

ESTTA Tracking number: **ESTTA398319**

Filing date: **03/16/2011**

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	ANTHONY J DIMARINO AJ DIMARINO PC 57 EUCLID STREET, SUITE A WOODBURY, NJ 08096 UNITED STATES ajd@dimarinolaw.com
Submission	Motion to Strike
Filer's Name	Anthony J. DiMarino, III
Filer's e-mail	ajd@dimarinolaw.com, doner@dimarinolaw.com
Signature	/Anthony J. DiMarino, III/
Date	03/16/2011
Attachments	Motion to Strike Testimony of Yael Menkin.pdf (6 pages)(254407 bytes) AJD Affidavit support Motion to Strike.pdf (32 pages)(1148299 bytes)

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

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.

MOTION TO STRIKE TESTIMONY OF Yael MENKIN

COMES NOW Defendant-Respondent Product Source International, LLC (“PSI”) and respectfully requests that the following Motion to Strike the Testimony of Yael Menkin be granted.

I. INTRODUCTION

Petitioner’s Pretrial Disclosures were due on December 30, 2010. Four months after it submitted its Initial Disclosures, and more than five weeks after its Pretrial Disclosures were due, Petitioner informed Respondent for the first time that it intended to rely on testimony from Yael Menkin in support of its petition to cancel. At her “deposition”, Ms. Menkin produced an affidavit as her testimony, leaving Respondent with no opportunity to cross examine her. Petitioner’s failure to identify Ms. Menkin as a witness until after the close of discovery has seriously prejudiced Respondent’s defense of this action. This injury to Respondent is further

compounded by Petitioner wrongfully submitting an affidavit and depriving Respondent of the opportunity to cross examine Ms. Menkin or object to her testimony. Petitioner's continued disregard of the rules of this forum should not be countenanced. Accordingly, Respondent seeks to strike Ms. Menkin's testimony in its entirety pursuant to Rule 26(a) and 37(c)(1) of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.121 and 2.123 of the Trademark Rules of Practice.

II. BACKGROUND

On the afternoon of Tuesday, February 8, 2011, at approximately 4:30 p.m. counsel for Respondent, Jay DiMarino, received a phone call from counsel for Petitioner, Vera Chernobylsky. Ms. Chernobylsky advised Mr. DiMarino that she intended to take the deposition of Yael Menkin at 9:30 a.m. on Thursday, February 10. This was the first time that Ms. Chernobylsky had ever suggested that Petitioner intended to rely on Ms. Menkin as a witness in this cancellation proceeding. See Affidavit of Anthony J. DiMarino, III submitted with this Motion.

Mr. DiMarino advised Ms. Chernobylsky that he was unable to attend the deposition on that date and requested Ms. Chernobylsky reschedule. At first, Ms. Chernobylsky stated that Mr. DiMarino had no right to object and that she was not required to give him notice. Mr. DiMarino responded that reasonable notice was required and that notice received at 4:30 p.m. on a Tuesday for a deposition that would take place at 9:30 a.m. on Thursday of the same week was not reasonable. Ultimately, the parties agreed to a deposition date of February 16 at 2:30 p.m.

On February 10, 2011, Petitioner served Respondent with notice that Petitioner intended to depose Ms. Menkin on February 16. The notice of deposition specifically stated that

Petitioner “will take the *oral* deposition of Yael Menkin,” (emphasis added). At no time did Petitioner indicate that Ms. Menkin’s deposition would not be taken by oral examination.

On February 16, 2011, counsel for Respondent prepared for the deposition of Ms. Menkin, travelled approximately two hours to the location of the deposition and was prepared to cross examine Ms. Menkin while also protesting the deposition on the ground that neither Ms. Menkin’s identity as a witness nor the substance of her testimony were disclosed to Respondent prior to the opening of trial. However, upon arrival, counsel for Respondent learned that Ms. Menkin would not testify by oral examination at all, but rather that she had prepared an affidavit, which she proceeded to sign and swear to, as her testimony.

