

ESTTA Tracking number: **ESTTA392673**

Filing date: **02/10/2011**

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

Proceeding	92051140
Party	Plaintiff Leonid Nahshin
Correspondence Address	VERA CHERNOBYLSKY LAW OFFICES OF VERA CHERNOBYLSKY 4623 DUNMAN AVENUE WOODLAND HILLS, CA 91364 UNITED STATES vchernob@yahoo.com
Submission	Plaintiff's Notice of Taking Testimony
Filer's Name	Vera Chernobytsky
Filer's e-mail	vchernob@yahoo.com
Signature	/Vera Chernobytsky/
Date	02/10/2011
Attachments	Notice of Deposition of Yael Menkin & Doc-s.pdf (10 pages)(660993 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

In the matter of U.S. Registration 3,350,041,
For the mark NIC OUT,
Registered on the Principal Register on December 4, 2007.

Leonid Nahshin,

Petitioner,

vs.

Petition No. 92051140

Product Source International, LLC,

Registrant.

NOTICE OF TAKING DEPOSITION OF YAEL MENKIN

To the parties who have appeared in the above cause of action, and their attorneys
of record:

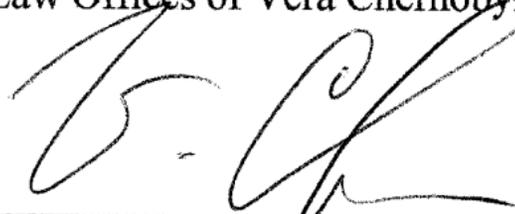
YOU ARE NOTIFIED that on Feb. 16, 2011 [date], at 2:30 pm [time],
Leonid Nahshin [plaintiff] will take the oral deposition of Yael Menkin, the
witness in this action, at the office of John Allegra, Esq
(name of law firm), located at 224 Middle Rd, Hazlet, NJ
07730 [address], Hazlet [city], _____ County,
New Jersey.

Deponent is required to produce at the deposition the materials described in Exhibit A
attached to this notice and incorporated by reference.

The Proof of Service attached to this notice contains a list of the parties and attorneys on whom this notice has been served.

Respectfully submitted this 10 day of February, 2011.

Law Offices of Vera Chernobytsky

A handwritten signature in black ink, appearing to read 'V. Chernobytsky', written over a horizontal line.

Vera Chernobytsky, Esq.

4623 Dunman Avenue

Woodland Hills, CA 91364

Attorney for the Petitioner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board**

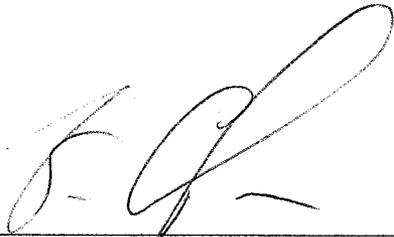
In the matter of U.S. Registration 3,350,041,
For the mark NIC OUT,
Registered on the Principal Register on December 4, 2007.

Leonid Nahshin, :
 :
 :
 Petitioner, :
 :
 :
 vs. : Petition No. 92051140
 :
 :
 Product Source International, LLC, :
 :
 :
 Registrant. :

CERTIFICATE OF SERVICE

I HERBEY CERTIFY that a true and accurate copy of the foregoing Notice of Taking Testimony of Yael Menkin was submitted, this 10 day of February, 2011, to the following via fax and first-class U.S. Mail, postage pre-paid:

Jay DiMarino
A.J. DiMarino PC
57 Euclid Street, Suite A
Woodbury, NJ 08096



Vera Chernobylsky, Esq.

EXHIBIT A

Document Description: **Offc Action Outgoing**Mail / Create Date: **07-Jul-2003**[Previous Page](#)[Next Page](#)You are currently on page **1** of **3**

To: Nahshin, Leonid (m.yael@lycos.com)
Subject: TRADEMARK APPLICATION NO. 78206651 - NIC-OUT - N/A
Sent: 7/7/03 6:12:51 PM
Sent As: ECom105
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/206651

APPLICANT: Nahshin, Leonid

CORRESPONDENT ADDRESS:

Menkin, Yael
 2607 WELSH RD APT E207
 PHILADELPHIA PA 19114-3316

RETURN ADDRESS:

Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, VA 22202-3514
ecom105@uspto.gov

MARK: NIC-OUT

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:m.yael@lycos.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/206651 NIC-OUT

The assigned examining attorney has reviewed the referenced application and determined the following.

