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

Proceeding	92076810
Party	Plaintiff YYGM, SA
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Submission	Motion to Suspend for Civil Action
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Date	11/01/2021
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 6,056,987  
For the Mark **RATBASTARD SUPPLY CO.**

**Y.Y.G.M. SA,**

Petitioner,

Cancellation No. 92076810

vs.

**JOHN CAPOVANI,**

Respondent

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**Y.Y.G.M. SA'S MOTION TO SUSPEND**

Pursuant to 37 C.F.R. §2.117 and TBMP § 510.02, petitioner Y.Y.G.M. SA (“Y.Y.G.M.”) hereby moves the Trademark Trial and Appeal Board for an order suspending this cancellation proceeding pending the resolution of a civil action. Namely, the parties herein are also parties to a civil action proceeding before the United States District Court for the Eastern District of New York (the “E.D.N.Y. Action”), and the E.D.N.Y. Action deals with overlapping issues as this proceeding and is thus likely to have a significant bearing on its. A true and correct copy of the complaint from the E.D.N.Y. Action is appended hereto as Exhibit A. Y.Y.G.M. is not aware of any unusual circumstances that would warrant the Board deviating from its ordinary policy of suspending proceedings when the parties are involved in a court action that may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); TBMP § 510.02(a).

WHEREFORE, Y.Y.G.M., by its attorneys, respectfully requests that this motion for suspension be granted.

Respectfully submitted,

Dated: November 1, 2021

/Keith J. Wesley/

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# Exhibit A

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF NEW YORK

Y.Y.G.M., SA,

Plaintiff,

v.

HENRY ISHAY d/b/a X-TREME VIBE,  
INC. and JOHN CAPOVANI d/b/a  
RATBASTARD SUPPLY CO.,

Defendants.

No. 21-CV-4902

**COMPLAINT**

**JURY TRIAL DEMANDED**

Plaintiff Y.Y.G.M., SA (“Plaintiff”), by and through its attorneys, Browne George Ross O’Brien Annaguey & Ellis LLP, as and for its complaint against Defendants Henry Ishay d/b/a X-Treme Vibe, Inc. and John Capovani d/b/a Ratbastard Supply Co. alleges as follows.

**PRELIMINARY STATEMENT**

1. This action concerns the use of the trademark “Yellow Rat Bastard” which, following the United States Patent and Trademark Office’s (“USPTO”) cancellation of an existing registration of the “Yellow Rat Bastard” wordmark in October 2019, Plaintiff (through its U.S. licensees) has used in commerce in connection with apparel marketed toward Millennial and Generation-Z males.

2. Despite Plaintiff’s prior use of the mark, two other persons, Defendant Henry Ishay (“Ishay”) and John Capovani (“Capovani” and, together with Ishay, “Defendants”), have also sought to register identical and/or similar word marks and design marks.

3. Notably, Ishay has attempted to use Plaintiff’s very own wordmark. Capovani, however, has attempted to use a wordmark that has the term “Ratbastard” in it but is not likely to be confused with Plaintiff’s wordmark. Nonetheless, when Plaintiff sought registration of the

wordmark and a related design mark with the USPTO, the USPTO tentatively denied Plaintiff's application based solely on an existing but dissimilar mark used by Capovani.

4. As a result of this tentative denial and the actions of both Defendants, Plaintiff, as the senior user since the cancellation of the original "Yellow Rat Bastard" mark, is now unable to register the "Yellow Rat Bastard" mark and enjoy the full complement of rights vested in the registered holder of a trademark. Hence, a declaration from the Court confirming Plaintiff's rights in and to the "Yellow Rat Bastard" mark is necessary and appropriate to alleviate the aura of uncertainty caused by the USPTO's tentative denial.

