that it only recently "learned" the basis for its proposed counterclaims is unavailing. The Board's decision in *Media Online Inc. v. El Clasificado Inc.*, 88 U.S.P.Q.2d 1285 (T.T.A.B. 2008) underscores that a party has a duty to promptly investigate any potential claims or counterclaims, and is obligated to timely assert all claims based upon facts that are known or could easily have been known. In *Media Online*, the petitioner sought leave to amend to assert additional claims for descriptiveness and fraud. In denying the motion to amend as untimely and prejudicial, the Board held:

[I]n support of its descriptiveness and fraud claims, *petitioner appears to have consulted dictionary definitions and accessed respondent's web site, actions which could quite easily have been undertaken prior to filing of the petition to cancel, or by any prompt investigation conducted immediately thereafter.* Petitioner waited over seven months, however, and until after respondent's motion for judgment before filing the motion for leave to amend its pleading to add the two additional claims.

Id. at 1286-87 (emphasis added). *Accord* 37 C.F.R. § 2.106(b)(2)(i) ("A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim *exist at the time when the answer is filed*") (emphasis added); *Kellogg Co. v. Shakespeare Co., LLC*, Opp. No. 91154502, 2005 TTAB LEXIS 284, at *9 (T.T.A.B. Jun. 30, 2005) (denying motion where "[o]pposer offers no explanation or sufficient justification as to why it failed to raise these claims at the time of filing the notice of opposition when opposer had in its possession sufficient facts to allege such claims and/or through reasonable effort could have known of these claims"); *Long John Silver's Inc. v. Lou Scharf Inc.*, 213 U.S.P.Q. 263, 265 (T.T.A.B. 1982) (denying motion where opposer knew or should have known of new grounds at the time the original opposition was filed).

Similarly here, Applicant cannot justify its excessive delay when the alleged basis underlying these proposed claims was either known to it, or could have been known to it through reasonable efforts, at the time it filed its Answer in July 2014 or at any time in the intervening 15 months. Instead, Applicant sat on its hands and waited until after the close of discovery and the eve of trial to ambush Opposer with its motion seeking to assert counterclaims that could have been asserted at the inception of this case. Such excessive delay in of itself warrants denial of the motion. To hold otherwise would encourage dilatory parties to game the system by refraining from diligently investigating potential claims and then feigning ignorance when it came time to justify a belated motion to amend.²

Additionally, Opposer would be prejudiced by such a drastic change to the pleadings at this advanced juncture. Based on the parties' operative pleadings, the sole issue to be determined in this proceeding—and the only issue upon which the parties have taken discovery over the past 15 months—is whether there is a likelihood of confusion between Opposer's NASTY PIG Mark and Applicant's applied-for mark DIRTY PIG. Now, with discovery closed and the testimony periods about to commence, Applicant seeks fundamentally to alter the nature of this proceeding by amending its Answer to include counterclaims seeking to cancel Opposer's registrations based on issues of genericness, descriptiveness, scandalousness and fraud. These are wholly new issues that would substantially expand the complexity of this case, would require the reopening of discovery on these issues and would cause Opposer to incur vastly increased

² Nor can Applicant excuse its excessive delay by falsely claiming that Opposer "concealed" information in discovery regarding this alleged meaning. Opposer has produced in discovery documents concerning the conception, adoption and selection of Opposer's NASTY PIG Mark (Ceresia Decl. ¶ 12), which confirm that the mark is a coined term whose adoption had no connection to the meaning now being ascribed to it by Applicant.

time and expense. In the interests of justice, the Board should act to prevent such prejudice to Opposer by denying the motion as untimely.

II. Applicant's Proposed Counterclaims Are Futile

The Board also should deny Applicant's motion for leave to amend on the additional ground that the four proposed counterclaims fail as a matter of law and are, thus, futile.³

In order to satisfy the requirements of Federal Rule 8, "a plaintiff must allege well-pleaded factual matter and more than 'threadbare recitals of the elements of a cause of action, supported by mere conclusory statements,' to state a claim plausible on its face." *Great Adirondack Steak & Seafood Cafe, Inc. v. Adirondack Pub & Brewery, Inc.*, Opp. No. 91219162, 2015 TTAB LEXIS 321, at *10 (T.T.A.B. Mar. 30, 2015) (citing *Ashcroft v. Iqbal*, 556 U.S. 662 (2009)). While, pursuant to Fed. R. Civ. P. 15(a), leave to amend "shall be freely given when justice so requires," the Board should deny a motion for leave to amend where the proposed amendment would be futile since it would not survive a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6). See *Institut Nat'l des Appellations d'Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875, 1896 (T.T.A.B. 1998) (denying amendment that would be futile). Thus, "[w]here the moving part seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, the Board normally will deny the motion for leave to amend." *Trek Bicycle*, 64 U.S.P.Q.2d at 1541.

