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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.
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Attachments	DIRTY PIG - Reply in Support of Motion to Consolidate.pdf(31405 bytes )

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

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NASTY PIG, INC.,		:	
	Opposer,	:	Opposition No. 91217154
		:	
v.		:	
JANOSKIANS LLC,		:	
	Applicant.	:	
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NASTY PIG, INC.,		:	
	Opposer,	:	Opposition No. 91220407
		:	
v.		:	
FITUMI, LLC,		:	
	Applicant.	:	
-----		X	

**REPLY IN FURTHER SUPPORT OF MOTION TO CONSOLIDATE  
OPPOSITION PROCEEDINGS**

Applicant Janoskians LLC’s (“Janoskians”) opposition papers fail to rebut Opposer Nasty Pig, Inc.’s (“Opposer”) showing that the Board should consolidate the subject oppositions involving the applications filed by Applicants Janoskians and Fitumi, who are, respectively, the record owner of the DIRTY PIG mark and the company responsible for the sale and distribution of the DIRTY PIG goods. Pursuant to TBMP § 502.03, Opposer respectfully submits this reply memorandum to respond to new issues raised in Janoskians’ opposition papers.

As set forth more fully below, contrary to Janoskians’ claim, the Board has historically ordered consolidation where, as here, there are common issues of law and fact (including claims of likelihood of confusion based upon the same core allegation), substantially similar marks and

closely related (if not identical) goods, and where consolidation would otherwise result in a substantial savings of time, effort and expense. Janoskians' opposition papers also confirm that its interests are sufficiently aligned with Fitumi for purposes of consolidation, and, in any event, the TBMP expressly states that an identity of parties is not necessary.

Moreover, Applicants' bold assertion that Opposer seeks consolidation in order "to harass and embarrass" Applicants with the "sole purpose of negatively impacting [their] business for its own personal gain" (Swanson Decl. ¶ 19; Skaller Decl. ¶ 16), represents the height of audacity. It was Fitumi who, after responding on Janoskians' behalf to Opposer's demand letter concerning the DIRTY PIG Application, filed three sham trademark applications all consisting of the terms "NASTY" and/or "PIG" – including the subject RAUNCHY PIG Application – for clearly retaliatory purposes and to gain leverage in the parties' existing dispute concerning the DIRTY PIG Application. Applicants cannot be heard to complain about consolidation when, self-evidently, there would be no other opposition proceeding in which to consolidate had Applicants not engaged in such bad-faith gamesmanship and abuse of the USPTO procedures.

For the foregoing reasons, Opposer's motion to consolidate should be granted.

### **ARGUMENT**

None of the arguments advanced by Janoskians in its opposition papers refutes Opposer's showing that the two subject proceedings – involving closely aligned parties, the substantially similar marks DIRTY PIG and RAUNCHY PIG, closely related Class 25 apparel goods, and claims that such marks are likely to cause confusion with Opposer's NASTY PIG mark based upon the same core allegation – warrant consolidation under the TBMP and relevant Board precedents.

**A. Consolidation Prior to Joinder of Issue is Appropriate In this Case**

As a threshold matter, Applicant's claim that the Board may not consolidate the proceedings before joinder of issue unless "[the] parties are identical and or agree to consolidate" (Opp. Br. at p. 4), is without merit. There is no legal support for such a limitation, nor does Janoskians provide any. Rather, the TBMP states generally, without any qualification, that "the Board may, in its discretion, order cases consolidated prior to joinder of issue." See TBMP § 511. In the case at bar, consolidation pre-joinder of issue is particularly appropriate here where the evidence indicates that the later-filed RAUNCHY PIG Application is a sham application that was filed purely to gain leverage in the parties' pre-existing dispute concerning the DIRTY PIG Application. Opposer submits that this is precisely the type of circumstance in which the Board is empowered to exercise its discretion to consolidate proceedings prior to joinder of issue.

**B. The Proceedings Involve Substantially Similar Marks, Identical and/or Closely Related Class 25 Goods, and Commons Questions of Law and Fact**

Janoskians does not, nor can it, dispute the fact that the subject proceedings involve: (1) substantially similar PIG-formative marks each of which contains a two-syllable first term – DIRTY or RAUNCHY – having a connotation that is extremely similar (if not identical) to the term "NASTY" prominently featured in Opposer's NASTY PIG Mark; (2) identical and/or closely related Class 25 goods; and (3) resulting common questions of law and fact, principally concerning claims for likelihood of confusion. Janoskians instead asserts a litany of arguments that find no basis in the TBMP or TTAB case law.

