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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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Submission	Motion for Default Judgment
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**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 MOTION FOR DEFAULT JUDGMENT

Respondent, Douglas Burda (Registrant) hereby moves the Trademark Trial and Appeal Board (the Board) for entry of default judgment in favor of Registrant and against Andrey Pinsky (Petitioner) for Petitioner’s willful contravention of the: (a) rules of practice applicable to Petitioner, and (b) Board’s various Orders in this matter.

REGISTRANT’S MOTION FOR DEFAULT JUDGMENT (Motion) is supported by Registrant’s BRIEF IN SUPPORT OF MOTION, 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.

1. On September 23, 2011, the Board issued its Notice of Petition for Cancellation in this matter, specifying the rules applicable to this matter.
2. On November 1, 2011, and then again on November 22, 2011, Petitioner filed with the Board requests for Board participation in the discovery conference in this matter stating in each case that Petitioner sent a “Copy to the Registrant via

email dbb@konceptlaw.com" of each such request. Registrant did not receive such email correspondences and Petitioner denied Registrant's request for proof of same.

3. On December 1, 2011, the Board issued its Discovery Conference Summary specifying, *inter alia*, that anything less than strict compliance by the parties with the applicable rules would not be tolerated by the Board.
4. On December 5, 2011, Petitioner filed with the Board its alleged Request for Reconsideration of the Discovery Conference Summary.
5. On December 7, 2011, Petitioner filed with the Board its Summary of Telephone Conference.
6. On December 7, 2011, Petitioner filed with the Board a reminder of its alleged Request for Reconsideration and filed same with the Board via facsimile.
7. On December 15, 2011, prior to any action on Petitioner's previous filings, Petitioner filed with the Board its Request to Remove the Board Attorney (that Request is now shielded from public view), and filed same with the Board via facsimile.
8. On December 30, 2011, despite stating previously that Petitioner would be out of its office during such time, Petitioner filed with the Board its Declaration of Andrey Pinsky, erroneously listed on TTABVue as "PL INITIAL DISCLOSURES".
9. On December 30, 2011, despite stating previously that Petitioner would be out of its office during such time, Petitioner filed with the Board its Discovery Request.

10. On December 31, 2011, despite stating previously that Petitioner would be out of its office during such time, Petitioner filed with the Board its Letter to the Director (now shielded from public view).
11. On or about January 3, 2012, Registrant contacted Petitioner by telephone in a good faith effort to resolve with Petitioner the issues of Petitioner's failure to serve initial disclosures and the impropriety of Petitioner's discovery requests in the absence of such disclosures. Specifically, Registrant stated that Registrant was not obligated to respond to Petitioner's discovery requests in the absence of Petitioner's initial disclosures and that such initial disclosures must be adequate under the rules. The meet-and-confer ended when Petitioner hung up the phone on Registrant and subsequently would not return Registrant's voice message regarding same. Thus, the parties were unable to resolve their differences.
12. On January 4, 2012, Petitioner filed with the Board its Motion to Compel Discovery.
13. On January 4, 2012, the Board issued an Order (now shielded from public view) (the Shielded Order).
14. On January 5, 2012, the Board issued an Order (the January 5 Order) denying Petitioner's December 5, 2011 Request for Reconsideration, denying Petitioner's January 4, 2012 Motion to Compel Discovery, and again specifying that anything less than strict compliance by the parties with the applicable rules would not be tolerated by the Board.

15. On January 25, 2012, Petitioner filed with the Board its Response to Board Order/Inquiry, again seeking removal of the Board Attorney assigned to the case, and reinserting into the case file the majority of papers previously shielded from public view by the Board.

16. On February 13, 2012, Petitioner filed with the Board its Discovery Request, containing the threat the threat of a motion to compel as well as the threat of a formal bar complaint against Registrant on the basis that Registrant must “provide timely replies to other lawyer’s [sic] correspondence.”