³ Applicant also seeks to add affirmative defenses nine through twelve based upon these same allegations of genericness, descriptiveness and fraud. Applicant's proposed defenses are subsumed within our discussion of its proposed counterclaims premised on the same grounds.

A. Applicant's Proposed Counterclaim for Genericness Is Futile

Applicant's first claim asserts that the registered mark NASTY PIG is generic for Opposer's registered goods and services, namely, clothing, bedding, leather goods, accessories, and retail services.

This claim is not plausible on its face. Indeed, Applicant studiously avoids mention of the proper test for genericism, the elements of which doom Applicant's claim even at the pleading stage. The Federal Circuit has recently confirmed that the two-part test for genericness asks: "First, what is the genus of the goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986)). There is no plausible basis – and Applicant alleges none – for the proposition that the mark NASTY PIG refers to the genus of the registered goods and services, let alone that the relevant public would understand the mark to primarily refer to the genus of those goods and services. Opposer's registered clothing and related goods and services do not constitute pigs.

Accordingly, this proposed counterclaim must be denied as futile.

B. Applicant's Proposed Counterclaim for Descriptiveness Is Futile

Next, Applicant has asserted a time-barred claim under Section 2(e) of the Lanham Act based on mere descriptiveness despite the clear statutory provision that prohibits asserting such a claim against Opposer's incontestable U.S. Reg. No. 2,800,386 for the mark NASTY PIG.

Pursuant to Section 14 of the Lanham Act, "[a] petition to cancel a registration issued on the Principal Register under the Act of 1946, on a ground not specified in [Sections 14(3) or

14(5) of the Lanham Act] must be filed within five years from the date of the registration of the mark.” T.B.M.P. § 307.02(a). Section 14(3) does *not* include grounds specified under Section 2(e) of the Lanham Act, including claims that a mark is merely descriptive. Thus, it is well-established that “once a registration is more than five years old, the grounds on which it may be cancelled . . . do not include the ground of mere descriptiveness.” *Life Enhancement Ctr. v. CR License, LLC*, Cancellation No. 92057149, 2014 TTAB LEXIS 334, at *25 (T.T.A.B. Aug. 1, 2014). Accordingly, this proposed counterclaim is time-barred and unavailable to Applicant. *See, e.g., Deckers Outdoor Corp. v. Shoe Show, Inc.*, Cancellation No. 92028287, 2004 TTAB LEXIS 567, at *20 n.7 (T.T.A.B. Sept. 14, 2004) (mere descriptiveness unavailable as ground for cancellation because registration was more than five years old).

Moreover, with respect to Opposer’s U.S. Reg. No. 4,809,230 for the mark NASTY PIG, which issued in September 2015, Applicant does not state a plausible claim required under Federal Rule 8. First, Applicant’s proposed counterclaim fails to specifically identify the alleged meaning of the mark NASTY PIG, relying on the impermissibly vague assertion that it refers to “a particular person or associated lifestyle.” (Proposed Counterclaims, ¶ 4). Even if one assumes that this refers to the alleged meaning of the mark NASTY PIG reflected in the two online references attached to Applicant’s motion papers (DeFrancesco Decl., Exs. A-B), the allegation of descriptiveness is implausible since the mark NASTY PIG does not “immediately describes an ingredient, quality, characteristic or feature” of the registered goods and services. *See, e.g., In re Oldcastle Glass, Inc.*, Serial No. 76/372,028, 2004 TTAB LEXIS 260, at *4 (T.T.A.B. Apr. 29, 2004).

While the Board has in rare instances held that a mark can be descriptive where it describes the intended users of the goods or services, those cases involve a direct correlation

between the mark and the applied-for goods or services. See *In re Camel Mfg. Co.*, 222 U.S.P.Q. 1031, 1032 (T.T.A.B. 1984) (MOUNTAIN CAMPER for “retail and mail order services in the field of outdoor equipment and apparel” held descriptive of intended users). In contrast, Opposer’s registered clothing and related goods and services are unqualified and make no reference to pigs. Moreover, a “nasty pig” is not an identifiable demographic or subpopulation that could conceivably describe the intended users of Opposer’s goods and services. Thus, Applicant fails to allege a plausible claim that the mark NASTY PIG is merely descriptive.