First, contrary to Applicant's contention, the Board has never held that an identity of marks is a prerequisite to consolidation. In fact, the Board routinely grants consolidation notwithstanding differences in the applied-for marks, particularly where, as here, the oppositions are based on the opposer's rights in the same mark. See Dating DNA, LLC v. Imagini Holdings,

Ltd., 94 U.S.P.Q.2d 1889, 1893 (T.T.A.B. 2010) (ordering consolidation of two opposition proceedings that involved “similar marks and related or identical issues” that had been challenged on the basis of opposer’s ownership of the same marks); World Hockey Ass’n v. Tudor Metal Prods. Corp., 185 U.S.P.Q. 246, 248 (T.T.A.B. 1975) (ordering consolidation where applied-for marks were substantially similar and opposer challenged both applications on the basis of its ownership of the same mark). See also Ritchie v. Simpson, 41 U.S.P.Q.2d 1859, 1860 (T.T.A.B. 1996), rev’d on other grounds, 170 F.3d 1092 (Fed. Cir. 1999) (consolidating oppositions against applications for marks O.J., O.J. SIMPSON, and THE JUICE “despite the variations in the marks and goods involved”).<sup>1</sup> Similarly here, Opposer’s claims of likelihood of confusion are premised upon the same core allegation, namely, that Applicants’ subject two-word marks comprised of the term “PIG” immediately preceded by a two-syllable first term carrying a connotation that is extremely similar (if not identical) to the term “NASTY” is likely to cause confusion with Opposer’s NASTY PIG Mark.<sup>2</sup>

Likewise unavailing is Applicant’s argument that because Opposer has alleged a claim of lack of bona fide intent against Fitumi and not Janoskians, “the matters are dissimilar.” Opp. Br. at p. 9. First, Opposer’s claim for lack of bona fide intent against Fitumi implicates questions of fact common to both proceedings, since the RAUNCHY PIG Application subject to this claim was filed in direct response to the parties’ existing dispute concerning the DIRTY PIG

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<sup>1</sup> Janoskians’ citation to *Envirotech Corp. v. Salorn Corp.*, 211 U.S.P.Q. 724 (T.T.A.B. 1981), does not hold otherwise as that case involved different design marks and, in any event, the Board later consolidated the records of the cases for purposes of rendering a dispositive decision.

<sup>2</sup> Janoskians’ inclusion of a table that purports to list marks of various assortments involving the term “PIG” in Class 25 (Opp. Br. at pp. 6-7), is immaterial. Opposer is not “claiming exclusive ownership to the word PIG in International Class 25,” as Janoskians suggests. Rather, Opposer is claiming a likelihood of confusion between Opposer’s NASTY PIG Mark and Applicants’ two-word marks involving the word PIG immediately preceded by a two-syllable first term with an extremely similar (if not identical) connotation to the word “NASTY,” such that the marks exhibit remarkably similar overall commercial impressions.

Application. *See* RAUNCHY PIG Not. Opp. ¶¶ 12-17. Moreover, the standard for consolidation is not whether all issues in both proceedings are identical, but rather whether there are one or more “common” questions of law or fact such that consolidation would lead to a savings of time and expense and otherwise serve the interests of judicial economy. *See* Fed. R. Civ. P. 42(a) (“involve a common question of law or fact”); TBMP § 511 (“involving common questions of law or fact”). For reasons described above, Opposer’s claims for likelihood of confusion based upon the same core allegation, in of themselves, satisfy this standard.

Finally, Applicant’s suggestion that consolidation should be denied because the Class 25 goods are “different,” is wholly without merit. As the cases cited by Janoskians make clear, the standard is whether the goods are closely related such that common issues of law and fact are implicated—a standard that is also clearly met in this case. *See No Fear, Inc. v. Victor Des Prez*, Opp. Nos. 99,956 and 102,786, 1997 TTAB LEXIS 140, at \*1 (T.T.A.B. Nov. 4, 1997) (consolidating oppositions where applications identified related Class 25 goods, namely, men’s, women’s and children’s footwear versus men’s and women’s clothing). Moreover, not only are the Class 25 goods at issue closely related, but in many instances **identical** as the applications involve numerous overlapping apparel items, including, without limitation, sweatshirts, pants, leggings, footwear, shorts, jackets, sleepwear, and pajamas. *See* Opp. Br. at p. 8 (listing Class 25 goods subject to DIRTY PIG Application and RAUNCHY PIG Application).

