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

Proceeding	92054551
Party	Defendant Douglas Burda
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Attachments	Opposition to Petitioner's Request for Revised Order. filed.pdf (8 pages)(78380 bytes)

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

ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**REGISTRANT'S OPPOSITION TO
PETITIONER'S RESPONSE TO BOARD ORDER/INQUIRY**

Respondent, Douglas Burda (Registrant) hereby requests that the Trademark Trial and Appeal Board (Board) deny Petitioner's Response to Board Order/Inquiry, filed with the Board by Petitioner in the above-referenced proceeding on December 5, 2011.

REGISTRANT'S OPPOSITION TO PETITIONER'S RESPONSE TO BOARD ORDER/INQUIRY (Opposition) is supported by Registrant's BRIEF IN SUPPORT OF OPPOSITION, below, the papers on file with the Board in this matter, and any other matters properly before the Board.

BRIEF IN SUPPORT OF OPPOSITION

I. BACKGROUND.

On November 29, 2011 the Board participated in the discovery conference between Petitioner and Registrant. On December 1, 2011 the Board issued its Discovery Conference Summary (Summary), in which the Board ordered, *inter alia*, that "[b]ased on the strong preference expressed by each party for conflicting modes of

electronic communication¹, as well as the acrimony displayed by the parties, the parties may only utilize facsimile or email service if they file a signed stipulation agreeing to such service with the Board.” See Summary at 3-4 [footnote added by Registrant]. The Board solidified the impact of this ruling, ordering that “the parties may not avail themselves of electronic means of service of disclosures, discovery, or trial evidence absent a signed stipulation filed with the Board.” *Id.* at 8.

On December 5, 2011, Petitioner filed its Response to Board Order/Inquiry, comprised of Petitioner’s Request for Revised Order.pdf (the Request) which indicated that Petitioner took exception to the Board’s rulings, and then filed its 2011-12-7 Letter to Elizabeth A. Dunn on December 7, 2011.pdf, which indicated that Petitioner had not received the Board’s reply to Petitioner’s Request, and that Petitioner forwarded a copy of the Request to the Board via fax (the Subsequent Request) (collectively, the Requests). Registrant then filed this paper in opposition to the Requests.

II. LEGAL STANDARDS.

While a party may request review of an order issued by the Board under certain circumstances, It is also clear that the underlying premise of a party’s request for review of an order or decision of the Board which concerns matters other than the central issue or issues before the Board must not be for an improper purpose such as the introduction of evidence or argument of points previously raised. TBMP § 518.

Likewise, the Board has established that “[s]trict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board,” see Summary at 2.

¹ Registrant expressed a preference for email or paper communication while Petitioner insisted only upon facsimile communication.

III. ARGUMENT.

A. Petitioner's Requests Should Be Denied because The Nature of Petitioner's Request is Unclear.

In addition to the issues with Petitioner's Requests (developed more fully herein), Registrant notes that the nature and purpose of Petitioner's Request is ambiguous and that Petitioner's Request is subject to denial on such basis alone. However, as a matter of procedural propriety regarding a response before the Board, Registrant has been forced to treat the Petitioner's Request as a Request for Reconsideration and respond thereto so as to maintain Registrant's rights, despite that Registrant believes that a response may be unnecessary due to the facts and circumstances surrounding Petitioner's actions.

To the extent that Registrant's present treatment of the Requests is warranted, the following arguments are applicable thereto. To the extent Registrant's present treatment of the Requests is not warranted or unnecessary (whether due to misclassification as a request for reconsideration, or based on lack of necessity of request, or otherwise), Registrant would respectfully reserve Registrant's rights to supplement and/or withdraw all or part of Registrant's Opposition based upon treatment of the Requests by the Board.

B. Petitioner's Requests Should Be Denied because The Board's Order was Proper and Based on the Applicable Rules of Practice Regarding Service and Communication.

It is clear that Petitioner takes issue with portions of the Board's Order addressing communication between the parties and service of papers by the parties.

Petitioner's unnecessarily lengthy Request, however, may be distilled into a single, unmeritorious argument: that Petitioner would require all communication to and from the Board and Registrant to occur exclusively by fax. Such a requirement is at odds with the clear impact and intent of the rules addressing this point. Furthermore, and perhaps most significantly, the Board's Order was accurate and proper in all regards to which Petitioner apparently takes exception. Any potential disadvantage, jeopardy or prejudice expressed or implied by Petitioner is wholly unsubstantiated and illusory at best.

