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

Proceeding	92051140
Party	Defendant Product Source International, LLC
Correspondence Address	Jay DiMarino A.J. DiMarino PC 57 Euclid Street, Suite A Woodbury, NJ 08096 UNITED STATES ajd@dimarinolaw.com
Submission	Motion to Dismiss - Rule 12(b)
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Date	10/07/2009
Attachments	NIC OUT Reply Brief--Motion to Dismiss AS FILED.pdf ( 7 pages )(28978 bytes )

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

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**Leonid Nahshin,**  
153/36 Beer-Sheva  
Beer-Sheva, 84746  
ISRAEL  
Plaintiff-Petitioner  
vs.

**Product Source International, LLC**  
13 Coleman Road  
Berlin, NJ 08009  
UNITED STATES  
Defendant-Respondent

**Opposition No.:** 92/051,140  
**Registration No.:** 3,350,041  
**Mark:** NIC-OUT  
**Interlocutory Attorney:**  
Ann Linnehan, Esq.

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**DEFENDANT’S REPLY BRIEF IN  
SUPPORT OF ITS MOTION TO DIMSISS**

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COMES NOW Defendant Product Source International, LLC (“PSI”) and replies to those untitled papers filed on September 23, 2009, by Plaintiff Leonid Nashin.<sup>1</sup> While Defendant respects the Board’s reluctance to consider reply briefs,<sup>2</sup> it nonetheless believes a small submission is in order. Specifically, Defendant seeks: i) to clarify whether it has received all relevant filings, and ii) to point out that Plaintiff’s most recent filing is untimely, fails in any substantive manner to respond to Defendant’s many objections, fails to remedy the numerous defects in the complaint, and, at best, contains irrelevant material. A prompt and favorable ruling on Plaintiff’s Motion to Dismiss is therefore respectfully requested since the motion has gone effectively unopposed.

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<sup>1</sup> Although the context in which the September 23 filing was made remains unclear, Defendant—once again called upon to supply details left blank by Plaintiff—surmises that those papers are somehow responsive to Defendant’s prior motion to dismiss, filed August 2, and therefore styles the present submission accordingly for lack of a better alternative.

<sup>2</sup> See TMEP § 502.02(b) (“The filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief.”); accord *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) (“The presentation of one’s arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.”).

**I. PROCEDURAL HISTORY—DOCUMENTS RECEIVED BY DEFENDANT**

The primary function of Defendant's present submission is to ascertain whether Defendant has received all relevant documents and submissions to the Board regarding the action at hand. Given the unusual nature of Plaintiff's September 23 filing (as explained below), the undersigned counsels for Defendant are genuinely concerned they may have missed important explanatory materials. To date, Defendant has been served by Plaintiff with only two documents: the initial complaint filed and served on June 23, and the aforementioned untitled documents filed and served on September 23. For the reasons explained below, Defendant cannot reasonably construe the September 23 filing as truly responsive to any prior-filed submission, and the September 23 filing does not stand on its own as a substantive brief, motion, or other appropriate document.

Further, on August 3 Defendant filed a motion to dismiss, which was deemed by Board order as having been served on August 17, and subject to clarifying correspondence from Defendant on August 21 and 24. Defendant has also received several communications from the Board including the June 23 notice and scheduling order, the August 17 order regarding defective proof of service for Defendant's motion to dismiss, and the August 31 suspension order. To the best of its knowledge, Defendant believes these are the only documents filed in the present case.

To the extent there were any additional documents from Plaintiff that would assist in clarifying Plaintiff's September 23 filing, Defendant has not received it and politely requests a copy. Clarification on this issue is politely requested in any event.

## **II. PLAINTIFF'S SEPTEMBER 23 SUBMISSION**

To the extent Plaintiff's September 23 filing is intended as a response to Defendant's August 3 motion to dismiss, such a response is untimely, non-responsive, and immaterial.

Initially, the September 23 filing was not submitted in time to be properly considered a response to Defendant's August 3 motion to dismiss. By order of the Board, Defendant's motion was served on August 17. A timely response was therefore due no later than September 21.<sup>3</sup> Being filed and served on September 23, the untitled submission is untimely, at least to the extent it seeks to respond to Defendant's motion.