II. LEGAL STANDARDS APPLICABLE TO REGISTRANT’S MOTION.

The Board, through its orders, has repeatedly 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 Discovery Conference Summary at 2¹, Shielded Order at 1, 3², January 5 Order at 9³.

Further, if a party fails to comply with an order of the Board, “the Board may make **any appropriate order**, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure[.]” 37 CFR § 2.120(g)(1) [emphasis added]. Such orders include “rendering a default judgment against the disobedient party”. FRCP 37(b)(2)(A)(vi).

¹ “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.”

² In the interest of keeping the Shielded Order shielded from public view, the Board’s direct quotations from the Shielded Order are omitted.

³ “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.”

Additionally, the Board's power to sanction a party, including a *pro se* party, is "manifestly clear" under FRCP 11. *Central Manufacturing Inc. v. Third Millennium Technologies, Inc.*, 61 U.S.P.Q.2d (BNA) 1210 (TTAB 2001).

III. ARGUMENT.

Petitioner's actions in this matter have established that Petitioner's objective is to circumvent the rules that are axiomatically applicable to any party who participates in a proceeding before the Board. Based on the discussion herein, it appears unlikely that Petitioner will comply with any applicable rules or the Board's Orders and it is clear that Petitioner has no intention of complying with same. Due to Petitioner's blatant and seemingly selective willful disregard for same⁴, and that Petitioner's actions in such regards have caused, and continue to cause, an unnecessarily protracted proceeding, any prejudice that Petitioner may experience from a default judgment being entered is self-inflicted, warranted and proper.

A. Petitioner has Refused to Comply with the Rules Applicable to the Parties, and the Board's Orders, regarding Service of Papers and Proof of Service.

Every paper filed in the Patent and Trademark Office in *inter partes* cases, must be served upon the other parties, 37 CFR § 2.119(a), according to the methods specified in 37 CFR § 2.119(b). Proof of such service must be made before any paper will be considered by the Patent and Trademark Office. 37 CFR § 2.119(a). The Board found, not only that such rules are strictly applicable to the parties in this matter, but

⁴ In some instances, for example, Petitioner has attempted to expressly rely on certain rules in support of its position, and in other instances, Petitioner contravenes such rules.

also that “methods employing the U.S. Postal Service are not available to [Petitioner].” See January 5 Order at 5. The Board further ruled that “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.” Nevertheless, here, Petitioner previously sought, and continues to seek, to avoid the requirements for acceptable methods of service.

Petitioner has in some instances has wholly failed to serve papers at all on Registrant in blatant violation of the rules. For example, Petitioner did not serve serve Petitioner’s: (a) Requests for Board participation in the discovery conference, (b) Request for Revised Order of December 5, 2011, (c) Summary of Telephone Conversation of December 7, 2011, (d) Letter to Ms. Dunn of December 7, 2011, (e) Letter to Judge Rogers of December 15, 2011,

In other instances, Petitioner has utilized methods of service not available to Petitioner. For example, Petitioner sent the following to Registrant via Canadian Post: (a) Motion to Compel of January 4, 2012, (b) Second Letter to Judge Rogers of January 16, 2012, (c) Threatened Motion to Compel and bar complaint of February 13, 2012 (not received at the time of this filing).

In other instances, Petitioner sought service of papers on Registrant by email despite Petitioner’s adamant opposition to same and the lack of any agreement between the parties regarding same. See Petitioner’s Requests for Board participation in the discovery conference.⁵

⁵ Petitioner clearly states “Copy to the Registrant via email dbb@konceptlaw.com”. However, Registrant never received such emails and when Registrant requested proof of same from Petitioner, Petitioner refused.

Additionally, as mentioned above, proof of such service must be made before any paper will be considered by the Patent and Trademark Office. 37 CFR § 2.119(a). Here, despite that these proof of service procedures are applicable to the parties, only one (1) of Petitioner's filings contains a certificate of service, and that certificate specifies a method of service that is unavailable to Petitioner. See Petitioner's Motion to Compel Discovery of January 4, 2012, specifying service by "mail".