1. *The Board's Order Addressed Only Non-Dispositive Matters and Reiterated Well-Established Trademark Rules that Apply Even Without the Board's Order.*

Petitioner's Request is misdirected as the Board's Order merely refers to the standard rules of practice applicable in any cancellation proceeding before this Board--there is nothing new therein and the Board is clearly not *sua sponte* creating new rules of practice applicable only to Petitioner, despite the picture that Petitioner has tried to paint.

The Board articulated the applicable rule(s) at multiple times throughout the Board's communications with the parties, namely, that the parties may stipulate to service by e-mail or fax, but in the absence of such stipulation, filings must be made pursuant to the applicable rules of practice which do not mandate service by fax. Indeed, as early as the day Petitioner filed this action, the Board established that "if they agree to, the parties may utilize electronic means, e.g., e-mail or fax, during the proceeding for forwarding of service copies." See Notice of Petition for Cancellation at

2. Moreover, the Board recently reiterated this point: “the parties may only utilize facsimile or email service only if they file a signed stipulation agreeing to such service with the Board.” See Summary at 3-4. These rules would be applicable to the parties regardless of the Board’s Order. The Board merely reiterated the impact of these rules from a procedural perspective, and delineated how such rules would specifically apply in matters before the Board in general.

Thus, because the Board’s Order addressed only non-dispositive matters relating to rules of practice that are applicable to the parties even in the absence of the Board’s Order, Petitioner’s Request should be denied.

***2. The Rules to which Petitioner Takes Exception are Axiomatically
Applicable to Any Party, Canadian or Otherwise, who Files a
Cancellation Proceeding Before the Board.***

It is unclear why Petitioner should be afforded special treatment by the Board through waiver of the applicable rules based solely upon his unilateral preference for fax communication and/or status as a Canadian. It is also unclear why the applicable rules of practice will not address Petitioner’s concerns for maintaining a full record when one of the very aims of the applicable rules is to maintain a full record in the face of the multitude of means of communication that the parties would otherwise have at their disposal for such purposes.

Petitioner’s inapposite contentions to the contrary are unavailing in the face of universal and unwavering applicability of the rules to all parties before the Board regardless of a party’s personal preference or opinion. The Board’s interpretation of the rules in this respect are spot-on: all parties, including *pro se* parties are expected to

undertake “[s]trict compliance with the Trademark Rules of Practice.” See Summary at 2. This remains true regardless of geographic location, nationality, or other characteristic of a party before the Board.

As such, because Petitioner’s Request flies in the face of the well-established norms of practice before the Board, including that the rules are equally applicable to any party before the Board, these circumstances weigh in favor of denying Petitioner’s Request.

C. Petitioner’s Requests Should Be Denied as Improper.

Petitioner’s baseless conclusions as to why established norms of practice before the Board should be disregarded in this case are unrelated to the only available purpose of Petitioner’s Requests as delineated by the rules, namely that:

the premise underlying a motion for reconsideration, modification or clarification under 37 CFR § 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. Rather, the motion should be limited to a demonstration that based on the facts before it and the applicable law; the Board's ruling is in error and requires appropriate change.

TBMP § 518.

Even a mere cursory inspection of Petitioner’s Request reveals that the Request is little more than Petitioner’s “gripe session” combined with an attempt to improperly introduce evidence and reargue points that Petitioner raised to the Board during the discovery conference, which were addressed by the Board then, and again in the Board’s Order. Notably, Petitioner does not even attempt to demonstrate that “based

on the facts before it and the applicable law; the Board's ruling is in error and requires appropriate change.” *Id.*

As such, because Petitioner’s Request is in clear contravention of the applicable rules of practice regarding the acceptable premise of a request for reconsideration articulated above, this circumstance also weighs in favor of denial of Petitioner’s Request.

IV. CONCLUSION.

For all of the forgoing reasons, Registrant respectfully requests that the Board deny Petitioner’s Requests and take further action as the Board determines is necessary.

Registrant respectfully reserves the right to file additional papers with the Board regarding Petitioner’s action(s) and/or representations related to Petitioner’s Requests.

December 22, 2011

Respectfully submitted,



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CERTIFICATE OF ELECTRONIC FILING

I certify that a true and complete copy of the foregoing REGISTRANT'S OPPOSITION TO PETITIONER'S RESPONSE TO BOARD ORDER/INQUIRY is being electronically transmitted to the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office on December 22, 2011.

By: 
Douglas Burda

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S OPPOSITION TO PETITIONER'S RESPONSE TO BOARD ORDER/INQUIRY has been served on Andrey Pinsky by mailing said copy on December 22, 2011 via First Class Mail International, postage prepaid to:

ANDREY PINSKY
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TORONTO, ON M2N 5W9
CANADA

By: 
Douglas Burda