C. Applicant’s Proposed Counterclaim for Scandalousness Is Futile

Applicant’s third proposed counterclaim alleges that Opposer’s registrations for the mark NASTY PIG should be cancelled on the basis that the mark NASTY PIG is scandalous under Section 2(a). In order to state a claim that a mark is scandalous under Section 2(a) of the Lanham Act, the moving party must plausibly allege that: (1) there is a likely meaning of the matter in question; and (2) in view of the likely meaning, the matter is scandalous to a substantial composite of the general public. *In re Mothers & Fathers Italian Ass’n*, Serial No. 75/197,967, 2000 TTAB LEXIS 52, at *6 (T.T.A.B. Feb. 11, 2000). For reasons set forth below, Applicant’s proposed counterclaim fails plausibly to allege either element.

First, there is no plausible basis for the proposition that Opposer’s coined mark NASTY PIG has any identifiable meaning apart from functioning as a source identifier for Opposer’s goods and services. The *sole* support for Applicant’s claim that the mark NASTY PIG has a specific meaning in the relevant trade consists of two obscure online references (DeFrancesco Decl., Exs. A-B). Such material is insufficient to establish plausibly that this coined mark has *any* single, readily understood meaning – let alone that such meaning is recognized by a substantial composite of the general public. *Accord Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)

(a complaint “must contain *sufficient factual matter*, accepted as true, to ‘state a claim to relief that is plausible on its face’”) (emphasis added). *Cf.* TMEP § 1203.01 (stating a term may be deemed vulgar “where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant’s use of the word is limited to the vulgar meaning of the word”). The fact that it purportedly took Applicant’s attorneys over 15 months even to discover this alleged meaning renders wholly implausible its allegation that such meaning is recognized by a substantial composite of the general public.

Moreover, even if one were to assume that the coined mark NASTY PIG has the specific meaning ascribed to it by Applicant, Applicant’s proposed counterclaim fails to plausibly allege that a substantial composite of general public would regard this mark as scandalous within the meaning of Section 2(a). A scandalous mark is one defined as “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation.” *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). Further, the meaning imparted by a mark must be made “in the context of contemporary attitudes” and “in the context of the marketplace as applied to only the goods described in [the registration].” *Id.*

Thus, Applicant’s proposed counterclaim is premised upon the assertion that, according to contemporary U.S. attitudes, a term that allegedly refers to consensual gay sex is somehow “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; or calling out for condemnation.” Not only is such an assertion unmistakably homophobic in nature, but it is wholly implausible in light of contemporary U.S. attitudes as reflected in recent Supreme Court jurisprudence, including the United States Supreme Court’s decisions in *Lawrence v. Texas*, 539 U.S. 558 (2003), that

consensual gay sex is a protected liberty right under the substantive due process clause of the Fourteenth Amendment, and *Obergefell v. Hodges*, 576 U.S. ____ (2015), recognizing that gay couples have the right to marry protected under the equal protection and substantive due process clauses of the Fourteenth Amendment. *Accord In re Engine 15 Brewing Co., LLC*, Serial No. 86/038,803, at page 9 (T.T.A.B. Oct. 29, 2015) (“For decades now this tribunal has observed that contemporary attitudes toward coarse language are more accepting than they had been in earlier eras”); *In re Thomas Labs., Inc.*, 189 U.S.P.Q. 50, 52 (T.T.A.B. 1975) (“it is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable”). Moreover, Applicant cannot plausibly claim that Opposer’s NASTY PIG Mark is “scandalous” to a substantial composite of the general public when Applicant has adopted the functionally equivalent mark DIRTY PIG.

For all of the foregoing reasons, Applicant’s proposed counterclaim that Opposer’s NASTY PIG Mark is “scandalous” under Section 2(a) should be denied as futile.

D. Applicant’s Proposed Counterclaim for Fraud Is Futile

To assert a viable claim for fraud on the USPTO, a party must allege with particularity that the registrant knowingly made a false, material representation in the procurement of a registration with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009). Here, Applicant alleges that Opposer fraudulently obtained its registrations for Opposer’s NASTY PIG Mark by making a material misrepresentation to the USPTO regarding the alleged meaning of the mark. This claim is subject to dismissal on several grounds.