**C. The TBMP Expressly Does Not Require an Identity of Parties As A Prerequisite to Consolidation**

Janoskians places great emphasis on the fact that it and Fitumi are allegedly “separate and distinct” companies. Opp. Br. at p. 5. However, even assuming this is true, that fact does not pose any bar to consolidation. The TBMP expressly provides that, “[a]lthough identity of the

parties is another factor considered by the Board in determining whether consolidation should be ordered, it is not always necessary.” TBMP § 511 (emphasis added).

Moreover, based on the facts of this case, it cannot be disputed that Applicants are closely affiliated companies whose interests are sufficiently aligned for purposes of consolidation. In this regard, Opposer emphasizes the following:

(1) Applicants Janoskians and Fitumi are, respectively, the record owner of the DIRTY PIG Application and the company self-identified as “responsible for sales and distribution of the Brand Dirty Pig” (*see* RAUNCHY PIG Not. Opp., Ex. B (Fitumi’s May 13, 2014 letter));

(2) Fitumi responded on Janoskians’ behalf in replying to Opposer’s demand letter concerning the DIRTY PIG Application, in which it appeared to make reference to Janoskians as an “affiliate” and referred to the mark DIRTY PIG as “our brand” (*see id.*); and

(3) on or about the day Fitumi sent that response letter, Fitumi filed three sham trademark applications, all consisting of the terms “NASTY” and/or “PIG,” in a clear attempt to retaliate against Opposer and to improperly gain leverage against Opposer in the parties’ existing dispute concerning the DIRTY PIG Mark.

Based upon the foregoing facts, Janoskians’ feeble attempt to portray itself as a disinterested outsider and to disclaim any involvement in the filing of these sham applications simply cannot be credited.<sup>3</sup>

Finally, as a procedural matter, the repeated claim that Opposer’s citation to Fitumi’s May 13, 2014 letter responding to Opposer’s demand letter concerning the DIRTY PIG Application violated Federal Rule of Evidence 408 (*see, e.g.*, Opp. Br. at p. 2), is wholly without merit and is based upon a misreading of that rule. FRE 408 provides in relevant part:

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<sup>3</sup> Of particular note, despite Fitumi’s prior admission in its May 13, 2014 letter that it serves as the sales and distribution arm of the DIRTY PIG brand, Fitumi now claims on this motion, without any hint of credibility, that “Fitumi does not conduct business with Janoskians.” Swanson Decl. ¶ 5. Such a statement contradicts not only Fitumi’s prior express admission but also its prior actions in explicitly acting on Janoskians’ behalf and even filing sham applications in response to the parties’ existing dispute concerning Janoskians’ DIRTY PIG Application. These are not the actions of companies that have no business relationship with one another.

(a) **Prohibited Uses.** Evidence of the following is not admissible — on behalf of any party — *either to prove or disprove the validity or amount of a disputed claim* or to impeach by a prior inconsistent statement or a contradiction:

(1) furnishing, promising, or offering — or accepting, promising to accept, or offering to accept — a valuable consideration in compromising or attempting to compromise the claim; and

(2) conduct or a statement made during compromise negotiations about the claim — except when offered in a criminal case and when the negotiations related to a claim by a public office in the exercise of its regulatory, investigative, or enforcement authority.

Fed. R. Evid. 408 (emphasis added).