5. Moreover, notwithstanding the uncertainty caused by the USPTO's tentative denial, Plaintiff believes that it, as the senior user since the cancellation of the original "Yellow Rat Bastard" mark, is entitled to use the "Yellow Rat Bastard" wordmark to the exclusion of the world. Thus, Ishay's use of an identical mark, and, to the extent a court were to determine that Capovani's use of a dissimilar mark may create a likelihood of confusion in the minds of consumers, these uses infringe upon Plaintiff's rights to the "Yellow Rat Bastard" wordmark, for which Plaintiff seeks money damages and corresponding equitable relief.

#### **PARTIES**

6. Plaintiff is a corporation organized and existing under the laws of Switzerland with a principal place of business in Lugano, Switzerland.

7. Defendant Ishay is an individual, and on information and belief, is domiciled at 295 West End Ave., Brooklyn, New York 11235 and is doing business as X-Treme Vibe, Inc. ("X-Treme Vibe"), an unregistered and unlicensed entity that purports to have its principal place of business at 295 West End Ave., Brooklyn, New York 11235.

8. Defendant Capovani is an individual, and on information and belief, is domiciled at 144 Putman Road, Rotterdam, New York 12306, and is doing business, including in this District, as Ratbastard Supply Co. (“RSC”).

### **JURISDICTION AND VENUE**

9. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338, as Plaintiff’s claims against Defendants arise under the federal Lanham Act, Title 15 of the United States Code, and pursuant to 28 U.S.C. § 2201 as the action seeks declaratory relief. The Court also has supplemental jurisdiction over the related state law claims pursuant to 28 U.S.C. § 1367 because these claims are so related to claims in the action within such original jurisdiction that they form part of the same case or controversy.

10. This Court has personal jurisdiction over Defendants because they are domiciled in the State of New York and because of their extensive in-state contacts that relate to and/or form the basis of this action.

11. Pursuant to 28 U.S.C. § 1391, venue properly lies in this District because a substantial part of the events giving rise to the claims alleged in this Complaint occurred in this judicial District and because Defendants reside or are found within this District.

### **FACTUAL ALLEGATIONS**

12. Plaintiff (through its U.S. licensees) is the senior user and thus owner of the word mark, YELLOW RAT BASTARD (the “Word Mark”), and a related design mark with the words YELLOW RAT BASTARD in a stylized font alongside a picture of a yellow rat (the “Design Mark” and, together with the Word Mark, the “YRB Marks”).

13. Plaintiff has filed applications with the USPTO dated July 16, 2019 and January 21, 2020, to obtain registrations for the YRB Marks, and which have been assigned USPTO App. Nos. 88540339 and 88768401, respectively. Authentic YRB Marks are emblazoned on articles of

clothing, such as t-shirts, hats, and sweatshirts, as well as stickers, which are then sold online by Plaintiff's licensees.

**A. Ishay's Abandonment Of A Prior Mark And Attempt To Resuscitate Those Rights**

14. Ishay, through a now *twice*-dissolved entity, X-Treem Vibe, Inc. ("X-Treem"), previously owned the registration for the YELLOW RAT BASTARD wordmark. USPTO Reg. No. 75726856 (the "Prior Mark"). After years of non-use, X-Treem's trademark was cancelled as of October 16, 2019, as a result of the USPTO's findings in connection with a Cancellation Proceeding that X-Treem had abandoned the Prior Mark.

15. Despite no longer owning any rights to the Prior Mark, on May 18, 2021, Ishay, now doing business as X-Treme Vibe, Inc., applied for a trademark for the "Yellow Rat Bastard" wordmark, USPTO App. No. 90719680 ("Ishay's Application"), which is the same wordmark sought by Plaintiff in connection with its own application to the USPTO.

16. Ishay's Application recites that the "applicant" is X-Treme, a New York corporation that has its place of business at 295 West End Ave. Brooklyn, New York. However, there is no such entity registered with the New York Department of State Division of Corporations, and, upon information and belief, it is not registered elsewhere. Ishay's Application further claims to have first used the mark in commerce on January 6, 1996, even though the Prior Mark was cancelled by the USPTO.

