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Filing date: **01/08/2022**

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

Proceeding no.	92076810
Party	Defendant John Capovani
Correspondence address	LEE PALMATEER LEE PALMATEER LAW OFFICE LLC 90 STATE STREET ALBANY, NY 12207 UNITED STATES Primary email: lee@palmateerlaw.com 518-591-4636
Submission	Motion for Sanctions (Other)
Filer's name	Lee Palmateer
Filer's email	lee@palmateerlaw.com
Signature	/Lee Palmateer/
Date	01/08/2022
Attachments	0370002-REPLY-Sanction-Motion.pdf(183422 bytes) 0370002-DECL01-Palmateer-10Nov21-refiled-8Jan22.pdf(1226507 bytes)

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

Y.Y.G.M. SA,

Petitioner,

Cancellation No. 92076810

vs.

Registration No. 6056987

JOHN CAPOVANI,

Respondent

**REPLY BRIEF IN SUPPORT
OF RESPONDENT'S MOTION FOR SANCTIONS**

I. Petitioner Gives No Justification for its Defiance of the Board

Despite its focus on collateral issues, it is Petitioner's defiance of the Board's Order that is the sanctionable conduct. Petitioner did not and cannot explain how it can refuse Mr. Capovani's discovery demands on the strength of its unilateral declaration that "this matter should be stayed" after having just received the Board's Order directing the parties to provide discovery.

The sanction of dismissal is appropriate when, like Petitioner did here, a party engages in a pattern of dilatory tactics, purposely avoids discovery responsibilities, and willfully fails to comply with a Board's Order relating to discovery. *Baron Philippe de Rothschild, S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2D 1848, 1854 (TTAB 2000). Dismissal is therefore appropriate here.

Petitioner urges that Mr. Capovani's remedy is limited to a motion to compel. That argument is consistent with Petitioner's aim -- delay. Petitioner argues that the Board would not entertain a motion to compel. Petitioner apparently believed it could cause long delay and avoid any consequence because Mr. Capovani would have no recourse.

II. Petitioner's Tale of Incivility is Belied by the Objective Record

In its opposition, Petitioner says that Mr. Capovani withholding consent for a discovery extension violated tenets of incivility. That is pure fiction. Mr. Capovani abides by tenets of civility, and they are not implicated whatsoever here.

As Petitioner explained, Mr. Capovani served his discovery demands on November 7, 2021 and Petitioner did not request an extension until 22 days later, on November 29, 2021, only eight days before the close of discovery set in the Notice of Institution. (Docket CAN-2). Petitioner requested a 30-day extension until January 6, 2022. The Board had not yet suspended the case, and the case schedule would not accommodate such a delay. Moreover, Petitioner's request was expressly "to give the Board a chance to weigh in on the motion to suspend" (see Lauritsen email dated November 29, 2021, CAN-12, Exh. "C"), not to give Petitioner more time to respond. Having no knowledge that the Board would rule on its motion in 30 days, presumably the extension request would be subject to renewal and open ended. The Board's work on the suspension motion is in no way effected by Petitioner's discovery obligations, otherwise the Order would not have included a pro-discovery directive.

Petitioner did not say it needed more time and in fact did not need more time to prepare its responses as they comprise objections only. The objections-only responses are self-evident that Petitioner's extension request was merely another delay tactic.

Petitioner misrepresented in its opposition that there was an informal extension pact. Mr. Capovani clearly communicated that he does not consent to delays in the Cancellation schedule, such as in emails on September 22 and October 13, 2021. (Palmateer Nov. 10, 2021 Decl. ¶¶ 5 and 6 and Exhs. "C" and "D") (CAN-6 and attached hereto).¹

¹ The Palmateer Nov. 10, 2021 Declaration was previously filed (CAN-6) and is herewith re-filed in support of this motion for sanctions.

III. Petitioner Falsely Compares the Parties' Diligence

There is no comparison between the parties' respective conduct. Each party independently exercised their prerogatives to withhold objection to the other's late initial disclosures. "A party that does not receive initial disclosures and does not file a motion to compel such disclosures *risks their being served late in the discovery period concurrently with discovery requests.*" *Luster Prods. v. Van Zandt* , 104 U.S.P.Q.2D 1877, 1879 (TTAB 2012) (emphasis added). Mr. Capovani served initial disclosures concurrently with his timely-served discovery requests in accordance with *Luster*. Petitioner served its initial disclosures, without discovery requests, only after its failure was cited in Mr. Capovani's opposition to Petitioner's suspension motion. Petitioner has shown a lack of diligence and Mr. Capovani has not. It is incongruous that a petitioner bringing a cause in good faith would be the non-diligent party.

