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

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|------------------------|---|
| Proceeding | 91217154 |
| Party | Plaintiff Nasty Pig, Inc. |
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| Attachments | DIRTY PIG - Notice of Supplemental Authority (Jan. 27, 2016).pdf(687415 bytes) |

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

In the Matter of Application Serial No. 86/085,785
Filed: October 8, 2013
For Mark: DIRTY PIG
Published in the Official Gazette of March 4, 2014

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| NASTY PIG, INC., | : | |
| Opposer, | : | Opposition No. 91217154 |
| v. | : | |
| JANOSKIANS LLC, | : | |
| Applicant. | : | |
| ----- | X | |

**OPPOSER’S NOTICE OF SUPPLEMENTAL AUTHORITY IN FURTHER SUPPORT
OF OPPOSITION TO MOTION FOR LEAVE TO AMEND ANSWER TO ADD
ADDITIONAL AFFIRMATIVE DEFENSES AND PETITION TO CANCEL**

Opposer Nasty Pig, Inc. (“Opposer”) respectfully advises the Board of additional recent authority that further supports Opposer’s opposition to the motion of Applicant Janoskians, LLC (“Applicant”) for leave to amend the Answer to add additional affirmative defenses and a petition to cancel Opposer’s registrations for the mark NASTY PIG.¹ Specifically, the attached en banc decision of the Federal Circuit, *In re Tam*, Case No. 2014-1203 (Fed. Cir. Dec. 22, 2015) and letter brief from the U.S. Department of Justice (“DOJ”) acting on behalf of the Director of the USPTO, bear directly on issues raised in connection with Applicant’s motion.²

In *Tam*, the Federal Circuit held that Section 2(a)’s ban on disparaging marks is unconstitutional because it violates the Freedom of Speech Clause of the First Amendment.

¹ For clarity, this notice of supplemental authority supplements the previous notice filed on January 8, 2016 [Dkt. 25] and thus replaces the previous version.

² The *Tam* decision and the DOJ letter brief are attached hereto as Exhibits A and B, respectively.

Although the *Tam* decision concerned the disparagement ban, the reasoning underlying the Court's holding indicates that Section 2(a)'s ban on immoral or scandalous marks – the provision at issue on the instant motion – suffers from the same constitutional defects.

In its decision, the Federal Circuit expressly linked together Section 2(a)'s bans against disparaging, scandalous or immoral matter under the umbrella of bans “based on the expressive nature of the content.” *Tam*, Decision at p. 7. It sharply distinguished such bans from Section 2(a)'s proscriptions against deceptive matter and false suggestion of a connection, which, in contrast, “further the Lanham Act's purpose in preventing consumers from being deceived.” *Id.*

Further, in reaching its decision that the disparagement ban is unconstitutional, the Federal Circuit adopted a rationale that is equally applicable to the bans on immoral and scandalous marks. First, the Court explained that the bans against disparaging, immoral or scandalous matter are contrary to the purposes of the Lanham Act:

These exclusions from registration [based on disparaging, immoral or scandalous marks] do not rest on any judgment that the mark is deceptive or likely to cause consumer confusion, nor do they protect the markholder's investment in his mark. They deny the protections of registration for reasons quite separate from any ability of the mark to serve the consumer and investment interests underlying trademark protection. In fact, § 2(a)'s exclusions can undermine those interests because they can even be employed in cancellation proceedings challenging a mark many years after its issuance and after the markholder has invested millions of dollars protecting its brand identity and consumers have come to rely on the mark as a brand identifier.

Id. at pp. 7-8. Moreover, the Court recognized that because “it is always a mark's expressive character, not its ability to serve as a source identifier, that is the basis for the disparagement exclusion,” “the government made moral judgments based solely and indisputably on the marks' expressive content” whenever it refused registration on that basis. *Id.* at pp. 23-24. The Court thus concluded that the disparagement ban is unconstitutional because Section 2(a) functions as a regulation of expressive content that does not pass strict scrutiny. *Id.* at pp. 56-57.

The above reasoning applies with equal force to Section 2(a)'s bans on immoral and scandalous matter which likewise regulate a mark's expressive content, and not only its ability to serve as a source identifier. In fact, the DOJ has now confirmed in a pending appeal before the Federal Circuit that the *Tam* decision similarly invalidated Section 2(a)'s bans on immoral and scandalous matter.

In *In re Brunetti*, Case No. 2015-1109 (Fed. Cir.), the DOJ filed a letter brief on January 21, 2016 stating that the Board's decision affirming a refusal to register a mark on the basis of scandalousness should be vacated and remanded for further proceedings because the bar on scandalous marks is no longer viable after *Tam*, which constitutes the binding law of the Federal Circuit. In so holding, the DOJ elaborated as follows:

. . . [G]iven the breadth of the Court's *Tam* decision . . . the reasoning of *Tam* requires the invalidation of Section 2(a)'s prohibition against registering scandalous and immoral marks [in addition to the prohibition against disparaging marks].

. . . [A]fter careful review of the Court's entire opinion, we do not believe that Section 2(a)'s prohibition on registration of scandalous and immoral marks can withstand challenge *under the current law of this Circuit*.

DOJ Letter Brief at pp. 2-3 (emphasis added).³

Accordingly, Opposer respectfully submits that the Federal Circuit's recent decision in *Tam* precludes Applicant's proposed counterclaim based on immoral or scandalous matter.

CONCLUSION

For the additional foregoing reasons, Opposer respectfully requests that Applicant's Motion for Leave to Amend Answer to Add Additional Affirmative Defenses and Petition to Cancel be denied in its entirety.

³ To the extent Applicant argues that Section 2(a)'s ban on scandalous marks remains viable because the government may appeal the *Tam* decision, this is incorrect. As the DOJ's letter brief recognizes, *Tam* constitutes the current law of the Federal Circuit and thus bars all current claims for scandalousness as a matter of law irrespective of any hypothetical appeal.

Dated: New York, New York
January 27, 2016

Respectfully submitted,

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