Even assuming that Fitumi’s letter refusing to comply with any of the demands set forth in Opposer’s letter could be credibly construed as an offer to settle or compromise a claim, by its express terms, FRE 408 forbids the use of such communications **only** where they are introduced for the purpose of proving or disproving “the validity or amount of a disputed claim.” FRE 408 does not, as Applicants appear to believe, impose an absolute bar on the introduction of such communications. On the contrary, it is well-settled that “Fed. R. Evid. 408[] permits such evidence to be received *for a purpose other than* to prove or disprove the validity of the claims that the [offer was] meant to settle.” Carvajal v. Mihalek, 453 F. App’x 69, 73 (2d Cir. 2011) (emphasis added). Accord In re MSTG, Inc., 675 F.3d 1337, 1345 (Fed. Cir. 2012) (“Rule 408 itself contemplates a host of scenarios under which documents related to settlement negotiations would be admissible for purposes other than ‘prov[ing] or disprov[ing] the validity or amount of a disputed claim or [] impeach[ing] by a prior inconsistent statement or a contradiction’”); Cent. Mfg. Co. v. Outdoor Innovations, L.L.C., Opp. No. 110,966, 2003 TTAB LEXIS 189, at \*3-5 (T.T.A.B. Apr. 17, 2003) (settlement communications were admissible where they were introduced by party for purpose other than establishing liability, namely, “for the limited purpose of supporting applicant’s argument that opposer’s actions, including the filing of a summary

judgment motion, are part of an effort to ‘obstruct prosecution’ [of applicant’s trademark application]”).

Here, Opposer cited to Fitumi’s letter for limited purposes **other than** proving the validity or amount of Opposer’s claim, namely to demonstrate (1) that Applicants are closely aligned companies in which Fitumi responded on behalf of Janoskians in replying to Opposer’s demand letter concerning the DIRTY PIG Application, and (2) the uncanny timing and factually interrelated nature of the subject applications in which the three sham trademark applications, including the subject RAUNCHY PIG Application, were filed on the very day or the day after Fitumi sent the May 13, 2014 letter regarding the DIRTY PIG Application. Because Opposer referenced Fitumi’s May 13, 2014 letter for limited purposes other than proving the validity or amount of the claim, ergo, there was no violation of FRE 408.

**D. Applicant Has Identified No Prejudice That Would Outweigh the Substantial Savings in Time, Effort and Expense Achieved by Consolidation**

Finally, unable to dispute the substantial savings in time, effort and expense that would be achieved by consolidation of the two subject proceedings, Janoskians seeks to manufacture a claim of “prejudice” that is entirely of Applicants’ own making. Specifically, Janoskians asserts that “the attempt by Opposer to combine proceedings against unrelated parties suggests that Opposer’s intent is to interfere with any business or prospect of doing business between Janoskians and other parties.” Opp. Br. at p. 9.

The sheer boldness of this claim can hardly be overstated. First, Applicants are not “unrelated” parties; they are the record owner and sales/distribution arm of the DIRTY PIG brand who refer to one another as “affiliates.” Moreover, it was **Applicants** who chose to unnecessarily broaden a straightforward dispute concerning the DIRTY PIG Application by causing to be filed three sham trademark applications, including the subject RAUNCHY PIG

Application, in order to improperly gain leverage against Opposer in the parties' existing dispute. Opposer would have gladly preferred to have kept the parties' dispute confined to the DIRTY PIG Application instead of having to undertake the expense of opposing the RAUNCHY PIG Application which all evidence indicates was filed in bad faith and without bona fide intent. Any potential adverse impact on business relations was caused by the concerted actions of Applicants, not Opposer.

Simply put, Janoskians is estopped from claiming prejudice when there would not even **be** another opposition proceeding requiring the instant motion to consolidate had Applicants refrained from engaging in such gamesmanship and abuse of the USPTO procedures.<sup>4</sup>

### **CONCLUSION**

For the foregoing reasons and those previously set forth in Opposer's moving papers, Opposer respectfully requests that the Board grant Opposer's motion to consolidate Opposition No. 91217154 with Opposition No. 91220407.

Dated: New York, New York  
February 24, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
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<sup>4</sup> Janoskians also asserts, without elaboration, that Opposer is "attempting to create a cause of action between Janoskian and Fitumi and possibly make it face having to waive privilege with Fitumi to defend itself." Opp. Br. at p. 10. To the extent this claim is even discernible, it is meritless. Consolidation would in no way affect any claims of privilege or other applicable immunity Janoskians may have against Fitumi or any other party. It would simply enable efficiencies in the management and prosecution of oppositions involving common questions of law and fact, substantially similar marks and closely related and/or identical Class 25 goods.

**CERTIFICATE OF SERVICE**

I hereby certify that I caused a copy of the foregoing REPLY IN FURTHER SUPPORT OF MOTION TO CONSOLIDATE OPPOSITION PROCEEDINGS 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  
February 24, 2015

/Scott P. Ceresia/  
Scott P. Ceresia