

ESTTA Tracking number: **ESTTA457468**

Filing date: **02/20/2012**

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	Motion to Compel Discovery
Filer's Name	Andrey Pinsky
Filer's e-mail	andrey@pinskylaw.ca
Signature	/Andrey Pinsky/
Date	02/20/2012
Attachments	(Petitioner's Motion to Compel Discovery PART 2).pdf (81 pages)(2625831 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of mark Registration No. 3981394
For the mark: KONCEPT
Date of First Use: June 12, 2010
Date of Registration: June 21, 2011

ANDREY PINSKY,

Petitioner,

v.

DOUGLAS BURDA

Registrant.

Cancellation No. 92054551

Petitioner, Andrey Pinsky, files his motion to Compel Registrant to Comply with Discovery Requests and his motion to Remove Interlocutory Attorney Elizabeth A. Dunn. Petitioner's motion is divided in to three PDF files due to a number of exhibits submitted with these motions. The first PDF file has pages 1 through 80. The second PDF file has pages 81 through 160. The third PDF file has pages 161 through 212. Page numbers are marked in the top right corner of each page.

February 20, 2012

Respectfully submitted



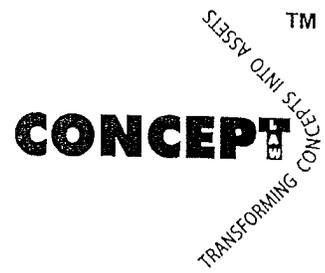
Andrey Pinsky
Pinsky Law
Suite 900
45 Sheppard Avenue East
Toronto, Ontario, M2N 5X7
CANADA
Phone: (416) 221-2600
Fax: (416) 221-2640
andrey@pinskyllaw.ca

AFFIDAVIT OF James J. Murphy

I, James J. Murphy, of the City of Dallas, in the State of Texas, the United States of America, MAKE OATH AND SAY THE FOLLOWING:

1. I am an intellectual property attorney licensed to practice in the United States of America in the areas of patent and trademark law.
2. Since January 27, 2010 I have been receiving a newsletter distributed by Andrey Pinsky, a Canadian intellectual property and business lawyer. In his newsletter titled "CONCEPT LAW", Mr. Pinsky has been advertising and offering his intellectual property and business law services to the residents of the United States of America.
3. Mr. Pinsky clearly marked "CONCEPT LAW" as his trademark, which he used to identify his intellectual property and business law services offered and distributed to the residents of the United States of America.
4. Since January 27, 2010 to date, Mr. Pinsky on a continuous basis has been promoting and offering his intellectual property and business law services under the trademark "CONCEPT LAW" to the residents of the United States.
5. Mr. Pinsky used the trademark "CONCEPT LAW" in the form exhibited in the samples below:

CONCEPT LAW™



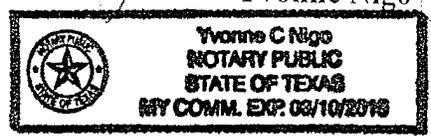
SWORN before me at the City of Dallas,
in the State of Texas, United States of America,
on this day of 19 October 2011.

Yvonne Nigo

 Commissioner for Taking Affidavits
 Yvonne Nigo

James J. Murphy

 James J. Murphy



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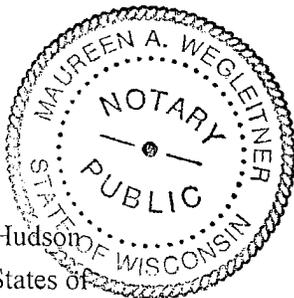
THIS IS EXHIBIT '24' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

AFFIDAVIT OF JOEL D. SKINNER

I, Joel D. Skinner, of the City of Hudson, in the State of Wisconsin, the United States of America, MAKE OATH AND SAY THE FOLLOWING:

1. I am an intellectual property attorney licensed to practice in the United States of America in the areas of patent and trademark law.
2. Since January 27, 2010 I have been receiving a newsletter distributed by Andrey Pinsky, a Canadian intellectual property and business lawyer. In his newsletter titled "CONCEPT LAW", Mr. Pinsky has been advertising and offering his intellectual property and business law services to the residents of the United States of America.
3. Mr. Pinsky clearly marked "CONCEPT LAW" as his trademark, which he used to identify his intellectual property and business law services offered and distributed to the residents of the United States of America.
4. Since January 27, 2010 to date, Mr. Pinsky on a continuous basis has been promoting and offering his intellectual property and business law services under the trademark "CONCEPT LAW" to the residents of the United States.
5. Mr. Pinsky used the trademark "CONCEPT LAW" in the form exhibited in the samples below:

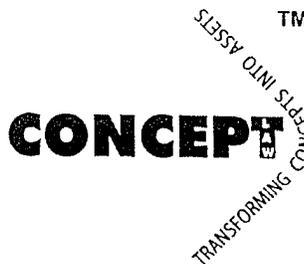
CONCEPT LAW TM



SWORN before me at the City of Hudson in the State of Wisconsin, United States of America, on this 12th day of October, 2011

Ma A. Wegleitner

 Commissioner for Taking Affidavits



Joel D. Skinner

 Joel D. SKinner

THIS IS EXHIBIT '25' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

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In the matter of mark Registration No.: 3981394
For the mark: KONCEPT
Date of First Use: June 12, 2010
Date of Registration: June 21, 2011

ANDREY PINSKY,

Petitioner,

v.