Furthermore, Plaintiff has once again submitted to the Board and served upon Defendant documents whose meaning cannot be clearly ascertained. With no explanation whatsoever as to their relevance or substance, Plaintiff has submitted a small handful of documents of largely foreign origin, which include:

- A March 26, 2002, report entitled "Invoice 3511;"
- A March 29, 2002, report entitled "Exporter's Statement of Origin;"
- A March 29, 2009, report entitled "Authentication Signature;"
- A March 9, 2009 (presumably), report entitled "Apostile;"
- An undated report entitled "Newspaper 'INFO;'"
- A July 3, 1999, report entitled "Licensed Business Certificate;"
- An undated and untitled report in untranslated Hebrew;
- A September 23, 2009, copy of the TARR database report for U.S. Trademark Serial No. 78/296,651 for NIC-OUT; and
- Three (3) copies of a September 23, 2009, Certificate of Service signed by Vera Chernobylsky, Esq.

Defendant objects to the submission of these documents to the extent that none of them have been authenticated, that several of them are in a foreign language without a translation attached (or clearly identified), and that even assuming their relevance,

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<sup>3</sup> Defendant respectfully submits that its motion to dismiss was properly served upon counsel for Plaintiff on August 3, 2009, and that the Board's August 17 Order is in error inasmuch as it confuses the concept of defective service with the legally distinct concept of defective proof of service. (Any failure by Defendant was by way of not proving service to the Board, not by way of improperly serving Plaintiff.)

timeliness, and authentication, their submission alone does not rectify the several defects complained of in Plaintiff's complaint.

Specifically, Defendant's August 3 motion clearly articulated five (5) bases of objection with amply cited supporting legal authority. These bases include: i) failure to state a valid statutory basis for cancellation; ii) Plaintiff's lack of standing for failure to allege damage; iii) failure to state a claim upon which relief can be granted; iv) an objection to irrelevant and inflammatory material within the complaint; and v) an objection to a portion of the complaint's informal structure and styling. To date no statutory basis has been corrected or amended. No statement has been made that Plaintiff will suffer damage by continued registration of the subject mark, and therefore doubt still exists as to Plaintiff's standing to bring the present action. Plaintiff has still not stated any basis upon which relief can be granted. The objectionable portion from Plaintiff's complaint has neither been stricken from the complaint nor its inclusion defended. And no reply has been made as to the informal nature of questionable portions of Plaintiff's complaint. The September 23 filing, furthermore, adds absolutely nothing to the resolution of these issues.

To the extent the submitted documents bear any apparent relevance on the dispute at hand, they appear to evince use of the mark NIC OUT in the sovereign nation of Israel. As such, they do not evince use of the mark "in commerce" as defined by the Trademark Act, since "commerce" must reside within the United States. If they accomplish any more than this, the explanatory burden falls to Plaintiff—a responsibility he has utterly dodged.

Hence, the documents are *inter alia* untimely, non-responsive, and irrelevant.

### **III. CONCLUSION**

Plaintiff has therefore failed to respond in a timely, substantive, or relevant fashion to Defendant's August 3 motion to dismiss. Defendant has accordingly been forced to sit idly by for some four (4) months under threat of legal action but without any genuine understanding of the basis for that action or of Plaintiff's standing to bring that action. Plaintiff, on the other hand, has been given ample opportunity to rectify the many defects of its pleading, but has failed to do so. He has opted instead to file, without explanation and only after the relevant deadline had passed, a collection of inexplicable foreign documents whose meaning and relevance are obscure.

Defendant cannot be expected to continue responding to vague and insufficiently documented legal complaints at considerable inconvenience and expense. Nor can Defendant be expected to continue running its business under a nebulous threat of legal action without a proper understanding of its liabilities.

Defendant therefore respectfully requests that its motion to dismiss should be granted and that a dismissal with prejudice be entered into the instant proceeding.

Date: October 7, 2009

Respectfully Submitted:

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**CERTIFICATE OF SERVICE**

I, Anthony J. DiMarino III, Esquire, counsel to Defendant-Respondent Product Source International, LLC, hereby certify that the foregoing DEFENDANT’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS was sent this 7<sup>th</sup> day of October, 2009, via regular mail to the below-named counsel for Plaintiff-Petitioner Mr. Leonid Nahshin:

Vera Chernobylsky, Esquire  
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\_\_\_\_\_/Jay DiMarino/\_\_\_\_\_  
Anthony J. DiMarino III, Esq.