17. Presumably, in order to claim that he is actively using the "Yellow Rat Bastard" wordmark in commerce, Ishay recently (but after Plaintiff's date of first use of the YRB Marks) began publishing the exact same marks on, *inter alia*, the website [www.yellowratbastard.com](http://www.yellowratbastard.com) (the "Website"). However, the Website does not actually sell any products, as any attempt to purchase a product stalls prior to the completion of the sale. Ishay's use of the YRB Marks on the Website,



therefore, appears to be a thinly veiled attempt to resuscitate rights in the Prior Mark that was abandoned by X-Treem, cancelled by the USPTO, and which is now owned by Plaintiff.

18. Visitors to the Website are likely to be misled and conclude that the Website is an authorized outlet for the purchase of clothing and items that use the YRB Marks. Ishay's display of the YRB Marks on the Website is likely to cause confusion amongst the relevant population of consumers that are looking to purchase clothing with Plaintiff's authentic YRB marks, which are similarly marketed and sold online on a similar URL. Thus, Ishay's unauthorized use infringes upon Plaintiff's common-law trademark rights in the YRB Marks and harms the market for items that bear authentic YRB marks.

19. Making matters worse (and potentially more harmful to Plaintiff), Ishay is using the YRB Marks to advertise and promote a variety of counterfeit products that infringe upon the rights of other famous brands and celebrities, from BUDWEISER to JACK DANIELS to BRITNEY SPEARS to DISNEY to PEPSI to many, many more.

**B. Capovani's Registration And Use Of A Similar Mark**

20. Capovani, doing business as Ratbastard Supply Co. ("RSC"), sells apparel, including t-shirts, sweatshirts, and hats via an online marketplace available at [www.ratbastardsupplyco.com](http://www.ratbastardsupplyco.com) and is the owner of a registration for the mark RATBASTARD SUPPLY CO., USPTO Reg. No. 88488647 (the "RSC Word Mark"). Capovani has also filed an application with the USPTO to register a stylized version of the RATBASTARD SUPPLY CO. name along with a drawing of a rat, USPTO App. No. 90145559 (the "RSC Design Mark" and, together with the RSC Word Mark, the "RSC Marks").

21. Despite that there should not be a likelihood of confusion within the relevant markets as to the origin of goods sold bearing the YRB Marks and RSC Marks, the USPTO has issued an Office Action that tentatively denies both (i) Capovani's attempt to register the RSC

Design Mark based on the purported likelihood of confusion with the YRB Marks and (ii) Plaintiff's attempt to register the YRB Marks based on a purported likelihood of confusion with Capovani's RSC Word Mark.

22. Accordingly, in order to break the logjam at the USPTO with regard to Plaintiff's and Capovani's marks and pending applications, Plaintiff requires a declaration that its use of the YRB Marks does not create a likelihood of confusion with Capovani's RSC Marks.

23. In the alternative, should there be a likelihood of confusion, then Plaintiff seeks a declaration that its use of the YRB Marks pre-dates Capovani's use of the RSC Marks, and, therefore, Capovani too is infringing upon Plaintiff's trademark rights.

**FIRST CLAIM FOR RELIEF**  
**(Declaratory Relief Against All Defendants)**

24. Plaintiff repeats and re-alleges the allegations made in paragraphs 1 through 23 above as if set forth at length herein.

25. This court may issue a declaratory judgment to settle and afford relief from uncertainty and insecurity with respect to litigants' rights, status, and other legal obligations, whether or not further relief is or could be claimed.

26. An actual and justiciable controversy has arisen and now exists between Plaintiff Ishay and Capovani concerning their respective rights and duties in connection with the YRB Marks, including, but not limited to, which party owns superior rights in and to the YRB Marks, and whether the YRB Marks and RSC Marks are confusingly similar.

27. A declaration concerning such rights is necessary and appropriate at this time, particularly in that Ishay is purporting to use the YRB Marks (albeit in conjunction with counterfeit designs), has applied to register the YRB Marks, and has made representations that he is the owner of the YRB Marks.

