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

Proceeding	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	Other Motions/Submissions
Filer's Name	Lee Palmateer
Filer's email	lee@palmateerlaw.com
Signature	/Lee Palmateer/
Date	11/10/2021
Attachments	0370002-Response-Suspension.pdf(263896 bytes) 0370002-DECL01-Palmateer-with-Exh.pdf(1212860 bytes)

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

Y.Y.G.M. SA, Petitioner, vs. JOHN CAPOVANI, Respondent	Cancellation No. 92076810 Registration No. 6056987 **RESPONSE TO PETITIONER'S MOTION TO SUSPEND**

With this Response and accompanying Declaration by Lee Palmateer dated November 10, 2021, Respondent John Capovani opposes Petitioner's Motion filed on November 1, 2021 (Doc. CAN-5) to suspend these proceedings.

I. Facts and Argument

A. This Cancellation is based on Fraud and Petitioner's Civil Action will have no Bearing on this Cancellation because Fraud is not an Issue in the Civil Action

Petitioner seeks suspension on the grounds that the parties are also parties to Civil Action, namely civil action No. 1:21-cv-04902-ENV-SJB in the Federal District Court for the Eastern District of New York (hereinafter "Civil Action"), that is likely to have a bearing on these proceedings.

In this Cancellation, Petitioner pleaded the following grounds for cancellation:

> 10. On information and belief, in reality, Respondent did not begin using Respondent's Mark in commerce until some time after June 15, 2019, when Petitioner began using Petitioner's Marks in commerce. On information and belief, Respondent's representation to the contrary—i.e. that its use of Respondent's Mark began on October 5, 2018—constituted a ***fraud on the Office*** intended to subvert Petitioner's superior rights.
>
> 11. Petitioner will be damaged should the Registration remain active on the Principal Register since it will be unable to secure federal registration of Petitioner's Marks as a result thereof, even though Petitioner is the true senior user.

(emphasis added) (See Petition, Doc. CAN-1, ¶¶ 10 and 11). Thus, the Petition for cancellation

is grounded exclusively on fraud.

The Board must scrutinize Petitioner's Complaint in the Civil Action to determine if the issues before the court may have a bearing on the Board's decision in this Cancellation. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011); TBMP § 510.02(a). Suspensions are omnibus extensions and should receive the same scrutiny as any extension, namely:

> A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient.
>
> Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. The Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown.

TBMP § 509.01(a). These extension standards should apply particularly to Petitioner's suspension motion considering that Petitioner filed the motion on November 1, 2021 mere days before its discovery demands were due even though the Civil Action has been extant since August 31, 2021. This two-month delay is inexcusable.

Petitioner annexed a copy of its Complaint in the Civil Action as Exhibit "A" to its Motion. Scrutiny of the Complaint shows that the Civil Action has no bearing on the issue of fraud, which is Petitioner's sole grounds for cancellation. There are no allegations of fraud in the Civil Action. Therefore, there is no reason to suspend these proceeding pending the outcome of the Civil Action, and Petitioner's motion must be denied.

B. *Arguendo*, Anticipatory of Petitioner's Reply, the Civil Action will not Otherwise have a Bearing on this Cancellation

Because fraud is the only issue in this Cancellation and fraud is not an issue in the Civil Action, Mr. Capovani can only speculate what Petitioner's arguments might be, particularly in the absence of a brief embodied or accompanied with Petitioner's motion. Mr. Capovani

respectfully submits that a sur-reply will be warranted and necessary. But on the contingency that a sur-reply might not be afforded him, Mr. Capovani offers the following arguments, *arguendo*, relating to dates of first use and likelihood of confusion in anticipation that Petitioner will raise these non-probative issues.

The cancellation Petition makes no allegation of likelihood of confusion and no allegation that Mr. Capovani did not use his mark prior to filing his U.S. Trademark Application No. 88/488,647 on June 25, 2019. They are therefore not issues in this Cancellation.

Review of the Complaint to determine if the Civil Action would have a bearing on these issues will require scrutiny because Petitioner uses smokescreens and mirrors to disguise the thin core of facts pertaining to Mr. Capovani. For example, Petitioner conflates allegations against unrelated codefendant Henry Ishay d/b/a X-Treme Vibe, Inc. with allegations against Mr. Capovani to blur the distinction between them, their different marks and different use histories. (e.g., Compl. ¶¶ 2, 4, 5, 26). Petitioner alleges seniority of use of the YELLOW RAT BASTARD mark, which Mark is used identically by Petitioner and X-Treme Vibe. But Mr. Capovani's mark is RATBASTARD SUPPLY CO.®, and nowhere does Petitioner allege that it used YELLOW RAT BASTARD before Mr. Capovani's used RATBASTARD SUPPLY CO.®

Arguendo, the Civil Action would have no bearing on likelihood of confusion in these proceedings.[1] In its "First" and main claim of its Civil Action, Petitioner seeks a declaratory judgment that there is no trademark infringement on grounds that there is no "likelihood of

[1] There is no allegation of likelihood of confusion in the Petition. Petitioner has consistently maintained that there is no likelihood of confusion in formal filings with the USPTO and Federal District Court. In a Response to Office Action filed on March 2, 2020 in Trademark Application No. 88,540,339, Petitioner argued that the parties' uses of their respective marks would not cause a likelihood of confusion (Palmateer Decl. ¶ 3, Exh. "A") and expressly alleged that there is no likelihood of confusion in its Civil Action Complaint. (Compl. ¶¶ 3 and 21).

confusion" between the parties' trademarks. Petitioner alleged that there is no likelihood of confusion. (Compl. ¶¶ 3 and 21). Petitioner makes no contrary allegation in the Complaint. Even if likelihood of confusion was alleged in the Complaint, Mr. Capovani's date of first use is irrelevant to the Court's determination of whether there is a likelihood of confusion.