III. ARGUMENT

A. Ms. Menkin’s Testimony Should be Stricken Because Petitioner Failed to Identify Ms. Menkin in Petitioner’s Initial Disclosures

Rule 26(a)(1)(A) of the Federal Rules of Civil Procedure and the Board’s rules require that a party, without awaiting a discovery request, disclose the name and, if known, the address and telephone number of each individual likely to have discoverable information. 37 C.F. R. § 2.120. Moreover, parties are required to supplement these disclosures in a timely manner when they learn they are incomplete. Fed. R. Civ. P. 26(a)(1)(A); 37 C.F.R. § 2.120. A party who fails to identify a witness in its initial disclosures may not call that witness to testify unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c)(1).

Here, Petitioner failed to identify Ms. Menkin in Petitioner’s Initial Disclosures or in any subsequent supplement until after the close of discovery when Ms. Chernobylsky contacted Mr. DiMarino by phone and served Petitioner’s overdue Pretrial Disclosures. Consequently, Petitioner’s inadequate disclosure is far from harmless because Respondent had no opportunity

to seek discovery of Ms. Menkin or adjust its strategy of the defense of this action. Allowing Ms. Menkin's testimony at this point would severely prejudice Respondent's defense of this case and is exactly the kind of inequitable trial tactic Federal Rules 26 and 37 are intended to prevent. Therefore, the Board should strike Ms. Menkin's testimony in its entirety.

B. Ms. Menkin's Testimony Should Also be Stricken Because Ms. Menkin Impermissibly Testified by Written Affidavit and Not by Oral Examination

To submit testimony by written affidavit, written agreement of the parties is required:

By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing. *See* 37 CFR § 2.123(b).

Here, Petitioner at no time evinced any intention of submitting Ms. Menkin's testimony by written affidavit and there was certainly no agreement between the parties to this effect. Mr. DiMarino arrived at Ms. Menkin's deposition with the intention of cross examining her while also protesting the deposition on the ground that neither Ms. Menkin's identity as a witness nor the substance of her testimony were disclosed to Respondent prior to the opening of trial. Instead, Mr. DiMarino had no opportunity to even cross examine Ms. Menkin—let alone register a protest. Upon his arrival, Mr. DiMarino learned for the first time that Ms. Menkin's testimony was to be submitted by written affidavit. Petitioner has provided no explanation as to why Petitioner failed to disclose Ms. Menkin as a knowledgeable witness in its Initial Disclosures or why its Pretrial Disclosures were filed more than five weeks after they were due. Petitioner has made no effort to address why Ms. Menkin submitted testimony by affidavit rather than by oral

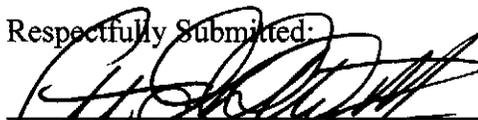
examination. Petitioner's continued disregard of the rules that govern this proceeding should not be countenanced nor rewarded.

IV. CONCLUSION

For the reasons set forth above, Respondent respectfully requests that the Board grant its Motion to Strike the Testimony of Yael Menkin in its entirety.

Date: March 16, 2011

Respectfully Submitted:



Anthony J. DiMarino III, Esq.
U.S.P.T.O. Reg. No. 37,312
ajd@dimarinolaw.com

A.J. DiMarino P.C.
57 Euclid Street, Suite A
Woodbury, NJ 08096
(856) 853-0055 main
(856) 853-2866 fax

CERTIFICATE OF SERVICE

I, Anthony J. DiMarino III, Esquire, counsel to Defendant-Respondent Product Source International, LLC, hereby certify that the foregoing Defendant-Respondent, Product Source International's, Motion to Strike Testimony Of Yael Menkin and Affidavit of Anthony J. DiMarino, III, Esquire, was sent this 16th day of March, 2011, via facsimile and regular mail to the below-named counsel for Plaintiff-Petitioner, Leonid Nahshin:

Vera Chernobylsky, Esquire
Law Offices of Vera Chernobylsky
4623 Dunman Avenue
Woodland Hills, CA 91364

A handwritten signature in black ink, appearing to read 'Anthony J. DiMarino III', written over a horizontal line.

Anthony J. DiMarino III, Esq.

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

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.

