

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

DUNN

Mailed: January 5, 2012

Cancellation No. 92054551

Andrey Pinsky

v.

Douglas Burda

**Elizabeth A. Dunn, Attorney (571-272-4267):**

This case comes up on respondent's December 7, 2011 motion to amend its answer, which is not contested; petitioner's December 5, 2011 request for reconsideration of the Board's December 1, 2011 order, which is contested; and several additional filings by petitioner.

MOTION TO AMEND ANSWER IS GRANTED

On December 7, 2011, in response to the Board having sua sponte stricken his affirmative defense that petitioner lacked standing to practice before the Board, respondent filed a motion to file a second amended answer with the affirmative defense that petitioner lacks standing because he does not use

the mark in commerce.<sup>1</sup> Petitioner filed no opposition to the motion. Respondent's motion to amend the answer is granted, and the second amended answer which accompanied the motion is accepted as the operative pleading.

REQUEST FOR RECONSIDERATION IS DENIED

A motion for reconsideration, modification or clarification is filed when, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Trademark Trial and Appeal Board Manual of Procedure (TBMP) §518 (3rd ed. 2011). 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. *Id.*

Here, petitioner requests reconsideration of the Board's December 1, 2011 order with respect to (i) the Board's requirement that a phone number be listed on all papers filed with the Board and that phone calls be promptly returned, and (ii) the Board's requirement that petitioner employ one the means of service listed in Trademark Rule 2.119, so that petitioner may not serve respondent by facsimile without respondent's express agreement.

---

<sup>1</sup> Respondent's continued reference to petitioner's "standing to practice" rather than standing to bring his claims is not fatal when the affirmative defense is viewed as a whole. As stated in the prior order, a party does not need "standing to practice" before the Board.

Petitioner cites to no legal authority in support of reconsideration, but argues that the Board's order "did not address my concerns" regarding petitioner's wish to maintain a written record of communications and to use a means of service not allowed under the rules, namely facsimile without respondent's consent. Respondent opposes reconsideration as an impermissible re-argument of the points already discussed in the Board's conference with the parties.

With respect to the requirement regarding phone calls, listing a phone number for filer is a customary practice intended to make communication with the parties easier for the Board. Trademark Trial and Appeal Board Manual of Procedure (TBMP) §106.02 (3rd ed. 2011).<sup>2</sup> Returning telephone calls is a customary business practice as well as a matter of courtesy. However, based on petitioner's plain statement that he would not do so, the Board ordered the parties to return promptly any phone calls regarding this case and made clear that the failure to do so could be the subject of a motion for sanctions.

---

<sup>2</sup> TBMP §106.02 (3<sup>rd</sup> ed. 2011) provides "A document filed in a proceeding before the Board should include the name, in typed or printed form, of the person who signed; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; or as the filing party's attorney); and his or her business address and telephone number."

Petitioner's argument that the requirement to return phone calls precludes a written record of all communication between the parties assumes that such a record is necessary or desirable. It is neither. The phone allows the parties to reach quick agreement on uncontested matters, and this is a savings to both the parties and the Board with no effect on the presentation of evidence of the pleaded claims and defenses.<sup>3</sup> If the call does not result in agreement, the parties then may move the Board to settle the dispute.<sup>4</sup> Accordingly, the Board finds no error in its earlier order with respect to the requirement that the parties list a phone number and respond to messages, as set forth in the earlier order, and the request for reconsideration is denied. The requirement remains in effect.

There also was no error in the Board's requirement for compliance with Trademark Rule 2.119. The Board's rule requiring service sets out several acceptable methods of service. There is no requirement for the parties to use the

---

<sup>3</sup> For example, the amendment of the answer to include an affirmative defense was discussed during the conference, and respondent called petitioner to seek his consent to the motion to amend the answer. If petitioner had consented, the Board could act upon the amendment immediately. Because petitioner did not consent, the motion had to be docketed to account for time for petitioner to respond to the motion and for any response to be processed by the post office, the USPTO mail room, and the Board's scanners.