First, a claim for fraud “needs to be alleged with a heightened degree of particularity in compliance with Fed. R. Civ. P. 9(b).” *Great Adirondack Steak & Seafood Cafe*, 2015 TTAB LEXIS 321, at *14. Because Applicant’s claim fails to identify the who, what, when or where of

the allegedly false statements, but instead relies on wholly conclusory allegations that merely parrot elements of the claim, Applicant's allegations of fraud fail to satisfy the specificity requirements of Federal Rule 9(b). *See W. R. Grace & Co. v. Arizona Feeds*, 195 U.S.P.Q. 670 (Comm'r Pat. 1977) (affirming denial of leave to amend where allegations of fraud were not set forth with particularity). Moreover, conspicuously absent from Applicant's proposed pleading is any allegation that Opposer acted with an intent to deceive the USPTO, a required element of a claim for fraud. *See Great Adirondack Steak & Seafood Cafe*, 2015 TTAB LEXIS 321, at *21 ("intent is an indispensable element of a fraud claim and intent has not been pleaded here").

Even beyond these patent pleading deficiencies, Applicant's asserted grounds for fraud are specious. First, the allegation that Opposer made a materially false representation "that 'Nasty Pig' has no meaning in the relevant trade" (Proposed Counterclaims, ¶ 7) is objectively untrue, as the USPTO never requested, and Opposer never made, any representations regarding the meaning of the mark NASTY PIG in connection with its registrations. The absence of any false statement by Opposer further dooms this claim. *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1928 (T.T.A.B. 2014) ("Because a false statement is one of the critical elements in proving fraud, the fraud claim is insufficient").

To the extent Applicant bases this claim on Opposer's purported failure to disclose to the USPTO the alleged meaning of the mark NASTY PIG, this fails to constitute fraud as a matter of law since an applicant's obligation not to make knowingly misleading statements "does not require an applicant to disclose the exact significance of a term to the U.S. Patent and Trademark Office upon filing an application." *John Abate Int'l, Inc. v. Miller*, Cancellation No. 28,890, 2001 TTAB LEXIS 528, at *13 (T.T.A.B. July 18, 2001) (citing *Bart Schwartz Int'l Textiles, Inc. v. FTC*, 289 F.2d 665 (C.C.P.A. 1961)). Thus, an allegation that an applicant failed to

disclose the descriptive nature of a mark fails to constitute fraud as a matter of law. *Id.* at *13-14 (dismissing fraud claim based on failure to disclose allegedly descriptive significance of mark).⁴

In contrast, for purposes of fraud, “any duty owed by applicant must arise out of the statutory requirements of the Trademark Act, particularly those found in Section 1(a)(1)(A) or Section 1(b)(1)(A) which require merely that applicant verify a statement that no other person, to the best of his or her knowledge and belief, has the right to use the mark in commerce.” *Id.* at *13. Thus, the allegation by Applicant that Opposer’s execution of its application oath attesting to the exclusive right to the use the mark NASTY PIG constituted fraud (Proposed Counterclaims, ¶ 7) is legally untenable inasmuch as fraud based upon the application oath concerns only whether the applicant knew of third-party users with superior trademark rights in the mark. *See, e.g., Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1206 (T.T.A.B. 1997) (setting forth four-factor test for fraud claims based upon application oath). Because Applicant makes no allegations that Opposer was aware of any third parties with superior trademark rights in the mark NASTY PIG, its claim for fraud based upon the application oath must fail.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that Applicant’s Motion for Leave to Amend Answer to Add Additional Affirmative Defenses and Petition to Cancel be denied in its entirety.

⁴ Furthermore, even where an applied-for mark has a descriptive significance, there is no false statement—and thus no fraud as a matter of law—for an applicant to attest to the exclusive right to use the term as a trademark since descriptive terms are registrable upon a showing of secondary meaning.

Dated: New York, New York
November 2, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Joel Karni Schmit/
Joel Karni Schmidt
Eric J. Shimanoff
Scott P. Ceresia
1133 Avenue of the Americas
New York, New York 10036
(212) 790-9200

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER TO ADD ADDITIONAL AFFIRMATIVE DEFENSES AND PETITION TO CANCEL to be sent via first class, postage paid mail to Applicant Janoskians LLC's Attorney and Correspondent of Record, Stephen L. Baker, Esq., Baker and Rannels, P.A., 575 Route 28, Raritan, New Jersey 08869-1354.