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Likelihood of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. 2337463 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

The applicant seeks registration of NIC-OUT for "cigarette filter holder to reduce the inhalation of tar and nicotine." The registered mark is NICOUT for "smoker's apparatus for puncturing holes in cigarettes." The applicant's mark is nearly identical to the mark in the cited registration. Despite the hyphen in the applicant's mark, the marks are spelled the same and sound the same.

Further, the applicant's goods are highly similar to the goods provided by the registrant. While not identically, the parties' goods are related in that they would be sold in the same channels of trade to the same purchasers, namely those seeking products that reduce the nicotine and/or tar in cigarettes.

Since the marks are confusingly similar, and the goods are highly related, it is likely purchasers would confuse the sources of the goods. The examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). Accordingly, the mark is refused registration under Section 2(d).

The applicant should note the following potential ground for refusal.

Prior Pending Application

The examining attorney encloses information regarding pending Application Serial No. 78-163268. The filing date of the referenced application precedes the applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §1208.01.

Action on this application will be suspended pending the disposition of Application Serial No. 78-163268, upon receipt of the applicant's response resolving the following informalities.

Cannot Assert §1(a) and §1(b) for the Same Goods

The applicant asserts use of the mark in commerce for "cigarette filter holder to reduce the inhalation of tar and nicotine" and applicant asserts that it has a bona fide intent to use the mark in commerce for the same goods. An applicant may not assert both use of the mark in commerce, under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and intent to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b), for the same goods. 37 C.F.R. §2.34(b)(1); TMEP §806.02(b). The

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applicant must delete one basis or divide the goods between the two bases, as appropriate.

Response

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

If the applicant does not have an attorney the applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The Patent and Trademark Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If the applicant has any questions or needs assistance in responding to this office action, please telephone the assigned examining attorney.

/Idi Aisha Clarke/
Trademark Attorney
Law Office 105
(703) 308-9105 Ext. 248
Fax: (703) 872-9825

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

[TDR Home](#)

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- **General trademark information:** Please e-mail TrademarkAssistanceCenter@uspto.gov, or telephone either 571-272-9250 or 1-800-786-9199.
- **Technical help:** For instructions on how to use TDR, or help in resolving technical glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](mailto:ElectronicBusinessSupport@uspto.gov), or call 1-800-786-9199.
- **Questions about USPTO programs:** Please e-mail [USPTO Contact Center \(UCC\)](mailto:USPTOContactCenter@uspto.gov).

Please Note:

- The Mail/Create Date is the date the document was loaded into the database; it is not necessarily the mailing date from which the response period, if any, flows. The mailing date is available in the prosecution history in TARR.
- Some filings made through the Trademark Electronic Application System (TEAS) are not uploaded immediately into TDR. Instead, it may take approximately seven (7) calendar days for the upload. If that amount of time has passed and your filing is still not appearing, please e-mail TDR@uspto.gov.

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-12-14 18:09:46 ET

Serial Number: 78206651 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark (words only): NIC-OUT

Standard Character claim: No

Current Status: Abandoned-Failure To Respond Or Late Response

Date of Status: 2004-02-25

Filing Date: 2003-01-23

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-04-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Nahshin, Leonid

Address:

Nahshin, Leonid

HAZVI 153/36

Beer-Sheva 84746

Israel

Legal Entity Type: Individual

Country of Citizenship: Israel

Phone Number: (972) 8 642-1322

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GOODS AND/OR SERVICES

International Class: 034

Class Status: Active

cigarette filter holder to reduce the inhalation of tar and nicotine.; cigarette filter holder to reduce the inhalation of tar and nicotine.

Basis: 1(a)

First Use Date: 2000-10-01

First Use in Commerce Date: 2000-10-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2004-02-25 - Abandonment - Failure To Respond Or Late Response

2003-07-07 - Non-final action e-mailed

2003-07-07 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

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2607 WELSH RD APT E207

PHILADELPHIA PA 19114-3316

Phone Number: 215-671-1060

Domestic Representative

Menkin, Yael

Phone Number: 215-671-1060

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