IV. Conclusion

For the foregoing reasons, Mr. Capovani respectfully requests dismissal of Petitioner's Petition with prejudice.

Dated: January 8, 2022

/s/Lee Palmateer
Lee Palmateer
LEE PALMATEER LAW OFFICE LLC
90 State Street
Suite 700
Albany, New York 12207
Tel: (518) 591-4636
Fax: 1-518-677-1886
Email: lee@palmateerlaw.com
Attorneys for Applicant

Certificate of Service

The undersigned hereby certifies that, on this date, a copy of this paper has been served upon Opposer by email at the email address of record of their counsel of record, including:

Keith J. Wesley, Esq.
Browne George Ross
O'Brien Annaguey & Ellis, LLP
2121 Ave. of the Stars, Suite 2800
Los Angeles, CA 9006
(310) 274-7100
kwesley@bgrfirm.com
Attorneys for Petitioner

Respectfully submitted,

Dated: January 8, 2022

/s/Lee Palmateer
Lee Palmateer
LEE PALMATEER LAW OFFICE LLC
90 State Street, Suite 700
Albany, NY 12207
Phone: 518-591-4636
Fax: 1-518-677-1886
Email: lee@palmateerlaw.com
Attorneys for Respondent

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

Y.Y.G.M. SA,

Petitioner,

Cancellation No. 92076810

Registration No. 6056987

vs.

JOHN CAPOVANI,

Respondent

**DECLARATION OF
LEE PALMATEER**

I, Lee Palmateer, depose and say under penalty of perjury as follows:

1. I am an attorney duly admitted to practice law in the courts of the Stat of New York.

I represent Respondent John Capovani in these cancellation proceedings (the “Cancellation”) and submit this Declaration in support of Mr. Capovani’s response to Petitioner’s Motion filed on November 1, 2021 (Doc. CAN-5) to suspend these proceedings.

2. Petitioner did not serve its Motion upon Mr. Capovani and did not file a proof of service of its Motion.

3. Annexed hereto and made part hereof as **Exhibit “A”** is a true and correct copy of a letter submitted to the USPTO by Petitioner with its Response to Office Action filed on March 2, 2020 in Trademark Application No. 88,540,339 (‘339 Application, March 2, 2020 Response to Office Action, TSDR pp. 2-3). I downloaded the letter from the USPTO’s TSDR system.

4. Annexed hereto and made part hereof as **Exhibit “B”** is a true and correct copy of an email from Petitioner’s counsel Eric Lauritsen dated September 9, 2021 indicating Petitioner’s intent to file a motion to suspend this Cancellation.

5. Annexed hereto and made part hereof as **Exhibit “C”** is a true and correct copy of an email to Petitioner’s counsel Keith Wesley dated September 22, 2021 declining consent to

Petitioner's then-anticipated suspension motion in response to an email from Mr. Wesley dated September 21, 2021, a true and correct copy of which is also included in the exhibit.

6. Annexed hereto and made part hereof as **Exhibit "D"** is a true and correct copy of an email dated October 13, 2021 to Petitioner's counsel Keith Wesley in which I informed Mr. Wesley that I await his motion to suspend and that I do not consent to any delay in the Cancellation schedule.

7. Mr. Capovani's deadline was October 12, 2021 to answer or otherwise respond to Petitioner's Complaint in Civil Action No. 1:21-cv-04902-ENV-SJB in the Federal District Court for the Eastern District of New York.

8. On November 6, 2021, Mr. Capovani served his initial disclosures and his discovery demands in this Cancellation on Petitioner. Petitioner has failed to serve its initial disclosures and has not served any discovery demands and Petitioner. The close of discovery in this Cancellation is December 7, 2021.

9. I declare under penalty of perjury that the foregoing is true and correct, except as to matters alleged on information and belief, and that as to those matters I believe them to be true, and I make this Declaration pursuant to the Federal Rules of Civil Procedure and with the knowledge that any knowingly false statement made herein by me is punishable under the penalty of perjury, fine and/or imprisonment.

