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

Proceeding	92054551
Party	Plaintiff Andrey Pinsky
Correspondence Address	ANDREY PINSKY PINSKY LAW 45 SHEPPARD AVE EAST SUITE 900 TORONTO, ON M2N 5W9 CANADA andrey@pinskylaw.ca
Submission	Other Motions/Papers
Filer's Name	Andrey Pinsky
Filer's e-mail	andrey@pinskylaw.ca
Signature	/Andrey Pinsky/
Date	12/05/2011
Attachments	Request for Revised Order.pdf (4 pages)(52960 bytes)

December 5, 2011

FILED BY ESTTA

Elizabeth A. Dunn, Attorney
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
U.S.A.

Dear Ms. Dunn:

Re: Cancellation No. 92054551
Parties: Andrey Pinsky v. Douglas Burda
Trademark: KONCEPT
Registration No. 3981394
Date of First Use: June 12, 2010
Registration Date: June 21, 2011

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1. I am in receipt of your Order dated December 1, 2011, following the discovery conference that took place on November 29, 2011. During the conference you advised that you would accept my submission only in writing. I do as you advised.
 2. It is my submission that the section of your Order dealing with communications between the parties places me in a clear disadvantage and jeopardises my ability to maintain a complete written record of communications between the parties and the Board. It is also my submission that the section of your Order dealing with communications between the parties places me in a clear disadvantage in respect of cost and speed of communications between Respondent and me. It is further my submission that the section of your Order dealing with communications between the parties jeopardises my ability to litigate my cancellation in a timely, and cost effective manner, if at all.
 3. I am not clear why your Order did not address my concerns in respect of communication with Respondent, which I clearly expressed during the discovery conference. Since your Order did not address my concerns, I am taking this opportunity to put my concerns in writing in hope that you will address them in a revised Order.
 4. I advised you during the discovery conference that my initial attempt to serve Respondent with my Petition to Cancel was met with his extreme resistance. The USPTO file for the trademark KONCEPT listed Respondent's address as a PO Box and provided a Gmail email address. Respondent's website provided no physical address of his law office and his law

firm's fax number. I also advised you that because FedEx does not deliver to PO Box addresses, I could not serve my Petition to Cancel on Respondent. I requested Respondent to provide physical address of his law office, but instead of providing the information I requested, Respondent repeatedly demanded that I place a call to him and negotiate. I further advised you that Respondent provided physical address of his law office only when I informed him that I would be seeking assistance of the Nevada Bar to obtain the location of his law office and to serve him with my Petition. My request to consent to service of my Petition by email received no reply from Respondent. Moreover, I advised you that all this information is well documented by my correspondence with Respondent and could be independently verified by reviewing the USPTO file for the trademark KONCEPT.

5. I submit that the information in paragraph 4 is relevant to your decision what mode of communication the parties have to adopt in this proceeding. If you wish to receive evidence in support of submissions made in paragraph 4, I am happy to provide it.
6. For the reasons outlined below, I am asking you to reconsider your Order as far as it deals with communications between the parties and to direct the parties to communicate on a day-to-day basis via fax and to serve important documents and pleadings via overnight couriers with next day delivery.

Fax Communication Between the Parties

7. My goal from the commencement of this proceeding was to have a complete written record of communications between Respondent and me as well as between the Board and me. Having a complete written record is vital to resolution of the issues brought by my cancellation on their merits. My request for fax communications between the parties was and is particularly important given the significance to me of the matters brought by this proceeding and the cost associated with this proceeding. For the above reasons, I insisted on communication with Respondent via fax from the start. Notably, Respondent refused to communicate via fax claiming that he did not utilize fax in his practice. The Respondent insisted on communication by phone and email - the methods which both do not provide a reliable record of communications. I submit that the Respondent's argument that he does not utilize fax in his practice is capricious and without any merit. I also submit that the Respondent's refusal to communicate through the mode that allows both parties to maintain a complete written record of communications is contrary to the spirit of this proceeding and such refusal jeopardises my legal position in this proceeding.
8. Firstly, fax communications provide an instant transmission and a reliable record of what and when was transmitted. Secondly, fax communications provide a confirmation of receipt of transmission. Thirdly, use of fax communications is routinely adopted by the legal industry for communications between parties involved in litigation. Therefore, my request for communication via fax is not a request for any exceptions but rather a request to adhere to the standard practice adopted by the legal industry. Fourthly, Respondent does not need to purchase any hardware or software to utilize fax communications. Irrespective of what computer operating system Respondent uses, his computer operating system comes with embedded and pre-installed fax software and hardware that enables him to transmit and receive faxes. Fifthly, it is my submission that because the parties in this proceeding are not represented by a legal counsel, and in light of the acrimony between the parties acknowledged by you in your Order, communications by any means other than fax could

derail this proceeding and sidetrack it in to disputes about issues that have nothing to do with the merits of my cancellation.

