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Filing date: **11/30/2021**

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	11/30/2021
Attachments	0370002-Sur-Reply-Suspension.pdf(180027 bytes) 0370002-DECL02-Palmateer.pdf(2933270 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

Registration No. 6056987

vs.

JOHN CAPOVANI,

Respondent

**SUR-REPLY TO PETITIONER'S
MOTION TO SUSPEND**

In this motion for which Petitioner omitted service, failed to embody a brief, and filed two Replies (Docs. CAN-7 and CAN-8), Mr. Capovani respectfully requests leave to file this Sur-Reply.

Finally putting its best foot forward, in its Second Reply (Doc. CAN-8, filed November 29, 2021) Petitioner makes its singular argument on the merits of its Motion. Specifically, Petitioner cites ¶ 23 of the Complaint as the allegation in the Civil Action that may have a bearing in this Cancellation, namely:

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.

This, oddly enough, is a conditional pleading based on speculation that the Court might in the future render a finding that there is a likelihood of confusion. However, there is no allegation in the Civil Action of likelihood of confusion and no allegation that Plaintiff's use of the YRB Marks pre-dates Mr. Capovani's use of the RSC Marks. In fact, Petitioner affirmatively alleges in its Civil Action Complaint that there is no likelihood of confusion. Therefore, the condition precedent of the allegation in ¶ 23 cannot materialize. It is a false premise. And the Federal District Court will not render an advisory opinion where no allegation of fact puts the issue before the Court. Therefore, the Civil Action will not have a bearing on this Cancellation.

In its Second Reply, Petitioner attempts to ingratiate itself, saying “Petitioner trusts the Board to . . . swiftly reject” Mr. Capovani’s “resist[ance]” to its motion. Petitioner says little else on the pretense that it “wishes to honor the Board’s policies disfavoring reply briefs” despite otherwise running roughshod over the rules of procedure and casting the USPTO in a negative light before the Federal District Court in Petitioner’s Civil Action Complaint. What little Petitioner does say, however, is meritless.

Petitioner exhorts the Board to swiftly grant its motion to suspend without scrutinizing its Complaint in its Civil Action. However, in a suspension motion the Board must scrutinize Petitioner’s Complaint 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). Petitioner takes issue with Mr. Capovani’s proposition that scrutiny is warranted on the additional independent grounds that Petitioner’s motion has the effect of an omnibus extension. Regardless, scrutiny of Petitioner’s Complaint is required under TBMP § 510.02(a). Petitioner nevertheless “trusts” that the Board will not scrutinize its Complaint.

Petitioner’s third and final point in its Second Reply is that its failure to serve its motion on Mr. Capovani is a mere technicality producing no prejudice to Mr. Capovani. Petitioner, however, does not address its failure to brief its motion, which obviously is prejudicial to Mr. Capovani. Petitioner did not give Mr. Capovani adequate notice of the factual and legal bases for Petitioner’s motion. Then, Petitioner exacerbated the prejudice by its thin Reply. Petitioner has not met its burden in this motion and has not given adequate notice of its arguments.

In its First Reply, Petitioner downplays its failure to serve its November 1, 2021 Motion

on Mr. Capovani by saying that it served the motion ten days later on November 10, 2021. It should come as no surprised that said purported service came only after Mr. Capovani served his Response on Petitioner. (Palmateer Decl. dated November 30, 2021).

I. Conclusion

For the foregoing reasons and the reasons set forth in Mr. Capovani’s Response, Petitioner’s motion should be denied.

Dated: November 30, 2021

/s/Lee Palmateer
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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
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Attorneys for Petitioner

Respectfully submitted,

Dated: November 30, 2021

/s/Lee Palmateer
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Y.Y.G.M. SA,

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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 sur-reply to Petitioner’s Motion filed on November 1, 2021 (Doc. CAN-5) to suspend these proceedings.

2. Mr. Capovani served his Response to Petitioner’s said motion on November 10, 2021 at 1:36 PM Eastern by email, a true and correct copy of which is annexed hereto and made part hereof as **Exhibit “E”**, and subsequently Petitioner emailed its said motion on November 10, 2021 at 5:59 PM Eastern (2:59 PM Western) by email, a true and correct copy of which is annexed hereto and made part hereof as **Exhibit “F”**.

3. 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 30, 2021

/s/Lee Palmateer
Lee Palmateer (BRN 509188)
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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:

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Attorneys for Petitioner

Respectfully submitted,

Dated: November 30, 2021

/s/Lee Palmateer
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Attorneys for Respondent

Exhibit "E" to Palmateer Decl. 11/30/21

From: [Lee Palmateer](#)
To: [Keith Wesley](#)
Cc: [Eric Lauritsen](#)
Subject: YYGM v. Capovani Cancellation No. 92076810
Date: Wednesday, November 10, 2021 1:36:00 PM
Attachments: [0370002-Response-Suspension.pdf](#)
[0370002-DECL01-Palmateer-with-Exh.pdf](#)

Dear Keith,

Please find attached Mr. Capovani's response to Petitioner's suspension motion and supporting declaration for service upon Petitioner.

Sincerely,

Lee

LEE PALMATEER LAW OFFICE LLC

Intellectual Property Law

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Exhibit "F" to Palmateer Decl. 11/30/21

From: [Andrea A. Augustine](#)
To: [Lee Palmateer](#)
Cc: [Peter Ross](#); [Keith Wesley](#); [Brett D. Katz](#); [Claudia Bonilla](#); [Owandra Hercules](#)
Subject: Y.Y.G.M. SA v. John Capovani [IWOV-DOCSLA.FID376693]
Date: Wednesday, November 10, 2021 5:59:19 PM
Attachments: [image001.png](#)
[2021-11-10-Served-Motion to Suspend TTAB Proceedings - Ratbastard Supply Co..PDF](#)
[2021-11-10-Served-Petitioner s Initial Disclosures.PDF](#)

Dear Counsel,

Attached please find service copies of our Motion to Suspend and our Initial Disclosures regarding the above-referenced matter.

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

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