Dated: November 10, 2021

/s/Lee Palmateer
Lee Palmateer (BRN 509188)
LEE PALMATEER LAW OFFICE LLC
90 State Street
Suite 700
Albany, New York 12207
Tel: (518) 591-4636
Fax: 1-518-677-1886
Email: lee@palmateerlaw.com
Attorneys for Respondent John Capovani

Certificate of Service

The undersigned hereby certifies that, on this date, a copy of this paper has been served upon Opposer by email at the email address of record of their counsel of record, including:

Keith J. Wesley, Esq.
Browne George Ross
O'Brien Annaguey & Ellis, LLP
2121 Ave. of the Stars, Suite 2800
Los Angeles, CA 9006
(310) 274-7100
kwesley@bgrfirm.com
Attorneys for Petitioner

Respectfully submitted,

Dated: November 10, 2021

/s/Lee Palmateer
Lee Palmateer
LEE PALMATEER LAW OFFICE LLC
90 State Street, Suite 700
Albany, NY 12207
Phone: 518-591-4636
Fax: 1-518-677-1886
Email: lee@palmateerlaw.com
Attorneys for Respondent

Certificate of Service

The undersigned hereby certifies that, on this date, a copy of this paper has been served upon Opposer by email at the email address of record of their counsel of record, including:

Keith J. Wesley, Esq.
Browne George Ross
O'Brien Annaguey & Ellis, LLP
2121 Ave. of the Stars, Suite 2800
Los Angeles, CA 9006
(310) 274-7100
kwesley@bgrfirm.com
Attorneys for Petitioner

Respectfully submitted,

Dated: January 8, 2022

/s/Lee Palmateer
Lee Palmateer
LEE PALMATEER LAW OFFICE LLC
90 State Street, Suite 700
Albany, NY 12207
Phone: 518-591-4636
Fax: 1-518-677-1886
Email: lee@palmateerlaw.com
Attorneys for Respondent

Exhibit "A" to Palmateer Declaration

BROWNE GEORGE ROSS LLP
Los Angeles · New York · San Francisco

2121 Avenue of the Stars, Suite 2800
Los Angeles, California 90067
T (310) 274-7100 F (310) 275-5697

Keith J. Wesley
kwesley@bgrfirm.com
File No. 7369-010

March 2, 2020

Via E-Mail and U.S. Mail

Kristin Williams
Examining Attorney
United States Patent and Trademark Office
Law Office 105
kristin.williams@uspto.gov

Re: Response to Office Action for U.S. Application Serial No. 88540339

Dear Ms. Williams:

We are in receipt of the office action dated October 18, 2019 in relation to the above referenced application and write in response to the concerns raised therein.

First, with respect to the “ornamental use” issue, one of the means you proposed for overcoming your objection was to submit a verified substitute specimen depicting the applied-for mark being used in a non-ornamental fashion. We are submitting herewith an additional specimen depicting the applied-for mark’s use “on the pocket or breast area of a shirt,” the hallmark example of trademark use upon clothing set forth in the office action. Please consider this substituted for the specimen included with the initial application. The substitute specimen was in use in commerce at least as early as the filing date of the application.

Apart from ornamentality, the office action points to a prior-filed application relating to the use of the mark “RATBASTARD SUPPLY CO.” on “graphic t-shirts” as potentially giving rise to a likelihood of confusion. We do not believe that the term “RATBASTARD SUPPLY CO.” creates the same commercial impression as “YELLOW RAT BASTARD” such that consumer confusion as to the source or origin of goods bearing the two marks would be likely. Indeed, the addition of the word “YELLOW” as a dominant feature of our client’s mark and the space between “RAT” and “BASTARD” serves to substantially distinguish the applied-for mark from the one subject to the first-filed application. This conclusion finds ample support in the case law. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (finding confusion between CAPITAL CITY BANK and CITIBANK unlikely even when used in the same industry based, in part, on finding that “CAPITAL” was the dominant element of the challenged mark); *Shen Mfg. Co. v. Ritz Hotel*

1391656.1

Exhibit "A" to Palmateer Declaration

Browne George Ross LLP

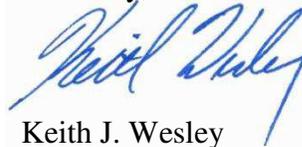
Kristin Williams
Examining Attorney
March 2, 2020
Page 2

Ltd., 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS and RITZ on similar goods was likely to cause confusion given difference in commercial impression). This is particularly true in light of the extensive differences between the stylized versions of our client's mark and the mark that is the subject of the prior application. *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding confusion unlikely despite contemporaneous use of the wording "SPORTSMAN'S WAREHOUSE" due to commercial impression created by other matter and stylization in the respective marks).