Thus, because Petitioner has refused, and continues to refuse, to comply with the applicable rules and the Board's Orders regarding service of papers and proof of service in this matter, Registrant's Motion should be granted and default judgment entered against Petitioner.

B. Petitioner has Refused to Comply with the Rules Applicable to the Parties, and the Board's Orders, regarding the Substantive and Procedural Propriety of the Papers Petitioner Filed with the Board.

"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." January 5 Order at 2. Additionally, a party should not proceed with filing any paper that "requires no Board action and unnecessarily enlarges the proceeding file." *Id.* at 9.

Further, the Board has clearly specified on a number of occasions that papers not directly germane to the substance or procedure of this case should not be filed

with the Board, and specifically, that papers seeking review of a Board attorney working on the case do not fall into such categories and thus, should not be filed.

Here, Petitioner's filing of January 25, 2012, is in clear contravention of each of these rules. Through such filings, Petitioner specifically reargued points it presented previously, in some cases in papers now shielded from public view (which the Board subsequently denied). Furthermore, Petitioner reintroduced papers that Petitioner filed previously, which the Board specifically shielded from public view due to their impropriety as part of the case file in the first place, making this Petitioner's second violation, at minimum, in this respect. Each such violation has occurred following clear messages to the parties from the Board that such actions should not be taken. Thus, such filings can only be seen as outside the purview of proper filings with the Board and for no purpose other than to unnecessarily enlarge the proceeding file in contravention of the applicable rules and the Board's Orders.

Further, "[w]ritten 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." January 5 Order at 7. Here, Petitioner's filing of February 13, 2012 serves only to reintroduce a multitude of redundant discovery requests, which requests are particularly meaningless in light of the impropriety of serving discovery requests prior to making adequate initial disclosures, as discussed more fully herein. In any case, Petitioner should not have filed these papers with the Board in the first place.

Likewise, Petitioner's dual filings of December 7, 2011, and Petitioner's filings of December 30, 2011, demonstrate Petitioner's transgressions as to the applicable rules

and the Board's Orders, as they are in no way germane to substantive or procedural aspects of the matter and serve only to pointlessly enlarge and meddle with the case file, all after Petitioner was required to not do so. See Discovery Conference Summary, January 5 Order at 5-9, and previous Board Orders.

It is also clear that filing papers with the Board by facsimile is impermissible. 37 CFR § 2.195. See *also* January 5 Order at 7. Here, Petitioner has undertaken filings by facsimile throughout this matter in contravention of the applicable rules and the Board's Orders, and has attempted to expressly require that the Board and Registrant communicate with Petitioner exclusively by facsimile, even after the Board's rulings specifically establishing that this is not the case. See Petitioner's Requests for Reconsideration, Letter to the Director, Shielded Order, and January 5 Order at 2-3, 7.

Notably, the Board has established previously that actions like Petitioner's are the bases for entry of default judgment. See *Carrini, Inc. v. Carla Carini S.R.L.*, 57 USPQ2d (BNA) 1067, 1071-73 (TTAB 2000) (dismissing the proceeding on the basis that the attorneys repeatedly filed papers in violation of Board orders).

Thus, because Petitioner has refused, and continues to refuse, to comply with the applicable rules and the Board's Orders regarding the substantive and procedural propriety of papers Petitioner filed with the Board in this matter, Registrant's Motion should be granted and default judgment entered against Petitioner.

C. Petitioner Has Refused to Comply with the Rules Applicable to the Parties, and the Board's Orders, regarding Discovery Practices.

A party may not seek discovery through traditional devices until after it has made its initial disclosures. 37 CFR § 2.120(a)(3). As such, the Board has found that a

party is justified in not responding to discovery where the requesting party has not served initial disclosures or served them inadequately, and where the responding party specifically states such reasons as the basis for its refusal to respond. *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010).