28. Moreover, a declaration is necessary given that Plaintiff and Capovani continue to use their respective marks and are each party's pending application to register their respective marks in the USPTO has been tentatively denied.

29. Plaintiff is therefore entitled to a declaratory judgment in its favor declaring that:

(i) In light of X-Treem's abandonment, and the USPTO's cancellation of the Prior Mark, that Plaintiff is the owner and senior user of the YRB Marks and that Ishay's use infringes on Plaintiff's rights in and to the YRB Marks; and

(ii) There is no likelihood of confusion as between the YRB Marks and the RSC Marks, and so Plaintiff is entitled to registration of the YRB Marks with the USPTO; or

(iii) If there is a likelihood of confusion between the YRB Marks and RSC Marks, then Plaintiff is the prior user and is entitled to registration of the YRB Marks with the USPTO.

**SECOND CLAIM FOR RELIEF**  
**(False Designation of Origin Against Ishay)**

30. Plaintiff repeats and re-alleges the allegations made in paragraphs 1 through 29 above as if set forth at length herein.

31. Ishay's advertising, marketing, creating, displaying, offering for sale, selling, distributing, and profiting from products incorporating the YRB Marks or nearly identical variations thereof on the same categories of goods—i.e., apparel products—as Plaintiff constitutes unfair competition and false designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

32. Plaintiff is the owner of the YRB Marks through its prior and continuous use, and the YRB Marks are inherently distinctive and have also acquired secondary meaning through extensive promotion and sales since the commencement of Plaintiff's use thereof.

33. Plaintiff has never consented to Ishay's use of the YRB Marks.

34. Ishay's unauthorized use of the YRB Marks is likely to cause confusion and deceive consumers as to the impression that Ishay's products are manufactured by, authorized by, or otherwise associated with Plaintiff in violation of Section 42(a) of the Lanham Act, 15 U.S.C. § 1125(a) as to the source or affiliation of the goods.

35. Ishay's unauthorized use of the YRB Marks has caused and unless enjoined, will continue to cause substantial and irreparable injury to Plaintiff for which it has no adequate remedy at law, including substantial and irreparable injury to the goodwill and reputation association with Plaintiff and its marks.

36. Upon information and belief, Ishay's use of Plaintiff's YRB Marks is willful and reflects Ishay's intent to trade on Plaintiff's goodwill.

37. X-Treme Vibe's acts were committed, and continue to be committed, with actual notice of Plaintiff's exclusive rights and with the intent to cause confusion, to cause mistake, and/or to deceive and to cause injury to the reputation and goodwill associated with Plaintiff and its products. Pursuant to 15 U.S.C. Section 1117, Plaintiff is, therefore, entitled to recover three times its actual damages or three times X-Treme Vibe's profits, whichever is greater, together with its attorneys' fees.

**THIRD CLAIM FOR RELIEF**  
**(False Designation of Origin Against Capovani)**

38. Plaintiff repeats and re-alleges the allegations made in paragraphs 1 through 37 above as if set forth at length herein.

39. The YRB Marks are inherently distinctive and have also acquired secondary meaning through extensive promotion and sales since the commencement of Plaintiff's use thereof.

40. Plaintiff is the owner of the YRB Marks through its prior and continuous use.

41. Capovani is advertising, marketing, creating, displaying, offering for sale, selling, distributing, and profiting from products incorporating the RSC Marks on the same categories of goods—i.e., apparel products—as Plaintiff markets and sells.

42. Plaintiff has never consented to Capovani’s use of the YRB Marks.

43. Although Plaintiff does not believe Capovani’s use of the RSC Marks are likely to cause consumer confusion, should a likelihood of confusion nevertheless be found, then Capovani’s use infringes upon Plaintiff’s rights because Plaintiff’s use of the YRB Marks pre-dates Capovani’s use of the RSC Marks.