Further, we note that there was no filing basis whatsoever indicated for the application for "RATBASTARD SUPPLY CO." until after the submission of our client's application. We are aware that priority may derive from the prior filing of an application alleging actual use or a bona fide intent to use a given mark, but cannot accept that the filing a defective application that alleges *nothing* with respect to use should afford priority over applications filed weeks later that properly allege existing use in commerce.

We appreciate your time and consideration in connection with this matter, and are available to speak at your convenience should you have any additional concerns.

Sincerely,

A handwritten signature in blue ink, appearing to read "Keith Wesley", is written over a light blue rectangular background.

Keith J. Wesley

KJW:el

Exhibit "B" to Palmateer Declaration

From: [Eric Lauritsen](#)
To: [Keith Wesley](#); [Lee Palmateer](#)
Subject: RE: YRB/Capovani [IWOV-DOCSLA.FID326033]
Date: Thursday, September 9, 2021 12:33:23 PM
Attachments: [image003.png](#)

Lee,

We haven't received a response from you on the below. We'll plan on filing a unilateral motion to stay the TTAB proceedings if we haven't heard from you by the end of the day on September 16.

Thanks,
Eric

From: Keith Wesley <kwesley@bgrfirm.com>
Sent: Wednesday, September 1, 2021 5:46 PM
To: Lee Palmateer <lee@palmateerlaw.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: YRB/Capovani [IWOV-DOCSLA.FID376693]

Dear Lee:

We filed the attached lawsuit. Please let us know if you are authorized to accept service. Alternatively, or additionally, please let me know (a) if your client would reconsider his position with regard to a voluntary co-existence agreement, or (b) if you will consent to our anticipated motion to stay the TTAB proceedings until the lawsuit is completed.

Please feel free to call Eric or me if you wish to discuss.

Keith

BGR | BROWNE GEORGE ROSS
O'BRIEN ANNAGUEY & ELLIS LLP

Keith J. Wesley, Esq. | Partner

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Exhibit "B" to Palmateer Declaration

error, please immediately notify the sender and delete this e-mail message from your computer.

Exhibit "C" to Palmateer Declaration

From: [Lee Palmateer](#)
To: [Keith Wesley](#)
Cc: [Eric Lauritsen](#)
Bcc: [Ratbastard Supply Co.](#)
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]
Date: Wednesday, September 22, 2021 2:04:00 PM
Attachments: [image001.png](#)

Keith,

Please forward any other specific comments to the agreements you may have, if any.

The TTAB will know your motion is not on consent when it is not filed as a consent motion. My response will alert the TTAB of my position.

Lee

LEE PALMATEER LAW OFFICE LLC

Intellectual Property Law

90 STATE STREET, SUITE 700

ALBANY, NEW YORK 12207

Phone: 518-591-4636

Email: lee@palmateerlaw.com

Website: www.albanyiplaw.com

From: Keith Wesley <kwesley@bgrfirm.com>
Sent: Tuesday, September 21, 2021 2:27 PM
To: Lee Palmateer <lee@palmateerlaw.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Lee –

My client is not willing to pay money in exchange for the co-existence agreement. Otherwise, the changes generally look OK. Please let us know if you will be opposing or not opposing our request to stay the TTAB proceeding. We should alert TTAB of your position in our request.

Keith

From: Lee Palmateer <lee@palmateerlaw.com>
Sent: Friday, September 17, 2021 1:31 PM
To: Keith Wesley <kwesley@bgrfirm.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408

Dear Keith,

Exhibit "C" to Palmateer Declaration

I carefully reviewed your proposed settlement agreement. For sake of clarity, rather than mark your proposal up, I prepared the attached. This proposal depends on an efficient conclusion.

What is the status of your motion to stay the TTAB proceeding that Eric Lauritsen wrote would be forthcoming?