AFFIDAVIT OF ANTHONY J. DIMARINO, III
IN SUPPORT OF DEFENDANT-RESPONDENT'S
MOTION TO STRIKE TESTIMONY OF YAEL MENKIN

I, Anthony J. DiMarino, III, being of full age, declare the following upon my personal knowledge:

1. I am a member of this bar and an attorney with the law firm of A.J. DiMarino, P.C., 57 Euclid Street, Suite A., Woodbury, New Jersey 08096. I am counsel for Defendant-Respondent, Product Source International, Inc., and do submit this Affidavit in support of Defendant-Respondent's Motion to Strike the Testimony of Yael Menkin.

2. Vera Chernaobylsky, Esquire, attorney for Petitioner, submitted Initial Disclosures in this matter on October 19, 2010. Petitioner did not identify Yael Menkin in its Initial Disclosures.

3. Petitioner's Pretrial Disclosures were due on December 30, 2010.

4. I received Petitioner's Pretrial Disclosures on February 15, 2011. Petitioner included Yael Menkin as an individual likely to testify as a witness and to have discoverable information.

5. For the first time, four months after it submitted its Initial Disclosures, and more than five weeks after its Pretrial Disclosures were due, Petitioner informed Respondent that it intended to rely on testimony from Yael Menkin in support of its petition to cancel.

6. Petitioner has provided no explanation as to why Petitioner failed to disclose Ms. Menkin as a knowledgeable witness in its Initial Disclosures or why its Pretrial Disclosures were filed more than five weeks after they were due.

7. On the afternoon of Tuesday, February 8, 2011, at approximately 4:30 p.m. I received a phone call from counsel for Petitioner, Vera Chernobylsky. Ms. Chernobylsky advised me that she intended to take the deposition of Yael Menkin at 9:30 a.m. on Thursday, February 10. This was the first time that Ms. Chernobylsky had ever suggested that Petitioner intended to rely on Ms. Menkin as a witness in this cancellation proceeding.

8. I advised Ms. Chernobylsky that I was unable to attend the deposition on that date and requested Ms. Chernobylsky reschedule. At first, Ms. Chernobylsky stated that I had no right to object and that she was not required to give me notice. I responded that reasonable notice was required and that notice received at 4:30 p.m. on a Tuesday for a deposition that would take place at 9:30 a.m. on Thursday of the same week was not reasonable. Ultimately, it was agreed that the deposition would occur on February 16 at 2:30 p.m.

9. I also informed Ms. Chernobylsky that Respondent objected to the use of Ms. Menkin as a witness for trial.

10. Ms. Chernobylsky never indicated that she would be submitting Ms. Menkin's testimony by written affidavit and there was no agreement between the parties to this effect.

11. On February 10, 2011, Petitioner served Respondent with notice that Petitioner intended to depose Ms. Menkin on February 16. The notice of deposition specifically stated that Petitioner "will take the *oral* deposition of Yael Menkin," (emphasis added). At no time did Petitioner indicate that Ms. Menkin's deposition would not be taken by oral examination.

12. On February 16, 2011, I prepared for the deposition of Ms. Menkin, travelled approximately two hours to the location of the deposition and was prepared to cross examine Ms. Menkin while also protesting the deposition on the ground that neither Ms. Menkin's identity as a witness nor the substance of her testimony were disclosed to Respondent prior to the opening of trial. However, upon arrival, I learned that Ms. Menkin would not testify by oral examination at all, but rather that she had prepared an affidavit, which she proceeded to sign and swear to, as her testimony.

13. When I arrived at the deposition, I met Yael Menkin and Peter Allegra, Esquire, who was acting on behalf of counsel for Petitioner, Vera Chernobylsky. Mr. Allegra informed me that he was there to witness the signature of Yael Menkin to an affidavit. He told me that he had spoken to Ms. Chernobylsky the day before and had specifically asked whether a Notice of Deposition had been served. Ms. Chernobylsky apparently told Mr. Allegra that no notice of deposition had been served. I then showed the deposition notice I received to Mr. Allegra.

14. Petitioner has made no effort to address why Ms. Menkin submitted testimony by affidavit rather than by oral examination.

15. Attached to this Affidavit as Exhibit "A" is a true and correct copy of the Notice of Deposition that I received from Vera Chernobylsky on February 16, 2011.

16. Attached to this Affidavit as Exhibit "B" is a true and correct copy of the affidavit which was signed by Yael Menkin.

