

ESTTA Tracking number: **ESTTA394389**

Filing date: **02/22/2011**

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	Testimony For Plaintiff
Filer's Name	Vera Chernobylsky
Filer's e-mail	vchernob@yahoo.com
Signature	/Vera Chernobylsky/
Date	02/22/2011
Attachments	Testimony Menkin and Exhibit.pdf (11 pages)(514294 bytes)

3. What do you know about Mr. L. Nahshin's first transaction of his goods using trademark NIC-OUT in United States?

When he made his first "NIC-OUT" batch I was already living in the United States with my husband. Leonid asked me to help him promote "NIC-OUT" on USA market. I promised him to look for some leads and asked Leonid to send me "NIC-OUT" cigarette filters.

Leonid Nahshin sent me a package with "NIC-OUT" cigarette filters. The package came in November of 2000. I picked it up at the local post office. It was packed in Israel trademark postal box.

The package weight was about 8 lbs. In the package there were 4 boxes of 80 packs "NIC-OUT." It had a very appealing design, especially a white-blue color combination.

4. What do you know about Mr. L. Nahshin's business relationship with Mr. N. Maslov?

During the next few years I was extremely busy with my marriage, work and a new baby to pursue any significant leads. Thankfully, in 2002, Leonid informed me that he found a man in the U.S. who is willing to promote "NIC-OUT" on U.S. market. His name was Nikolay Maslov. In 2002 Leonid sent Nikolay two parcels with "NIC-OUT".

5. What do you know about Mr. L. Nahshin's intent to protect his rights in his trademark NIC-OUT?

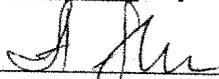
Leonid Nahshin was very worried, that his trademark "NIC-OUT" does not have protection in the U.S. market. He was also disturbed about possibility of poor quality forgeries. I understood his concerns. I saw how hard he works on distribution and promotion of "NIC-OUT" in U.S. market. It was clear that his business in U.S. was organized.

Leonid Nahshin wanted to protect his trademark. He asked me to help him to find a lawyer to patent his "NIC-OUT" trademark in the United States.

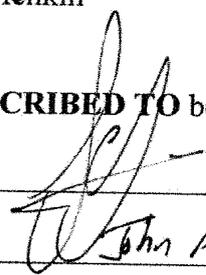
Later, on January 23, 2003, on behalf of Leonid Nahshin I filed USPTO Trademark Application. His USPTO Trademark Application Serial Number 78206651 with USPTO Word Mark: "NIC-OUT" for International Class "034", Goods & Services described as "G & S: cigarette filter holder to reduce the inhalation of tar and nicotine.; cigarette filter holder to reduce the inhalation of tar and nicotine." Please see attached documents .

In 2004 we had to abandon this Trademark Application due to existence of prior pending Trademark Application Serial No. 78-163268.

DATED this 16 day of February, 2011

By: 
Yael Menkin

SWORN AND SUBSCRIBED TO before me this 16th day of February, 2011

Notary Public:  (signature)

Notary Public: John ALLEGKA (Typed/Printed name of Notary Public)

Commission No. _____ John ALLEGKA

My Commission Expires: lifetime Attorney At Law
STATE of NEW JERSEY

**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 testimony and Documents in Exhibit A were submitted, this 22 day of February, 2011, to the following via first-class U.S. Mail, postage pre-paid:

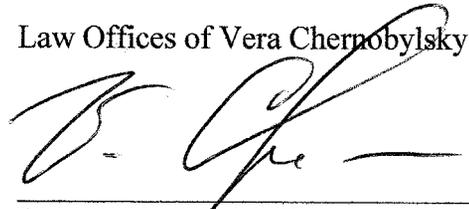
Jay DiMarino
A.J. DiMarino PC
57 Euclid Street, Suite A
Woodbury, NJ 08096



Vera Chernobylsky, Esq.

Respectfully submitted this 22 day of February, 2011.

Law Offices of Vera Chernobylsky

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

Vera Chernobylsky, Esq.

4623 Dunman Avenue

Woodland Hills, CA 91364

Attorney for the Petitioner

EXHIBIT A

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.

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 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.

NICOUT

Serial Number

75517935

Status

REGISTERED

Word Mark

NICOUT

Registration Number

2337463

Date Registered

2000/04/04

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Hsu, Henry C. INDIVIDUAL UNITED STATES 29-42 162nd Street Flushing NEW YORK 11358

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S:
Smoker's Apparatus for Puncturing Holes in Cigarettes. First Use:
1998/06/00. First Use In Commerce: 1998/06/00.

Filing Date

1998/07/13

Examining Attorney

SNAPP, TINA L.

Attorney of Record

RICHARD O CHURCH

TYPED DRAWING

Serial Number

78163268

Status

NON-FINAL ACTION - MAILED

Word Mark

NIC-OUT

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Safety Aid Supplies Inc. CORPORATION NEW YORK 3411 Irwin Avenue, Suite 6F, Bronx New York NEW YORK 10463

Goods/Services

Class Status -- ACTIVE. IC 034. US 002 008 009 017. G & S:
Cigarette holder made of plastic with filter inside.

Filing Date

2002/09/12

Examining Attorney

DWYER, JOHN