DOUGLAS BURDA,

Registrant.

Cancellation No. 92054551

AFFIDAVIT OF MIGUEL VILLARREAL, JR.

I, Miguel Villarreal, Jr., being duly sworn, depose and state the following:

1. "My name is Miguel Villarreal, Jr. I am over eighteen (18) years of age. I am an intellectual property attorney licensed to practice before the Courts of the State of Texas, the United States District Courts of Texas, the United States Court of Appeals for the Fifth Circuit and the United States Patent and Trademark Office. My practice is primarily in the areas of patent and trademark law. My office is located at 300 Convent St., Suite 1080, San Antonio, Texas 78205. I am fully competent to make this affidavit, and I have personal knowledge of the facts stated in this affidavit. To my knowledge, all of the facts stated in this affidavit are true and correct.
2. Since January 27, 2010, I have been receiving a newsletter distributed by Andrey Pinsky, a Canadian intellectual property and business lawyer. In his newsletter, titled "CONCEPT LAW," Mr. Pinsky has been advertising and offering his intellectual property and business law services to the residents of the United States of America.

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3. Mr. Pinsky clearly marked "CONCEPT LAW" as his trademark in his newsletter, which he used to identify his intellectual property and business law services offered and distributed to the residents of the United States of America.

4. Since January 27, 2010 to date, and based on the newsletters I have received, Mr. Pinsky on a continuous basis has been promoting and offering his intellectual property and business law services under the trademark "CONCEPT LAW" to the residents of the United States.

5. Mr. Pinsky used the trademark "CONCEPT LAW" in his newsletters in the form exhibited in the samples below:

CONCEPT LAW™



6. Further, Affiant sayeth naught."

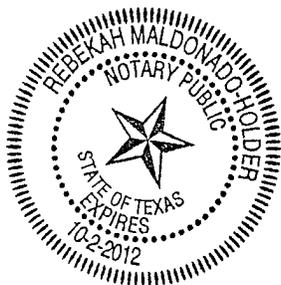
[Handwritten signature]
Miguel Villarreal, Jr.

BEFORE ME, the undersigned authority, on this day personally appeared MIGUEL VILLARREAL, JR., known to me to be the person of that name, who signed the foregoing instrument, and acknowledged the same to be his free act and deed.

GIVEN under my hand and seal of office this 4 day of October, 2011.

[Handwritten signature]
Signature of Notary Public

Rebekah Maldonado Holder
Printed Name of Notary Public



My Commission Expires: 10-2-2012
Notary Public for the State of Texas

THIS IS EXHIBIT '26' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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PINSKY LAW

Intellectual Property & Technology Law

SUITE 900
45 SHEPPARD AVE. EAST
TORONTO, ONTARIO
CANADA, M2N 5W9

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TEL: (416) 221 - 2600
FAX: (416) 221 - 2640
WWW.PINSKYLAW.CA

June 15, 2011

SENT BY EMAIL TO: HELLO@KONCEPTLAW.COM
DOUGLAS.BURDA@GMAIL.COM
TRADEMARKASSISTANCECENTER@USPTO.GOV

Douglas Burda
Koncept Innovative Law
P.O. Box 15533
Las Vegas, Nevada 89114
USA

Dear Mr. Burda

Re: Trademark "Koncept" USPTO file # 85176628

My name is Andrey Pinsky. I am the principal of Pinsky Law, a Canadian intellectual property law firm. As you are aware, CONCEPT LAW™ is trademark under which Pinsky Law distributes its intellectual property services for a number of years. My attention has been directed to your law firm's recent adoption of the trademark and trade name "Koncept Innovative Law" for a very similar legal services promoted and distributed in the same commercial channels.

Pinsky Law adopted the trademark CONCEPT LAW™ in 2007, not only in Canada and the United States but also internationally, and has been promoting its intellectual property services continuously since then. Pinsky Law has extensively promoted its CONCEPT LAW™ services to intellectual property practitioners in Canada, the United States, and internationally through brochures and monthly newsletters and has developed a valuable goodwill in the trademark since its adoption. Pinsky Law CONCEPT LAW™ newsletter has been delivered to thousands of intellectual property professionals in Canada, the United States, and internationally on a monthly basis. As a result, CONCEPT LAW™ has become a well-known trademark for intellectual property services.