Petitioner's remaining Civil Action claims (false designation of origin under the Lanham Act and related state law claims) require Petitioner to have trademark priority. However, the Complaint alleges only that Petitioner was first to use YELLOW RAT BASTARD. That allegation is not probative on the issue of priority between Petitioner and Mr. Capovani. The Complaint does not allege that Petitioner used YELLOW RAT BASTARD before Mr. Capovani used RATBASTARD SUPPLY CO.® and therefore does not invoke the issue of Mr. Capovani's date of first use. There is no other context in which Mr. Capovani's date of first use would be a relevant inquiry. The issue is simply not before Federal District Court. Therefore, the Civil Action will have no bearing on Mr. Capovani's date of first use (or Petitioner's date of first use).

Moreover, the Lanham Act claim and related state law claims are expressly conditioned on failure of the declaratory judgment claim and on the false premise that if the court denies the declaratory judgment claim it must affirmatively find likelihood of confusion. The Complaint in the Civil Action does not affirmatively allege likelihood of confusion, and the court will not give an advisory opinion that there is likelihood of confusion. Likewise, the court will not give an advisory opinion regarding priority in the Lanham Act claim, declaratory judgment claim, or any other claim, particularly in the absence of factual allegation that Petitioner has priority.[2] Federal

[2] Different from standards in Cancellations, in a civil action allegations of fact are required to state a claim. *Bell Atlantic Corp. v. Tomboy*, 550 U.S. 544, 127 S. Ct. 1955 (2007); *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937 (2009). Mere "'labels and conclusions'" or "'a formulaic recitation of the elements of a cause of action will not do.'" Iqbal, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 555). "'[N]aked assertion[s]' devoid of 'further factual enhancement'" will

District Courts do not give an opinion advising what the law would be upon a hypothetical state of facts. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127, 127 S. Ct. 764 (2007) (analyzing "controversy" requirement for declaratory judgment jurisdiction).

C. Petitioner's Motion is Procedurally Defective.

Petitioner was required to serve the Motion upon Mr. Capovani and to file proof of service. With certain exception that do not apply:

> (a) . . . every submission filed in the Office in inter partes cases . . . must be served upon the other party or parties. Proof of such service must be made before the submission will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.
>
> (b) Service of submissions filed with the Board . . . must be on the attorney . . . and must be made by email.

37 C.F.R. § 2.119; TBMP § 110.03. Petitioner failed to serve its motion (Palmateer Decl. ¶ 2) and therefore cannot file proof of service. The Board therefore cannot consider the motion.

Petitioner's Motion is incomplete and deficient. "Every motion . . . shall embody or be accompanied by a brief." 37 C.F.R. § 2.127(a); TBMP § 502.02(b). Papers that do not meet the requirements shall not be considered. *Id.*. ("The Board will consider no further papers."). Petitioner's motion does not embody a brief and is not accompanied by one. It does not qualify as a motion and does not warrant consideration.

D. Suspension should be Denied because the Civil Action is Expressly Based on Facially Deceptive Mischaracterization of USPTO Proceedings.

In its Civil Action Complaint, Petitioner alleges for its "First" and primary claim that "Plaintiff requires a declaration" of noninfringement "in order to break the ***logjam at the***

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not due. *Id*. (quoting *Twombly*, 550 U.S. at 557). "While legal conclusions can provide the framework of a complaint, they must be supported by factual allegations." *Iqbal* at 679.

USPTO" (emphasis added) (Compl. ¶ 22), [3] as if the USPTO is unable to adequately conduct its business without court intervention. Nothing could be further from the truth. The USPTO is merely following its rules involving conflicting pending applications, namely to approve the earlier-filed application for publication (37 C.F.R. §2.83(a)) and suspend the later-filed application pending disposition of the earlier-filed application. 37 C.F.R. §2.83(c). Petitioner keeps the Court in the dark about a senior user's right to oppose an earlier-filed application to clear the way for its own registration. Petitioner itself has stalled the application process by its chosen course of litigation. Petitioner cannot claim victimhood of a supposed "logjam" that it caused.