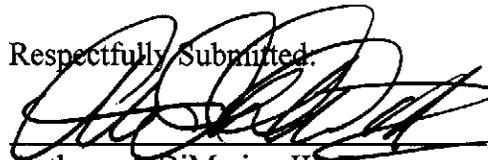
17. Attached to this Affidavit as Exhibit "C" is a true and correct copy of Petitioner's Initial Disclosures.

18. Attached to this Affidavit as Exhibit "D" is a true and correct copy of Petitioner's Pretrial Disclosures.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Date: March 16, 2011

Respectfully Submitted.



Anthony J. DiMarino III, Esq.
U.S.P.T.O. Reg. No. 37,312
ajd@dimarinolaw.com

A.J. DiMarino P.C.
57 Euclid Street, Suite A
Woodbury, NJ 08096
(856) 853-0055 main
(856) 853-2866 fax

EXHIBIT 'A'

**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:

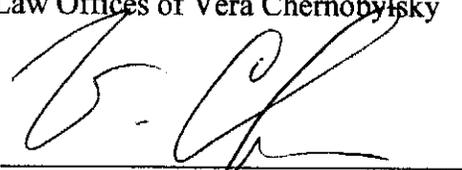
YOU ARE NOTIFIED that on Feb. 16, 2011 [date], at 2:30 pm [time],
Leonid Nahshin [plaintiff] will take the oral deposition of Yael Menkin, the
witness in this action, at the office of John Allegra, Esq
(name of law firm), located at 224 Middle Rd, Hazlet, NJ
07730 [address], Hazlet [city], _____ County,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

FAQ: Are you seeing only the first page of this PDF document?

If you need help:

- **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).

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- *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.*

000126

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

000127

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

Menkin, Yael

2607 WELSH RD APT E207

PHILADELPHIA PA 19114-3316

Phone Number: 215-671-1060

Domestic Representative

Menkin, Yael

Phone Number: 215-671-1060

600128

EXHIBIT 'B'

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.

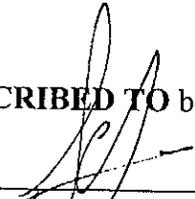
Later, on January 23, 2003, on behalf of Leonid Nahshin I filed USPTO Trademark Application. His USPTO Trademark Application Serial Number 78206651 with USPTO Word Mark: "NIC-OUT" for International Class "034", Goods & Services described as "G & S: cigarette filter holder to reduce the inhalation of 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
Attorney At Law
STATE of NEW JERSEY

My Commission Expires: Indefinite

EXHIBIT 'C'

LAW OFFICES OF VERA CHERNOBYLSKY

4623 Dunman Avenue, Woodland Hills, California 91364-3817
Tel: 818-251-6783 • Fax: 818-638-7844 • VChernob@yahoo.com

October 19, 2010

Via Email ajd@dimarinolaw.com & First Class U.S. Mail

Anthony J. DiMarino
A.J. DiMarino P.C.
Fax: 856.853.2866
57 Euclid Street, Suite A
Woodbury, NJ 08096

RE: Leonid Nahshin v. Product Source International, LLC

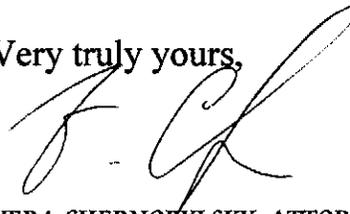
Dear Mr. DiMarino:

I represent Leonid Nahshin in the above referenced matter.

Please find enclosed Initial Disclosures, Petitioner's Amended First Set Of Interrogatories to Registrant, Petitioner's Amended Requests For Production Of Documents. Kindly respond to these discovery requests within thirty (30) days.

Please contact me if you have any questions regarding this matter.

Very truly yours,



VERA CHERNOBYLSKY, ATTORNEY AT LAW
LAW OFFICES OF VERA CHERNOBYLSKY

Tel: 818-251-6783

Fax: 818-638-7844

E-mail: VChernob@yahoo.com

Website: www.VChernPatLaw.com

4623 Dunman Avenue

Woodland Hills, California, 91364

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.	:	

INITIAL DISCLOSURES

COMES NOW the Petitioner, Leonid Nahshin (hereinafter "Petitioner"), and pursuant to the scheduling order entered in this matter provides the following initial disclosures as required by the applicable rules of the Board.