**FOURTH CLAIM FOR RELIEF**  
**(Violation of New York General Business Law Article 22-A § 349)**

44. Plaintiff repeats and re-alleges the allegations made in paragraphs 1 through 43 above as if set forth at length herein.

45. Without Plaintiff’s authorization or consent, and having knowledge of Plaintiff’s rights in and to the YRB Marks, Ishay advertised, marketed, created, displayed, offered for sale, sold, distributed, and profited from marks that are identical and/or are highly similar to the YRB Marks, in direct competition with Plaintiff’s genuine merchandise bearing the YRB Marks.

46. Ishay’s unauthorized use of the YRB Marks is likely to cause confusion and deceive customers as to the origin, sponsorship, or approval of Ishay’s products by creating the false and misleading impression that Ishay’s products are manufactured by, authorized by, or otherwise associated with Plaintiff.

47. If Ishay’s activities are not enjoined, Plaintiff will suffer immediate and continuing irreparable harm and injury to its reputation and to the goodwill associated with its name and marks.

48. In addition, to the extent that there is a likelihood of confusion between the YRB Marks and the RSC Marks, Capovani's use of the RSC Marks are likely to cause confusion and deceive customers as to the origin, sponsorship, or approval of Capovani's products by creating the false and misleading impression that his products are manufactured by, authorized by, or otherwise associated with Plaintiff.

49. To the extent that there is a likelihood of confusion between the YRB Marks and the RSC Marks, if Capovani's activities are not enjoined, Plaintiff will suffer immediate and continuing irreparable harm and injury to its reputation and to the goodwill associated with its name and marks.

**FIFTH CLAIM FOR RELIEF**  
**(Common Law Unfair Competition Against All Defendants)**

50. Plaintiff repeats and re-alleges the allegations made in paragraphs 1 through 49 above as if set forth at length herein

51. The likelihood of confusion alleged above not only constitutes a violation of the federal Lanham Act but also constitutes common law unfair competition under state law, entitling Plaintiff to actual damages, a disgorgement of profits, and injunctive relief.

52. Defendants engaged in unfair competition with the intention of depriving Plaintiff of its legal rights, with oppression, fraud, and/or malice, and in conscious disregard of Plaintiff's rights, including Ishay's act of publishing a nonfunctional website online that falsely purports to sell apparel branded with the YRB Marks. This constitutes bad faith misappropriation of the labors and expenditures of Plaintiff and constitutes unfair competition under New York common law. Plaintiff is, therefore, entitled to an award of exemplary and punitive damages, according to proof.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff respectfully requests that the Court enter judgment in its favor as follows:

**ON PLAINTIFF'S FIRST CLAIM FOR RELIEF**

A. Declaring that:

(i) In light of X-Treem's abandonment and the USPTO's cancellation of the Prior Mark, that Plaintiff is the owner and senior user of the YRB Marks, and that Ishay's use infringes on Plaintiff's rights in and to the YRB Marks; and

(ii) There is no likelihood of confusion as between the YRB Marks and the RSC Marks, and so Plaintiff is entitled to registration of the YRB Marks with the USPTO; or

(iii) If there is a likelihood of confusion between the YRB Marks and RSC Marks, then Plaintiff is the prior user, and is entitled to registration of the YRB Marks with the USPTO.

**ON PLAINTIFF'S SECOND THROUGH FIFTH CLAIMS FOR RELIEF**

B. Enjoining and restraining Defendants and their officers, agents, servants, and those persons in active concert or participation from directly or indirectly infringing Plaintiff's rights in the YRB Marks;

C. Directing that Defendants immediately: (i) remove all products bearing the YRB Marks from their websites, (ii) destroy all such products in their possession, custody or control or return them to Plaintiff, and/or (iii) immediately obtain a license from Plaintiff for their use;

D. Awarding Plaintiff monetary damages in the amount equal to Plaintiff's damages and Defendants' profits in an amount not less than \$500,000;

E. Awarding Plaintiff its costs and attorneys' fees incurred in this Action pursuant to statute.