<sup>4</sup> Any statement by a party to a Board proceeding that phone calls would be futile because the party under no circumstance will agree by phone to anything proposed by the other party - such as scheduling a deposition date or confirming that a document arrived - is unreasonable on its face.

same method of service. In fact, the methods employing the U.S. Postal Service are not available to parties located outside the U.S. Contrary to petitioner's argument, there is no rule or practice that the costs of complying with the Board's service rules (or any Board rules) are equal for both sides. The cost for petitioner of complying with the Board's rules was foreseeable, and should have been assessed by petitioner before bringing his claims to the Board.<sup>5</sup> Accordingly, the request for reconsideration is denied. The requirement for compliance with Trademark Rule 2.119, and the additional requirement that any agreement to use electronic means of service must be the subject of a signed stipulation filed with the Board, remains in effect.

#### PETITIONER'S OTHER FILINGS

While the request for reconsideration of the service requirement was pending, the Board considered all papers filed by petitioner, including those which lacked proof of service, and the papers are addressed below. However, now that reconsideration is denied, no consideration will be given to any paper filed with the Board which lacks proof of service. The Trademark Trial and Appeal Board Manual of Procedure is

---

<sup>5</sup> In this case, respondent offered to agree to service by email, which would result in the parties using the same method of service and reduce the costs of service, but petitioner, who is located in Canada, refused.

available on the TTAB page at the USPTO website ([www.uspto.gov](http://www.uspto.gov)) and includes an example of a certificate of service which is acceptable as the necessary proof of service. The Board also notes that petitioner employs an unacceptable format for some of its papers. Trademark Rule 2.126 requires, among other things, papers to be double-spaced.

With respect to petitioner's other papers, the Board finds as follows:

*1. December 7, 2011 (TTABVUE Docket #11)*

Petitioner's account of a phone call with respondent requires no Board action but is unnecessary and enlarges the Board's proceeding file for no purpose. Petitioner remains under order to return promptly all phone calls from respondent but is ordered to stop filing accounts of phone calls with the Board unless as an attachment to, or incorporated in, a motion seeking Board action.

*2. December 7, 2011 (TTABVUE Docket #12)*

Petitioner's letter notifying the Board that, since no action had been taken on the request for reconsideration filed two days earlier, petitioner was forwarding another copy by fax, also requires no Board action and unnecessarily enlarges the proceeding file. However, the Board advises that (i) no action will be taken on unconsented requests for Board action until the briefing periods set forth in

Trademark Rule 2.127 have passed, and (ii) as set forth in Trademark Rule 2.195(d)(3), facsimile is not an acceptable means for filing papers with the Board.

*3. December 30, 2011 (TTABVUE Docket #18)*

Petitioner's filing does not refer to initial disclosures, or otherwise comply with Fed. R. Civ. P. 26(a), but appears to comprise petitioner's proof of first use of his mark.<sup>6</sup> Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period. Trademark Rule 2.120(j)(8). This filing requires no Board action and, since it was not submitted in compliance with the Board's rules, is not considered evidence of record.

*December 30, 2011 (TTABVUE Docket #19)*

Petitioner's filing is a copy of his request for documents from respondent. As set forth above, discovery

---

<sup>6</sup> During the conference, the parties agreed to expand the initial disclosures required by Fed. R. Civ. P. 26(a) to include proof of the first date of use of their mark in commerce.

requests should not be filed with Board, except in circumstances not applicable here, the filing requires no Board action, and is not considered evidence of record.

*January 4, 2012 (TTABVUE Docket #22)*

Petitioner's motion to compel initial disclosures is denied as premature and not in compliance with the Board's rules. The initial disclosures were due January 1, 2012. Because that date fell on a Sunday and was followed by a federal holiday, the due date was January 3, 2012. See Trademark Rule 2.196. Non-receipt on the day after the due date does not demonstrate respondent's failure to serve but may indicate that the initial disclosures were served by mail which has not yet been delivered.

Petitioner's failure to demonstrate a good faith effort to resolve this matter with respondent before filing his motion to compel is an independent basis for denial of the motion. Trademark Rule 2.120(e)(1) ("A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a written statement from the moving party that such party or the attorney therefore has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefore the issues presented in the motion but the parties were unable to resolve their differences."); Kairos Institute of

Cancellation No. 9254551

Sound Healing, LLC v. Doolittle Gardens, LLC, 88 USPQ2d 1541, 1543 (TTAB 2008).

As the parties were previously advised, strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

DATES REMAIN THE SAME

The schedule set forth in the Board's September 23, 2011 institution and trial order remains in effect.