Here, Petitioner sent Petitioner's discovery requests on December 29, 2011. Also on December 29, 2011, following Petitioner's discovery requests, Petitioner set forth Petitioner's Declaration of Andrey Pinsky, which did not comply with any applicable rules. The Board recognized these deficiencies,⁶ which resulted in inadequate initial disclosures. Notably, Petitioner itself does not appear to believe that its Declaration of Andrey Pinsky comprised its initial disclosures, and it is only due to the mistaken specification of Petitioner's filing as "PL INITIAL DISCLOSURES" on TTABVue that Petitioner has relied on its inadequate filing as such.

Registrant had no obligation to respond to Petitioner's Discovery Requests in the face of Petitioner's inadequate Declaration of Andrey Pinsky as such Discovery Requests were sent prior to any disclosure by Petitioner in compliance with the applicable rules regarding initial disclosures. Registrant made Petitioner aware of this situation, and instead of complying with the rules, Petitioner responded only with unfounded threats: (a) to bring a motion to compel, and (b) to bring a bar complaint against Registrant on the basis that Registrant must "provide timely replies to other lawyer's [sic] correspondence." See Petitioner's February 13, 2012 filing.

Petitioner's failure to set forth initial disclosures pursuant to the mandates of the Board's Orders, and Petitioner's improper lodging of discovery requests prior to the

⁶ The Board found that "Petitioner's filing does not refer to initial disclosures, or otherwise comply with Fed. R. Civ. P. 26(a)." See January 5 Order at 7, and Shielded Order at 1.

fulfillment of such disclosure obligations (and Petitioner's refusal to correct same) result in clear transgression of the applicable rules of practice.

Thus, because Petitioner has refused, and continues to refuse, to comply with the applicable rules and the Board's Orders regarding discovery practices in this matter, Registrant's Motion should be granted and default judgment entered against Petitioner.

D. Petitioner has Refused to Comply with the Rules Applicable to the Parties, and the Board's Orders, regarding Formatting of Filings.

"Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the Web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission." 37 CFR § 2.126. The Board has reinforced this requirement in this matter on multiple occasions. See January 5 Order at 6, Shielded Order at 1.

Despite the Board's express requirements for compliance with this rule, each and every of Petitioner's filings with the Board in this Matter, including Petitioner's filings made after the Shielded Order, are in contravention of such filing requirements in one manner or another, and in most cases, for multiple reasons.

Thus, because Petitioner has refused, and continues to refuse, to comply with the applicable rules and the Board's Orders regarding the proper formatting of papers

filed with the Board in this matter, Registrant's Motion should be granted and default judgment entered against Petitioner.

IV. CONCLUSION.

In each of the multitude of instances specified herein, Petitioner was on notice by the Board that strict compliance with each of the applicable rules was absolutely required. Petitioner knew of the applicable rules and how those rules applied to the parties in this matter via the Board's Orders, at minimum. Nevertheless, Petitioner's actions demonstrate only clear transgression of same. On this basis, Petitioner has established a pattern of willful non-compliance in contravention of the Board's authority, warranting the entry of default judgment against Petitioner.

For all of the forgoing reasons, Registrant respectfully requests that the Board issue an order entering a default judgment against Petitioner.

Registrant respectfully reserves the right to file additional papers with the Board regarding Registrant's Motion and/or Petitioner's response, if any.

February 15, 2012

Respectfully submitted,



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CERTIFICATE OF ELECTRONIC FILING

I certify that a true and complete copy of the foregoing REGISTRANT'S MOTION FOR DEFAULT JUDGMENT is being electronically transmitted to the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office on February 15, 2012.

By: 
Douglas Burda

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S MOTION FOR DEFAULT JUDGMENT has been served on Andrey Pinsky by mailing said copy on February 15, 2012 via First Class Mail International, postage prepaid to:

ANDREY PINSKY
PINSKY LAW
45 SHEPPARD AVE EAST SUITE 900
TORONTO, ON M2N 5W9
CANADA

By: 
Douglas Burda