In furtherance of its "logjam" caricature, Petitioner paints a false equivalence between the parties' respective trademark applications having ended in a tie that can only be broken by the Court. Petitioner's Complaint in the Civil Action alleges that the USPTO "tentatively denied" its trademark application based on Mr. Capovani's registration (Compl. ¶ 3) and "tentatively denie[d]" Mr. Capovani's application based on Petitioner's application. (Compl. ¶ 21). That is an understatement of Petitioner's circumstance and an overstatement of Mr. Capovani's circumstance. There is nothing "tentative" about the USPTO's non-final refusal to register Petitioner's mark. And the USPTO suspended, but did not deny Mr. Capovani's application. The declaratory judgment claim is based on an utterly false premise.

Likewise, Petitioner alleges that the USPTO refusal of its trademark application creates a

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[3] Petitioner's allegation that its trademark application was "tentatively denied" (Compl. ¶ 3) is misleading. The USPTO has refused registration of Petitioner's mark. There is nothing tentative about the refusal. The refusal is "non-final" meaning Petitioner can still submit a response to the refusal. Likewise, it's allegation that Mr. Capovani's application was "tentatively denie[d]" (Compl. ¶ 21) is misleading as the application was merely suspended.

controversy between Petitioner and Mr. Capovani. It is well-settled in the Second Circuit that the existence of a dispute before the TTAB over the registration of a party's mark is insufficient adversity to constitute a case of actual controversy. *1-800-Flowers.com* at 454 (citing *Bruce Winston Gem Corp. v. Harry Winston, Inc*., 2010 U.S. Dist. LEXIS 96974, at *15 and *Bausch & Lomb Inc. v. CIBA Corp*., 39 F. Supp. 2d 271, 274 (W.D.N.Y. Mar. 17, 1999) (defendant's filing of proceedings before the TTAB against plaintiff to oppose plaintiff's trademark application was "not enough to support declaratory judgment jurisdiction")).

In *Bruce Winston*, the Court observed that resolution of the only concrete dispute (i.e., trademark registration) was a matter for the USPTO and that the matter could be appealed to the appropriate court. *Bruce Winston Gem Corp.*, at *15. [4] There simply is no actual controversy and no subject matter jurisdiction of Petitioner's declaratory judgment action against Mr. Capovani.

E. Mr. Capovani and the Board have a pressing interest to not Suspend These Proceedings

Fraud is a uniquely serious allegation. A heightened pleading standard is one way that the law recognizes it as such.[5] One accused of fraud should be able to confront the accusation without delay. An agency defrauded has an interest in seeing the matter through expeditiously. A good-faith accuser would naturally want prompt remedy. But, in this case, delay suits Petitioner. After Petitioner indicated on September 9, 2021 its intent to file this motion, Mr. Capovani repeatedly prompted Petitioner to do so. (Palmateer Decl. ¶¶ 4, 5 and 6 and Exhs. "B",

[4] Petitioner has not exhausted its right to request reconsideration of the USPTO's Non-final registration refusal in its *ex parte* trademark application proceedings, to appeal the refusal to the TTAB once the examination process is complete, or ultimately to appeal to the courts.

[5] A plaintiff must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a). *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478-79 (TTAB 2009).

"C" and "D"). Yet, Petitioner inexplicably delayed its filing for many weeks, and then filed this defective motion. Even then, Petitioner failed to serve its motion upon Mr. Capovani and did not file proof of service. (Palmateer Decl. ¶ 2). In the meantime, important deadlines approached, including the discovery deadline in this matter and the October 12, 2021 deadline for Mr. Capovani to answer or otherwise respond to the Civil Action Complaint. (Palmateer Decl. ¶¶ 7 and 8).

Mr. Capovani served his initial disclosures and served his discovery requests in a timely fashion so that Petitioner's responses are due before the December 7, 2021 discovery deadline in this matter. (Palmateer Decl. ¶ 8). Petitioner, on the other hand, failed to serve its initial disclosures or any discovery requests. (*Id.*) A pattern emerges from Petitioner's opting to commence Cancellation in lieu of filing a response to the non-final refusal, then commencing the Civil Action with a deceptive and disheveled Complaint, and then engaging in dilatory tactics in these proceedings. Petitioner is avoiding a determination on the merits in favor of a chance to win by submission under the burden of litigation.

II. Conclusion

For the foregoing reasons, Petitioner's motion should be denied.

Dated: November 10, 2021

/s/Lee Palmateer
Lee Palmateer
LEE PALMATEER LAW OFFICE LLC
90 State Street
Suite 700
Albany, New York 12207
Tel: (518) 591-4636
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: November 10, 2021

/s/Lee Palmateer

Lee Palmateer
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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, vs. JOHN CAPOVANI, Respondent	Cancellation No. 92076810 Registration No. 6056987 **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
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Attorneys for Respondent

Exhibit "A" to Palmateer Declaration

BROWNE GEORGE ROSS LLP
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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*

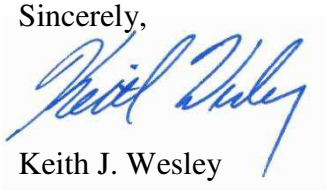
Exhibit "A" to Palmateer Declaration

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,



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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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

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.

Thank you in advance.

Keith

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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

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
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Website: www.albanyiplaw.com

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

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
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Exhibit "D" to Palmateer Declaration

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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

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