Regards,

Lee

LEE PALMATEER LAW OFFICE LLC

Intellectual Property Law

90 STATE STREET, SUITE 700

ALBANY, NEW YORK 12207

Phone: 518-591-4636

Email: lee@palmateerlaw.com

Website: www.albanyiplaw.com

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From: Keith Wesley <kwesley@bgrfirm.com>

Sent: Sunday, September 12, 2021 10:41 PM

To: Lee Palmateer <lee@palmateerlaw.com>

Cc: Eric Lauritsen <elauritsen@bgrfirm.com>

Subject: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Dear Lee –

I have conferred further with my client about the proceedings involving our respective clients. I have been authorized to make the attached proposal, which would resolve all matters and implement a procedure to ensure the parties' respective businesses can co-exist moving forward. My client is not willing to make a payment towards your client's attorney's fees. It feels that those fees could have been avoided altogether had your client responded to our initial overtures instead of failing to respond to them completely.

Please let me or Eric know if your client is willing to enter into the attached or something materially similar.

Exhibit "C" to Palmateer Declaration

Thank you in advance.

Keith



Keith J. Wesley, Esq. | Partner

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Los Angeles, California 90067

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kwesley@bgrfirm.com

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Exhibit "D" to Palmateer Declaration

From: [Lee Palmateer](#)
To: [Keith Wesley](#)
Cc: [Eric Lauritsen](#)
Bcc: [Ratbastard Supply Co.](#); [Lee Palmateer](#)
Subject: Re: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]
Date: Wednesday, October 13, 2021 10:09:33 AM

Keith, former paragraph one is reinstated at REDACTED . I am still waiting for your motion to suspend the TTAB cancellation proceedings, which we will oppose. I have not and do not consent to any delays to the proceedings in the TTAB or EDNY. I see no reason why this should not be wrapped up by early next week.

Get [Outlook for iOS](#)

From: Keith Wesley <kwesley@bgrfirm.com>
Sent: Tuesday, October 12, 2021 6:23:09 PM
To: Lee Palmateer <lee@palmateerlaw.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Lee –

Apologies for the delay. I just realized you went ahead and filed a response. I was planning to send back the agreement signed by my side. I should have it in the next day or two. I will send it along asap.

Keith

From: Lee Palmateer <lee@palmateerlaw.com>
Sent: Monday, October 4, 2021 2:06 PM
To: Keith Wesley <kwesley@bgrfirm.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Keith,

Inadvertent use would not trigger a claim for a breach. That's a vanishingly small concern compared to my client's real risk if YYGM were allowed in this Agreement to use RAT BASTARD without YELLOW.

Please have YYGM sign the agreement so we can exchange counterparts and put this matter to rest.

Lee

LEE PALMATEER LAW OFFICE LLC

Exhibit "D" to Palmateer Declaration

Intellectual Property Law
90 STATE STREET, SUITE 700
ALBANY, NEW YORK 12207
Phone: 518-591-4636

Email: lee@palmateerlaw.com

Website: www.albanyiplaw.com

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From: Keith Wesley <kwesley@bgrfirm.com>

Sent: Monday, October 4, 2021 4:34 PM

To: Lee Palmateer <lee@palmateerlaw.com>

Cc: Eric Lauritsen <elauritsen@bgrfirm.com>

Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Lee –

Although my client has no present intention to use “rat bastard” without “yellow”, it is concerned that sometime in the future there will be an inadvertent use that will trigger a breach. Plus, your client has branded around Ratbastard Supply, which is something we will never use.

Please see if your client is willing to agree to this one final modification.

Keith

From: Lee Palmateer <lee@palmateerlaw.com>

Sent: Monday, October 4, 2021 12:14 PM

To: Keith Wesley <kwesley@bgrfirm.com>

Cc: Eric Lauritsen <elauritsen@bgrfirm.com>

Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

In your words to the USPTO:

“Indeed, the addition of the word “YELLOW” as a dominant feature of our client’s mark and the space between “RAT” and “BASTARD” serves to substantially distinguish the applied-for mark

Exhibit "D" to Palmateer Declaration

from the one subject to the first-filed application.”

Your new proposal is completely detached from that and our agreement. YELLOW is indispensable to distinguish the marks.

Please have YYGM sign the agreement as I previously sent to you and let me know when that’s done so we can exchange counterparts.

