

ESTTA Tracking number: **ESTTA652776**

Filing date: **01/28/2015**

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

**Notice of Opposition**

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

**Opposer Information**

Name	Nasty Pig, Inc.
Granted to Date of previous extension	02/04/2015
Address	170 West 23rd St., Apt. 4V New York, NY 10011 UNITED STATES
Attorney information	Joel Karni Schmidt Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES jks@cll.com, spc@cll.com, mxs@cll.com, trademark@cll.com Phone:212-790-9200

**Applicant Information**

Application No	86280433	Publication date	10/07/2014
Opposition Filing Date	01/28/2015	Opposition Period Ends	02/04/2015
Applicant	Fitumi, LLC 2133 East 38th Street Vernon, CA 90058 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Thong beachwear; Thong footwear; Thong underwear; Thongs
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**Grounds for Opposition**

Other	Please see the attached pleading.
Related Proceedings	Opposition No. 91217154
Attachments	Notice of Opposition - RAUNCHY PIG.pdf(281431 bytes )

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joel Karni Schmidt/
Name	Joel Karni Schmidt
Date	01/28/2015

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

In the Matter of Application Serial No. 86/280,433  
Filed: May 14, 2014  
For Mark: RAUNCHY PIG  
Published in the Official Gazette of October 7, 2014

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NASTY PIG, INC.,	:	<b><u>NOTICE OF OPPOSITION</u></b>
	:	
Opposer,	:	
	:	Opposition No.
v.	:	
	:	
FITUMI, LLC,	:	
	:	
Applicant.	:	
-----	X	

Commissioner of Trademarks  
Attn: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Opposer Nasty Pig, Inc. (“Opposer”), a New York corporation, believes it will be damaged by registration on the Principal Register of the standard character word mark RAUNCHY PIG (“Applicant’s RAUNCHY PIG Mark”) for “Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Children’s and infant’s apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Thong beachwear; Thong footwear; Thong underwear; Thongs” in International Class 25 (“Applicant’s Goods”) shown in Application Serial No. 86/280,433 (the “Application”) filed by Applicant Fitumi, LLC (“Applicant”) on May 14, 2014, and having been granted an extension of time to oppose up to and including February 4, 2015, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Since at least as early as 1995, and long prior to May 14, 2014, Applicant's constructive first use date, Opposer, its affiliates, its predecessors and/or its licensees engaged throughout the United States in the marketing, sale and distribution of clothing, jewelry, leather goods, and other goods and accessories bearing the NASTY PIG name and mark ("Opposer's NASTY PIG Mark"), as well as the provision of retail store services and computerized online retail services in these fields.

2. Opposer is the owner of U.S. Registration No. 2,800,386 for Opposer's NASTY PIG Mark, which issued on December 30, 2003 for various goods in International Classes 18, 24, 25 and 35, including but not limited to hats, pants, undershirts, shirts, jackets, shorts, belts, jeans, t-shirts, sweatshirts, jerseys, and tank tops, and retail store services and computerized online retail services in the field of clothing. Opposer's U.S. Registration No. 2,800,386 is incontestable.

3. Opposer is also the owner of an application for Opposer's NASTY PIG Mark, Ser. No. 86/114,145, for various goods in International Class 14, including jewelry, wallets, and leather goods.

4. Opposer also owns domain names incorporating Opposer's NASTY PIG Mark, such as the domain name NASTYPIG.COM, that lead to Opposer's website, which provides information about Opposer and through which consumers can purchase Opposer's goods sold under Opposer's NASTY PIG Mark.

5. Commencing long prior to May 14, 2014, Applicant's constructive first use date, Opposer has extensively advertised and otherwise promoted the sale of its goods and services

bearing Opposer's NASTY PIG Mark and has sold such goods and rendered such services in interstate commerce.

6. Opposer has built up highly valuable goodwill in Opposer's NASTY PIG Mark, and said goodwill has become closely and uniquely identified and associated with Opposer.