9. Lastly, the “strong preference expressed by each party for conflicting modes of electronic communication” is an irrelevant criterion for making the decision what mode of communication between the parties must be used in this proceeding. I submit that the only relevant criterion is whether or not the selected mode of communication is assisting to administration of justice in this proceeding. I submit that depriving me from using a reliable mode of communication and depriving me from ability to have a complete written record of communications with Respondent does not serve administration of justice.
10. Accordingly, it is my submission that Respondent’s refusal to communicate via fax jeopardises my legal position as it deprives me from my legal right to have a complete written record of communications between the parties and the Board. I am asking you to reconsider your Order as far as it deals with communication between the parties and to direct the parties to use fax for their day-to-day communications.

Service of Correspondence by Overnight Courier

11. Your Order is directing me to communicate with Respondent on a day-to-day basis via an overnight courier, while directing Respondent to communicate with me via United States Postal Service (USPS) First Class Mail is unfair to me and puts the me in a clear disadvantage, as far as the cost and speed of such communications is concerned, because I am located outside the USA.
12. For example, the cost of serving Respondent with my Petition to Cancel (two pages) via FedEx was \$46.08. The cost to Respondent of serving me with the First Amended Answer (ten pages) via USPS was \$1.34. The Respondent received my Petition to Cancel the day after it was sent by FedEx. I received the Respondent’s First Amended Answer on December 2, 2011, that is two weeks after it was mailed to me.
13. While I agree that the parties in this proceeding ought to serve all important documents and pleadings by overnight couriers, it is my submission that day-to-day communications ought to be carried out by fax. I submit that I ought not to be put in any financial or legal disadvantage because Respondent capriciously refuses communicate via fax on a day-to-day basis and because I am located outside the USA.
14. Further, it is unfair to order me to forward my day-to-day correspondence to Respondent by overnight courier at a premium cost to me, while allowing Respondent to reply back to me through slow and inferior mail service that provides neither a confirmation of shipment, no a confirmation of delivery. I submit that it is unfair to require me to spend \$46.00 per each and every communication and then wait two weeks to receive a reply from the Respondent at cost of \$1.00 to him. There may be dozens if not hundreds communications between the parties in this proceeding and it is not reasonable to order me to pay \$46.00 for each communication. The last but not the least, your order for Respondent to communicate with me via USPS jeopardises not only my ability to receive correspondence from Respondent in a timely manner, but it also jeopardizes my ability to provide a timely reply to Respondent and to meet deadlines established by the Board given that it takes two weeks for USPS First Class Mail to arrive to me.

15. For the above reasons, I am again asking you to reconsider your Order as far as it deals with communications between the parties and to direct the parties to use fax for their day-to-day communications while serving important documents and pleadings via overnight couriers with next day delivery.

Oral Communications Between Parties

16. As I indicated above, I have a strong preference for written communications in this proceeding. I submit that your Order directing me to communicate with Respondent via phone jeopardises my legal position in this proceeding for the following reasons. Firstly, there is nothing the parties need to discuss orally that could not be put in writing to keep a complete written record. Even offers to settle have to be submitted in writing to be considered and accepted. Secondly, this cancellation is not going to be decided by the Board on basis of any telephone discussions. This cancellation will be decided on basis of written evidence produced by the parties. Thirdly, given the acrimony between the parties acknowledged in your Order, oral communications could derail this proceeding and sidetrack it in to disputes about issues that have nothing to do with the merits of my cancellation. Fourthly, since I am not represented by a legal counsel in this proceeding, I do not wish my oral communications be used against me and against my legal position in this proceeding. I therefore insist on being allowed to communicate with Respondent and receive his replies only in writing.

17. For the above reasons, I am again asking you to reconsider your Order as far as it deals with communications between the parties and to direct the parties to use fax for their day-to-day communications while serving important documents and pleadings via overnight couriers with next day delivery.

Discussion of Settlement

18. At no pint during settlement discussion did I make any statements that the Respondent “was unethical in defending his registration”. The Respondent is entitled to defend his registration and is free to put anything he perceives as a reasonable defence in his Answer to my Petition to Cancel. However during the discovery conference I asserted my superior rights in the trademark CONCEPT LAW.

19. Also, the discussion of settlement of this proceeding did not “end when petitioner treated respondent’s overtures as admissions that respondent would be unable to maintain the registration”. The discussion of the settlement ended when I advised Respondent that in order to consider his offer to settle, his offer to settle has to be reduced to writing, and I asked Respondent to do so. Respondent refused to reduce his offer to settle to writing at which point the discussion of the settlement ended.

Absence from the Office

20. I am advising the Board and Respondent that I will be out my office between December 17, 2011, and January 3, 2012.

Yours truly,

Andrey Pinsky