Dated: New York, New York
November 2, 2015

/Scott P. Ceresia/
Scott P. Ceresia

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

In the Matter of Application Serial No. 86/085,785
Filed: October 8, 2013
For Mark: DIRTY PIG
Published in the Official Gazette of March 4, 2014

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NASTY PIG, INC.,		:	
	Opposer,	:	Opposition No. 91217154
		:	
v.		:	
JANOSKIANS LLC,		:	
	Applicant.	:	
-----		X	

**DECLARATION OF SCOTT P. CERESIA IN OPPOSITION TO APPLICANT’S
MOTION FOR LEAVE TO AMEND ANSWER TO ADD ADDITIONAL AFFIRMATIVE
DEFENSES AND PETITION TO CANCEL**

SCOTT P. CERESIA, pursuant to 28 U.S.C. § 1746, declares as follows:

1. I am an associate at the law firm of Cowan, Liebowitz & Latman, P.C., attorneys for Opposer Nasty Pig, Inc. (“Opposer”) in this matter. I submit this declaration in opposition to Applicant Janoskians, LLC’s (“Applicant”) Motion for Leave to Amend Answer to Add Additional Affirmative Defenses and Petition to Cancel.

2. In the fall of 2014, the parties served their respective First Set of Interrogatories and First Set of Requests for Production of Documents and Things.

3. Opposer served its written substantive responses to Applicant’s requests on November 14, 2014, and subsequently served its document production by mailing said documents to Applicant’s counsel’s offices in New Jersey on December 4, 2014.

4. Applicant refused to serve responses to Opposer's interrogatories, even after Opposer in good faith amended its interrogatories to address Applicant's argument that the interrogatories exceeded the 75 numerical limitation provided in 37 C.F.R. § 2.120(d).

5. Due to Applicant's refusal to serve its interrogatory responses, Opposer was forced to file a motion to compel.

6. On June 12, 2015, the Board granted Opposer's motion to compel upon finding that Opposer's interrogatories did not exceed the numerical limitation [Dkt. 18].

7. Applicant finally served its interrogatory responses on July 13, 2015, nine months after the initial interrogatories had been served in October 2014.

8. Despite Opposer's service of its document production in early December 2014, Applicant refused to reciprocally mail its responsive documents to the offices of Opposer's counsel, insisting instead that Opposer's New York counsel travel approximately 2,500 miles across the country to inspect and copy Applicant's documents at its offices located in Vernon, California.

9. Because Applicant persisted in such refusal even after Opposer had generously offered to pay for all necessary copying and shipping expenses, Opposer was forced to seek relief from the Board.

10. After the Board denied Opposer's motion for an order regarding the method of Applicant's document production [Dkt. 13], Opposer reached out to Applicant's counsel to coordinate the logistics of inspection and copying at Applicant's offices.

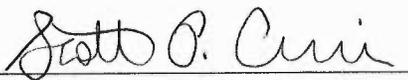
11. On April 8, 2015, notwithstanding Applicant's prior refusal and the ensuing motion practice, Applicant did an abrupt about-face by stating it would serve the production electronically—precisely the method of production Opposer had requested in the first instance.

12. The statement by Applicant that Opposer has “concealed” information in discovery regarding the alleged meaning of the mark NASTY PIG (Br. at p. 8), is false. Opposer has produced documents concerning its adoption, selection and creation of the mark NASTY PIG twenty years ago.

13. Opposer sharply disputes Applicant's new claim regarding this alleged meaning of the mark NASTY PIG found only in two recent and obscure online references.

14. Opposer does not have any documents in its possession, custody or control concerning this alleged meaning that Applicant is now ascribing to the mark NASTY PIG.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON NOVEMBER 2, 2015 AT NEW YORK, NEW YORK.


Scott P. Ceresia

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing DECLARATION OF SCOTT P. CERESIA IN OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER TO ADD ADDITIONAL AFFIRMATIVE DEFENSES AND PETITION TO CANCEL to be sent via first class, postage paid mail to Applicant Janoskians LLC's Attorney and Correspondent of Record, Stephen L. Baker, Esq., Baker and Rannells, P.A., 575 Route 28, Raritan, New Jersey 08869-1354.

Dated: New York, New York
November 2, 2015

/Scott P. Ceresia/
Scott P. Ceresia