7. On May 14, 2014, Applicant filed the Application based on an intent to use.

8. Upon information and belief, Applicant did not use Applicant's RAUNCHY PIG Mark in United States commerce for any of Applicant's Goods covered in the Application prior to its constructive first use date of May 14, 2014.

9. The goods covered by the Application are identical and/or closely related to the goods and services rendered in connection with Opposer's NASTY PIG Mark.

10. Applicant's RAUNCHY PIG Mark is a two-word mark comprised of: (1) the identical term "PIG," and (2) the term "RAUNCHY," which carries a connotation that is extremely similar, if not identical, to the term "NASTY" prominently featured in Opposer's NASTY PIG Mark. The overall commercial impression and connotation of Applicant's RAUNCHY PIG Mark is thus strikingly similar to Opposer's NASTY PIG Mark.

11. Applicant's RAUNCHY PIG Mark so resembles Opposer's NASTY PIG Mark as to be likely, when used in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive the trade and public, who are likely to believe that Applicant's Goods have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's RAUNCHY PIG Mark.

12. On April 21, 2014, Opposer sent a demand letter concerning Application Serial No. 86/085,785 for the standard character word mark DIRTY PIG for various Class 25 goods (“the DIRTY PIG Application”) to the attorneys of record for that application. Attached hereto as **Exhibit A** is a true and accurate copy of Opposer’s April 21, 2014 demand letter.

13. Although the record owner of the DIRTY PIG Application is Janoskians LLC, on or about May 13, 2014, Opposer received a written response to its demand letter from Chris Swanson of Applicant Fitumi, LLC. Attached hereto as **Exhibit B** is a true and accurate copy of Applicant’s May 13, 2014 letter sent to Opposer.

14. In the May 13, 2014 letter, Mr. Swanson identified Applicant Fitumi, LLC as “the company responsible for sales and distribution of the Brand Dirty Pig,” and stated its refusal to comply with the terms set forth in Opposer’s demand letter regarding the DIRTY PIG Application. *See Exhibit B* hereto.

15. Upon information and belief, on May 13 and 14, 2014 – on or about the time Applicant Fitumi, LLC sent its May 13, 2014 letter to Opposer – Mr. Swanson filed three Section 1(b) trademark applications on behalf of Applicant Fitumi, LLC all containing the terms “NASTY” and/or “PIG,” including the Application that is the subject of the instant proceeding (collectively, the “Fitumi Applications”).<sup>1</sup>

16. Upon information and belief, Applicant Fitumi, LLC filed the Fitumi Applications, including the Application, in bad faith and to retaliate against Opposer.

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<sup>1</sup> The other two applications filed by Applicant Fitumi, LLC on those dates were Application Serial No. 86/280,431 for the mark SEXY NASTY PIG and Application Serial No. 86/280,435 for the mark SEXY GAY NASTY. The USPTO has since issued an Office Action refusing to register the application for the mark SEXY NASTY PIG due to Opposer’s U.S. Registration No. 2,800,386 for Opposer’s NASTY PIG Mark.

17. Applicant's RAUNCHY PIG Mark should be refused registration under Trademark Act Section 1(b) because, upon information and belief, at the time Applicant filed its Application, Applicant did not have a bona fide intent to use Applicant's RAUNCHY PIG Mark in commerce on or in connection with the goods specified in the Application. Upon information and belief, Applicant has no written document(s) that would sufficiently support such an intent. Upon information and belief, Applicant filed the Application solely in order to attempt to gain leverage in the parties' dispute concerning the DIRTY PIG Application. Upon information and belief, Applicant does not currently intend to use Applicant's RAUNCHY PIG Mark in U.S. commerce on or in connection with the goods specified in the Application.

WHEREFORE, Opposer believes it will be damaged by registration of Applicant's RAUNCHY PIG Mark and requests that the opposition be sustained and registration be denied.

Please recognize as attorneys for Opposer in this proceeding Joel Karni Schmidt, Eric J. Shimanoff and Scott P. Ceresia (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Joel Karni Schmidt, Esq. at the address listed below.