Disclosures

1. The name(s) and address(s) of each individual likely to have discoverable information along with the subject(s) of that information that may be used to support Petitioner's claims:

Leonid Nahshin
ISRAEL HAZVI 153/36
Beer-Sheva ISRAEL 84746

Leonid Nahshin retains information concerning all aspects of the instant matter including, but not limited to, his rights in the mark at issue, dates of use thereof, marketing and other stream of commerce matters, as well as other information pertinent to the instant claims.

2. Copies or descriptions of all documents, electronically stored information, and tangible things that Petitioner has in his possession, custody, or control and may be used to support its claims or defenses:

Petitioner retains business records, trademark applications and other pertinent documents which it may use to support his claim in this instant matter.

3. For inspection and copying any insurance agreement:

None.

Respectfully submitted this 19th day of October, 2010.



/Vera Chernobylsky/

Vera Chernobylsky

4623 Dunman Avenue

Woodland Hills, CA 91364

Telephone (818) 251-6783

Facsimile (818) 638-7844

Vchernob@yahoo.com

Attorney for 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 pleading was submitted, this 19 day of October, 2010, 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.

EXHIBIT 'D'

**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.	:	

PRETRIAL DISCLOSURES

COMES NOW the Petitioner, Leonid Nahshin (hereinafter "Petitioner"), and pursuant to the scheduling order entered in this matter provides the following Pretrial initial disclosures as required by the applicable rules of the Board.

Disclosures

1. The name(s) and address(s) of each individual likely have testify as witness and to have discoverable information and along with the subject(s) of that information that may be used to support Petitioner's claims:

Leonid Nahshin
ISRAEL HAZVI 153/36
Beer-Sheva ISRAEL 84746

Leonid Nahshin (thereafter "Petitioner") retains information concerning all aspects of the instant matter including, but not limited to, his rights in the mark at issue, dates of use thereof, marketing and other stream of commerce matters, as well as other information pertinent to the instant claims. Petitioner's testimony is relevant to this case due to Petitioner's personal knowledge of the following facts:

1. Relationship in 2003 between Eugene Higgins, owner of Product Source International, and Nickolas Maslov, at that time, representative and partner of Leonid Nahshin, Petitioner, in the United States.
2. Contractual relationship between Mr. Maslov and Petitioner.
3. Petitioner's intent to protect his Intellectual Property Rights, his Trademark NIC-OUT, in the United States.
4. Petitioner's continuous use of its Trademark NIC-OUT in the United States.
5. Petitioner is the owner of the mark NIC-OUT used on or in connection with a cigarette filter holder to reduce the inhalation of tar and nicotine.
6. Petitioner first use of the mark NIC-OUT in connection with the above-identified goods in interstate commerce in United States least as early as October 1, 2000.
7. Petitioner's use of the mark NIC-OUT in connection with the above-identified services has been continuous since on or about October 1, 2000.
8. Petitioner has invested significant sums of money in the promotion of the mark NIC-OUT and the Petitioner's goods in the United States.
9. As a result of the aforesaid, Petitioner has developed a valuable reputation and goodwill in its NIC-OUT mark and has achieved a following among the relevant consuming public prior to the filing, registration and/or priority date of Defendant – Respondent, Product Source International's, LLC (hereinafter "Respondent") mark NIC OUT identified more fully in U.S. Registration No. 3,350,041.
10. Petitioner filed USPTO Trademark Application Serial Number 78206651 on January 23, 2003 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."

11. Petitioner was barred by the Respondent, to deliver and sell in United States Petitioner's product under Petitioner's Trademark NIC-OUT.
12. Petitioner's consumers confronted with the Respondent's mark NIC OUT will inevitably be confused and deceived into the mistaken belief that the Respondent's goods have their origin or are in some manner connected with the Petitioner and/or Petitioner's goods offered in connection with his NIC-OUT mark.
13. Petitioner will be seriously damaged by the continued registration of Registrant's mark NIC OUT.

Copies or descriptions of all documents, electronically stored information, and tangible things that Petitioner has in his possession, custody, or control and may be used to support its claims or defenses:

Petitioner retains business records, trademark applications and other pertinent documents which it may use to support his claim in this instant matter.

