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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
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Submission	Motion to Strike
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Attachments	TO BE FILED.pdf (7 pages)(302769 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.

RESPONDENT'S MOTION TO STRIKE
PORTIONS OF PETITIONER'S NOTICES OF RELIANCE

Pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP") sections 532 and 707, defendant-respondent Product Source International, LLC ("PSI") hereby moves to strike certain portions of the Notices of Reliance filed by plaintiff-petitioner Leonid Nahshin ("Nahshin").

Because Nahshin seeks to submit purported evidence by Notice of Reliance that is not procedurally admissible by Notice of Reliance, and for the reasons set forth below, PSI respectfully requests that the Board strike the following portions of, and exhibits to, Nahshin's Notice of Reliance:

Notice of Reliance Part A (ESTTA387754) – Exhibits "E" and "F" and text of Notice referring thereto;

Notice of Reliance Part B (filed under seal) – Exhibit "D" and text of Notice referring thereto; and

Notice of Reliance Part D (ESTTA387760).

I. FACTUAL AND PROCEDURAL BACKGROUND

Plaintiff-Petitioner, Leonid Nahshin, initiated the instant cancellation proceeding against the registrant, Defendant-Respondent PSI, on or about June 23, 2009.

On January 11, 2011, Nahshin filed a four-part Notice of Reliance (labeled "Part A" through "Part D," respectively) (referred to collectively herein as the "Notice of Reliance").

Part A of the Notice of Reliance seeks to make of record in this proceeding the parties' responses to interrogatories and requests for production of documents which were pursuant to Federal Rules of Civil Procedure 33 and 34, respectively, along with – in Exhibits "E" and "F" – numerous documents produced by Nahshin.

In Part B of the Notice of Reliance, Nahshin seeks to make of record certain confidential responses to interrogatories and requests for production of documents made by PSI, along with – in Exhibit "D" – confidential documents produced by PSI. Part B was filed under seal.

In Part C of the Notice of Reliance, Nahshin seeks to make of record a since-abandoned trademark application he allegedly filed in 2003.

In Part D of the Notice of Reliance, Nahshin seeks to make of record the testimony he intends to introduce at trial, including Nahshin's summaries of the proposed testimony. One of the witnesses listed in Part D was Yael Menkin, whose testimony was later stricken by this Board as explained below.

On January 11, 2011, Petitioner filed a Notice with the Board for the taking of two depositions upon written questions. As a result, on February 2, 2011, the Board suspended

proceedings pursuant to Trademark Rule 2.124 for the completion of the depositions upon written questions.

Shortly after the Notice of Reliance was filed, counsel for Nahshin advised counsel for PSI that Petitioner intended to take the deposition of Yael Menkin, February 10, 2011. After the "deposition" turned out to not be a deposition at all, PSI moved to strike Ms. Yenkin's testimony on March 16, 2011. As the Order noted, Nahshin's testimony period had closed before PSI's motion to strike was granted. (8/22/2011 Order, at 7.)

A motion to resume proceedings was filed by Petitioner on February 23, 2011, docket number 28. This Motion to Resume was denied on May 2, 2011.

On June 17, 2011, the Petitioner's filing of June 15, 2011 was noted. The proceedings were suspended pending disposition of the Defendant's Motion to Strike.

On August 22, 2011, Respondent's Motion to Strike the Testimony of Yael Menkin was granted. The proceedings were then resumed.

II. ARGUMENT

Pursuant to TBMP § 532, PSI hereby moves to strike evidence in several portions of Nahshin's Notice of Reliance which is not procedurally admissible through a notice of reliance. PSI's objections to the Notice of Reliance on substantive grounds will be addressed in PSI's trial brief.

A. Documents Attached to Parts A and B of Nahshin's Notice of Reliance Are Neither Printed Publications nor Official Records, and Must Be Stricken

Exhibit "E" to Nahshin's Notice of Reliance – Part A contains more than 30 pages of documents produced by PSI in response to Nahshin's requests for production of documents. Exhibit "D" to Nahshin's Notice of Reliance – Part B, which was filed under seal, contains

approximately 10 pages of documents produced by PSI in response to Nahshin's requests for production of documents.