Dated: New York, New York  
January 28, 2015

Respectfully submitted,

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

By:           /Scott P. Ceresia/            
Joel Karni Schmidt  
Eric J. Shimanoff  
Scott P. Ceresia  
1133 Avenue of the Americas  
New York, NY 10036-6799  
(212) 790-9200

# **EXHIBIT A**





Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036

(212) 790-9200 Tel  
(212) 575-0671 Fax  
www.cll.com

**Joel Karni Schmidt**  
(212) 790-9244  
jks@ccl.com

April 21, 2014

**By Certified Mail and Email (s.baker@br-tmlaw.com)**

Stephen L. Baker, Esq.  
Baker and Rannels, P.A.  
575 Route 28  
Raritan, New Jersey 08869-1354

Re: Infringement of NASTY PIG Trademark

Dear Mr. Baker:

We are intellectual property counsel to Nasty Pig, Inc. ("Nasty Pig"), owner of the well-known NASTY PIG trademark.

Since at least as early as 1995, Nasty Pig has been using its NASTY PIG name and mark (the "NASTY PIG Mark") in connection with a broad range of products and retail and online retail store services. Nasty Pig has developed substantial public recognition and incalculable goodwill in its NASTY PIG Mark.

Nasty Pig owns an incontestable federal registration for the NASTY PIG Mark in the United States, namely, U.S. Registration No. 2,800,386, which was issued on December 30, 2003 for various goods in International Classes 18, 24, 25 and 35. Nasty Pig is also the owner of an application for its NASTY PIG Mark, Ser. No. 86/114,145, for various goods in International Class 14. Our client also owns numerous domain names incorporating the NASTY PIG Mark, such as the domain names nastypig.com, nastypig.net and nastypig.eu, which lead to its website.

It has come to our client's attention that on October 8, 2013 your client Janoskians LLC ("Janoskians") filed an intent-to-use application in the United States, Application No. 86/085,785, to register the trademark DIRTY PIG (the "Infringing Mark") for various articles of clothing in International Class 25 (the "Application"). While the Application was filed on an intent-to-use basis, we also note that your client appears to be advertising and/or offering for sale clothing bearing the Infringing Mark, both on its website located at the URL <http://shopdirtypig.com/> whose domain name incorporates the Infringing Mark (the "Infringing Domain Name") and on its Facebook and Twitter pages located at the URLs <https://www.facebook.com/Janoskians> and <https://twitter.com/DirtyPigClothes>, respectively.

**Cowan, Liebowitz & Latman, P.C.**

Stephen L. Baker, Esq.

April 21, 2014

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The Infringing Mark is confusingly similar to our client's well-known NASTY PIG Mark, and inevitably invokes the NASTY PIG Mark and deceives consumers into believing that the two brands are somehow associated or affiliated. Our client is concerned that consumers may come to the erroneous conclusion that clothing bearing the mark DIRTY PIG is a new line of clothing either from, licensed by, or otherwise connected to the owner of the well-known NASTY PIG Mark. This could be construed as a deliberate attempt to trade on our client's reputation and to infringe our client's trademark rights. The mark DIRTY PIG may also dilute the distinctive quality of our client's NASTY PIG Mark.

On behalf of Nasty Pig, we therefore demand that your client:

- 1) Withdraw the Application and undertake never to seek registration for the Infringing Mark or any mark confusingly similar to the NASTY PIG Mark;
- 2) Cease any use, advertisement, promotion, or other exploitation of the Infringing Mark or any other mark confusingly similar to the NASTY PIG Mark in connection with apparel, accessories and retail store services featuring apparel and accessories, and undertake not offer online retail store services or to sell any goods or accessories bearing the Infringing Mark or other confusingly similar marks in the future;
- 3) Take down the website located at [shopdirtypig.com](http://shopdirtypig.com) and take the necessary steps to the transfer the Infringing Domain Name to Nasty Pig;
- 4) Take down your client's Twitter page located at the URL [/shopdirtypig.com](http://shopdirtypig.com);
- 5) Identify the total units of apparel and accessories manufactured bearing the Infringing Mark;
- 6) Identify by units and dollars the total number of apparel and accessories sold bearing the Infringing Mark, and any such units remaining in Janoskians' inventory;
- 7) Deliver any such units of inventory up to the undersigned for destruction;
- 8) Identify the intended and actual channels of trade for apparel and accessories bearing the Infringing Mark, including all retail accounts, distributors or other third parties to whom Janoskians has sold such goods and the amounts sold to each; and
- 9) Account to our client for any profits made from the sale of products bearing the Infringing Mark.