Lee

LEE PALMATEER LAW OFFICE LLC

Intellectual Property Law

90 STATE STREET, SUITE 700

ALBANY, NEW YORK 12207

Phone: 518-591-4636

Email: lee@palmateerlaw.com

Website: www.albanyiplaw.com

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From: Keith Wesley <kwesley@bgrfirm.com>

Sent: Monday, October 4, 2021 2:43 PM

To: Lee Palmateer <lee@palmateerlaw.com>

Cc: Eric Lauritsen <elauritsen@bgrfirm.com>

Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Here is what we’re proposing:

a. For so long as Mr. Capovani or his successors and assigns continue to use and maintain rights in and to the RATBASTARD SUPPLY CO. mark, YYGM in the marking, advertising or promotion of its goods or services shall not directly or indirectly use any term, phrase or trademark RATBASTARD SUPPLY CO. or any term, phrase or trademark containing the words “rat” or “bastard” or “rat bastard” along with the word “supply” or “supply co”.

b. For so long as YYGM or its successors and assigns continue to use and maintain rights in and to the YELLOW RAT BASTARD mark, Mr. Capovani in the marking, advertising or promotion of his goods or services shall not directly or indirectly use any term, phrase or trademark containing the word “yellow rat bastard” or “yellow ratbastard” alone or in combination with other

Exhibit "D" to Palmateer Declaration

words or features.

From: Lee Palmateer <lee@palmateerlaw.com>
Sent: Monday, October 4, 2021 11:32 AM
To: Keith Wesley <kwesley@bgrfirm.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Keith,

Your "only" comment is attached, which I fully addressed in a subsequent revision. You reviewed it and agreed. The agreement gives YYGM everything it asked for, namely use of YELLOW RAT BASTARD. Use of RATBASTARD or RAT BASTARD alone was never contemplated by either party. It is an overreach and harmful to my client. Please redline your proposal in a return email based on the below current language.

4. Limitations on Trademark Use.

a. For so long as Mr. Capovani or his successors and assigns continue to use and maintain rights in and to the RATBASTARD SUPPLY CO. mark, YYGM in the marking, advertising or promotion of its goods or services shall not directly or indirectly use any term, phrase or trademark (i) containing the words "bastard" or "rat bastard" separate and apart from the term "yellow rat bastard" or (ii) the words "ratbastard" or "supply" or "supply co." alone or in combination with other words or features.

b. For so long as YYGM or its successors and assigns continue to use and maintain rights in and to the YELLOW RAT BASTARD mark, Mr. Capovani in the marking, advertising or promotion of his goods or services shall not directly or indirectly use any term, phrase or trademark containing the word "yellow rat bastard" or "yellow ratbastard" alone or in combination with other words or features.

Lee

LEE PALMATEER LAW OFFICE LLC

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Exhibit "D" to Palmateer Declaration

From: Keith Wesley <kwesley@bgrfirm.com>
Sent: Monday, October 4, 2021 1:53 PM
To: Lee Palmateer <lee@palmateerlaw.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: RE: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Dear Lee –

We had previously objected to the prohibition on use of the words “rat bastard” or “supply” in isolation. We believe the section about prohibitions should state that our side is agreeing not to use RAT BASTARD SUPPLY (or any combination of RAT or BASTARD with SUPPLY) and your side is agreeing not to use YELLOW RAT BASTARD (or any combination of RATE OR BASTARD with YELLOW). Subject to that clarification, we’re willing to sign immediately and put this to rest.

Keith

From: Lee Palmateer <lee@palmateerlaw.com>
Sent: Thursday, September 30, 2021 12:54 PM
To: Keith Wesley <kwesley@bgrfirm.com>
Cc: Eric Lauritsen <elauritsen@bgrfirm.com>
Subject: YYGM/Capovani - Confidential Settlement Communication Under FRE 408 [IWOV-DOCSLA.FID376693]

Keith,

I have deleted former paragraph 1 regarding other consideration and changed dates from September to October.

As other consideration was the sole remaining unresolved issue, I believe the agreements are in condition for each party to sign their counterparts.

Please confirm receipt of this email and whether you agree with the foregoing. We can then exchange counterparts.

When we receive YYGM’s counterparts to Consent Agreement and TTAB Stipulation, we will re-sign them so both signatures appear on them for filing.

Regards,

Exhibit "D" to Palmateer Declaration

Lee

LEE PALMATEER LAW OFFICE LLC

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Exhibit "D" to Palmateer Declaration

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