As a general rule, documents obtained by a party through discovery pursuant Federal Rule of Civil Procedure 34 may not be made of record. *See* TBMP § 704.11 (citing 37 C.F.R. § 2.120(j)(3)(ii) ("A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of relaince alone . . ."). A limited exception exists under 37 C.F.R. § 2.122(e). As explained below, the general rule applies in the instant dispute, and portions of Parts A and B of Nahshin's Notice of Reliance must be stricken.

Trademark Rule 2.122(e) provides as follows:

> Printed publications, such as books and periodicals, *available to the general public* in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and *official* records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered.

37 C.F.R. § 2.122(e) (emphasis added).

First, the documents attached to Parts A and B of the Notice of Reliance are not printed publications. They are not available to the general public, nor are they circulated among members of the public. *See* TBMP § 704.11 (citing "books and periodicals" as representative examples of "printed publications"); *Osage Oil & Transp., Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.5 (TTAB 1985) (excluding non-public documents attached to notice of reliance).

Second, the above-mentioned documents are not official records. "The term 'official records,' as used in Rule 2.122(e), refers not to private business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer."

Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230, 1231 (TTAB 1992). In contrast, the documents attached to Parts A and B of Nahshin's Notice of Reliance are business records of the parties, including but not limited to numerous invoices.

Because Exhibits "D" and "E" to Parts A and B of Nahshin's Notice of Reliance consist of documents which have been produced in accordance with Fed. R. Civ. P. 34 and which do not satisfy one of the exceptions in Rule 2.22(e), Petitioner's exhibits must be stricken.

B. Nahshin's Own Answers to Interrogatories (Exhibits E and F) may not be Made of Record through a Notice of Reliance

In addition to the improperly included documents, Exhibit "E" to Petitioner's Notice of Reliance contains Nahshin's answers to PSI's first set of interrogatories. Similarly, Exhibit "F" contains Nahshin's answers to PSI's second set of interrogatories. This is procedurally improper.

Under TBMP § 704.10, an answer to an interrogatory "may be submitted and made part of the record *by only the inquiring party*." TBMP § 704.10 (citing 37 C.F.R. § 2.120(j)(5)) (emphasis added). With respect to the answers to interrogatories attached to the Notice of Reliance as Exhibits E and F, Nahshin clearly was not the inquiring party. The inquiring party was PSI and the answering party was Nahshin. Therefore, Nahshin's answers may not be made of record through a notice of reliance, and Petitioner's Exhibits E and F must be stricken.

C. Part D of Nahshin's Notice of Reliance also is Procedurally Improper

Part D of the Notice of Reliance purports to identify four witnesses which Petitioner intends to rely upon at trial: Leonid Nahshin, Yael Menkin, Alexander Slobidker, and Nicholas Maslov. Such an identification is not the proper subject of a notice of reliance.

TBMP § 704 lists the types of evidence that may be submitted by notice of reliance, as follows: applications and registrations (TBMP § 704.03); statements and things in an application

or registration (§ 704.04); official records (§ 704.07); printed publications (§ 704.08); discovery depositions (§ 704.09); and the adverse party's interrogatory answers and admissions (§ 704.10). Nowhere in the Trademark Rules and Procedures is there a mechanism for a party to notice its intent to take certain witnesses' trial testimony through a notice of reliance. For the foregoing reasons, Part D of Petitioner's Notice of Reliance must be stricken as well.

III. CONCLUSION

Pursuant to TBMP §§ 532 and 707, Parts "A," "B," and "D" of Petitioner's Notice of Reliance contain improper subject matter for a notice of reliance. Therefore, Respondent PSI respectfully requests that those portions of Petitioner's Notice of Reliance relating to and/or containing Nahshin's answers to interrogatories, documents produced in discovery by PSI, and Nahshin's notice of intent to take certain witnesses' testimony be stricken.

Respectfully submitted,

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Dated: October 17, 2011

CERTIFICATE OF SERVICE

I, Anthony J. DiMarino III, Esquire, counsel to Defendant-Respondent Product Source International, LLC, hereby certify that a true and complete copy of the foregoing Defendant-Respondent, Product Source International's, Motion to Strike Testimony Portions of Petitioner's Notices of Reliance, has been served on the below-named counsel for Plaintiff-Petitioner, Leonid Nahshin, on this 17th day of October, 2011, via facsimile, electronic mail and overnight mail via UPS:

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

Anthony J. DiMarino III, Esq.