Our client takes its intellectual property rights very seriously and will not hesitate to enforce those rights against those who misappropriate or infringe them. Accordingly, please provide written assurance by the close of business in New York on **May 2, 2014** that your client will comply with the foregoing demands, failing which we shall advise our client to take whatever further steps may be necessary to protect its valuable trademark rights.

**Cowan, Liebowitz & Latman, P.C.**

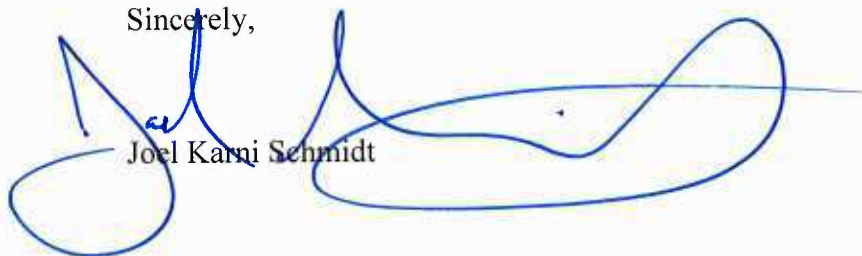
Stephen L. Baker, Esq.

April 21, 2014

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This letter is written without prejudice to any rights, remedies or assertions our client may have, all of which are expressly reserved.

Sincerely,

A handwritten signature in blue ink, consisting of a large, stylized initial 'J' followed by a long, horizontal, wavy line that loops back to the right.

Joel Karni Schmidt

## **EXHIBIT B**



May 13, 2014

Chris Swanson  
Fitumi, LLC  
2133 East 38<sup>th</sup> Street  
Vernon, CA 90058

David A Lauterstein  
Nasty Pig, Inc  
265a W 19th St  
New York, NY

Dear Mr. Lauterstein:

We are the company responsible for sales and distribution of the Brand Dirty Pig. As you are aware, you have filed a motion for extension of time with the USPTO to oppose the mark Dirty Pig. A letter has also been sent by your attorney demanding that we and our affiliates cease using the mark Dirty Pig.

Sir, we very experienced in domestic and international patents, trademarks, and intellectual property rights. We also have very competent attorneys who are prepared to defend any opposition. I realize that target demographics may not be ultimately definitive to infringement or possibility of confusion, and I am not an attorney. But the chance of confusion by the average consumer seems remote in addition to the other defenses available to us. Please take a look at our demographic and yours:



We absolutely will not comply with any of the demands in your attorney's letter and are confident there is no legitimate basis for your claim.

We are prepared to spend as much time and money as necessary to protect our brand. I just felt it may be useful to reach out to you with the hope of saving us both a substantial amount of time and money. I can assure you that we have no interest in encroaching on your market and it appears obvious that you are no threat to ours.

If you would like to work something out, please feel free to call me at 323-306-1330 x 131

Sincerely,

  
Chris Swanson  
Managing Member

**CERTIFICATE OF SERVICE**

I hereby certify that I caused a copy of the foregoing NOTICE OF OPPOSITION to be sent via first class, postage paid mail to Applicant Fitumi, LLC, 2133 East 38th Street, Vernon, California 90058-1616.

Dated: New York, New York  
January 28, 2015

\_\_\_\_\_  
/Scott P. Ceresia/  
Scott P. Ceresia