Yael Menkin:
14 Duke Pass,
Colts Neck, NJ 07722
TEL: 1-(732) 252-6393
1-(267)408-4990

Yael Menkin testimony is relevant to this case due to her personal knowledge of receipt in New York, US the first shipment of the product from Leonid Nahshin using his trademark name NIC-OUT in year 2000 and knowledge that this transaction was intended by the Petitioner as first introduction of his product under trademark NIC-OUT in United States. Written testimony of Yael Menkin is intended to show date of priority of the use in United States Petitioner's

Trademark name "NIC-OUT". Further Yael Menkin personally filed Trademark Application in USPTO for NIC-OUT on behalf of Petitioner on January 23, 2003.

Copies or descriptions of all documents, electronically stored information, and tangible things that Yael Menkin has in her possession, custody, or control and may be used to support its claims or defenses:

Yael Menkin retains business records, trademark applications and other pertinent documents which it may use to support this claim in this instant matter.

Alexander Slobidker
59 Haven Rd
Maple, ON L6A0W8
Canada
TEL: (1)-647-702-7418

Alexander Slobidker is manager of the Petitioner's Company P. Service and has a personal knowledge NIC-OUT product sales, promotions, advertizing and contacts. Alexander Slobidker's testimony is relevant to this case due to Alexander Slobidker's position as the manager of the Petitioner's company "P. Service", solely engaged in business of selling, promoting and advertising Petitioner's Trademark NIC-OUT.

Alexander Slobidker as the manager has personal knowledge of the following facts:

1. All sale transactions, advertising, promotions, marketing and business relations of the Petitioner's Trademark NIC-OUT since year 2000.
2. First shipment being forwarded to Yael Menkin in year 2000.
3. Registration of the domain nic-out.com and website www.nic-out.com.

4. Direct sales of "NIC-OUT" in the United States.
5. All articles on the website were written by Petitioner.
6. Sending of the Shipments in early April 2002, as major industrial cargo of "NIC-OUT" to United States for "Safety Aid Supplies, Inc."
7. Major shipment sent to United States in September 2002.
8. In October 2002, "Safety Aid Supplies Inc." ordered its barcode for packs made by Petitioner's company for the United States.
9. Agreement with Mr. Maslov, owner of "Safety Aid Supplies, Inc".
10. Petitioner first use of the mark NIC-OUT in connection with the above-identified goods in interstate commerce at least as early as October 1, 2000.
11. Petitioner's use of the mark NIC-OUT in connection with the above-identified services has been continuous since on or about October 1, 2000.
12. Petitioner has invested significant sums of money in the promotion of the mark NIC-OUT and the Petitioner's goods in the United States.
13. Petitioner was barred by the Defendant – Respondent, Product Source International, LLC (hereinafter "Respondent") to deliver and sell in United States Petitioner's product under Petitioner's Trademark NIC-OUT.
14. Petitioner has developed a valuable reputation and goodwill in its NIC-OUT mark and has achieved a following among the relevant consuming public prior to the filing, registration and/or priority date of Registrant's mark NIC OUT identified more fully in U.S. Registration No. 3,350,041.
15. Petitioner's consumers confronted with the Respondent's mark NIC OUT will inevitably be confused and deceived into the mistaken belief that the Respondent's goods

have their origin or are in some manner connected with the Petitioner and/or Petitioner's goods offered in connection with his NIC-OUT mark.

Copies or descriptions of all documents, electronically stored information, and tangible things that Alexander Slobidker has in his possession, custody, or control and may be used to support its claims or defenses:

Alexander Slobidker retains business records, trademark applications and other pertinent documents which it may use to support this claim in this instant matter.

3. For inspection and copying any insurance agreement:

None.

Respectfully submitted this 9th day of February, 2011.



/Vera Chernobylsky/
Vera Chernobylsky
4623 Dunman Avenue
Woodland Hills, CA 91364
Telephone (818) 251-6783
Facsimile (818) 638-7844
Vchernob@yahoo.com
Attorney for 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 pleading was submitted, this 9 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
Fax: (856) 853-2866



Vera Chernobylsky, Esq.