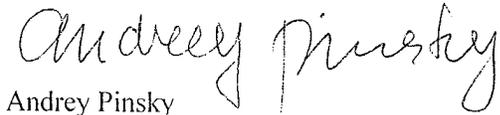
Pinsky Law does not have a United States trademark registration for CONCEPT LAW™, but it claims common law rights inuring to it from its long-standing use of that trademark. Trademark rights in the United States arise from use, not mere registration. I sincerely believe that the name "Koncept Innovative Law" and sale of intellectual property legal services under this name may mislead potential clients and intellectual property professionals into believing that your law firm services originate with Pinsky Law or that they are approved, sponsored, or supplied by Pinsky Law. I feel strongly that there is a high likelihood of confusion in the market place between Pinsky Law intellectual property services distributed under the trademark CONCEPT LAW™ and intellectual property services distributed under the name "Koncept Innovative Law". I believe that you are no more eager to suffer such confusion than Pinsky Law is. Accordingly, I ask that before your fledgling services get off the ground under the name "Koncept Innovative Law", you consider adopting another

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name and another trademark that could not create any confusion with Pinsky Law long-standing trademark CONCEPT LAW™.

My attention has also been directed to the fact that you filed trademark application for registration of the trademark "Koncept" on the principal register of the United States Patent and Trademark Office (USPTO). The trademark application (#85176628) was filed on November 15, 2010, and is still alive. You claimed June 12, 2010, as the date of first use of the trademark "Koncept". A simple Internet search for words "concept law" would have revealed to you that on both of those dates CONCEPT LAW™ was a trademark used by Pinsky Law to distribute its legal services. I can discern no legitimate commercial justification for your use and registration of the trademark "Koncept" other than to profit from Pinsky Law extensive advertising of the trademark CONCEPT LAW™ and the invaluable goodwill generated by it. Your actions are indefensible, as the numerous federal cases demonstrate. I am asking you to voluntarily abandon your trademark application with the USPTO for the trademark "Koncept". I am asking you to abandon your trademark application in order to avoid expenses that will arise from expungement proceedings I will have to commence to cancel registration of the trademark "Koncept".

If you believe that I am mistaken in my conviction that there inevitably will be confusion between CONCEPT LAW™ trademark and "Koncept" trademark, I welcome your written comments. However, if I have persuaded you that there may be substantial confusion, it stands to reason that as the junior adopter, you might consider renaming your law firm and the trademark it uses to distribute its services. I look forward to receiving your written reply at your earliest convenience.

Yours very truly,


Andrey Pinsky

Copy to: Caryn Glasser United States Patent and Trademark Office by email and mail

THIS IS EXHIBIT '27' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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PINSKY LAW

Intellectual Property & Technology Law

SUITE 900
45 SHEPPARD AVE. EAST
TORONTO, ONTARIO
CANADA, M2N 5W9

TEL: (416) 221 - 2600
FAX: (416) 221 - 2640
WWW.PINSKYLAW.CA

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June 15, 2011

SENT BY EMAIL TO: TRADEMARKASSISTANCECENTER@USPTO.GOV
SENT BY FAX TO: (571) 270-2517
AND BY MAIL TO:

Caryn Glasser
Trademark Assistance Center
P.O. Box 15533 Madison East,
Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314
USA

Dear Ms. Glasser

Re: Trademark "Koncept" USPTO file # 85176628

Please find enclosed letter to Mr. Douglas Burda concerning the abovementioned trademark application.

Yours very truly,


Andrey Pinsky

THIS IS EXHIBIT '28' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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To: The Concept Law Group, P.A. (scott@pats-tms.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85230890 - THE CONCEPT
LAW GROUP - TCLG/TM
Sent: 5/3/2011 10:45:34 AM
Sent As: ECOM109@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85230890

MARK: THE CONCEPT LAW GROUP

85230890

CORRESPONDENT ADDRESS:

SCOTT SMILEY
THE CONCEPT LAW GROUP, P.A.
716 NW 30TH CT
FORT LAUDERDALE, FL 33311-1722

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: The Concept Law Group, P.A.

CORRESPONDENT'S REFERENCE/DOCKET
NO:

TCLG/TM

CORRESPONDENT E-MAIL ADDRESS:

scott@pats-tms.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 5/3/2011

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Prior Pending Application

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The filing dates of pending Application Serial Nos. 85176628 precede applicant's filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Mark Differs on Drawing and Specimen

The mark on the specimen disagrees with the mark on the drawing. In this case, the specimen displays the mark as THE CONCEPT LAW GROUP, P.A.; and the drawing shows the mark as only THE CONCEPT LAW GROUP.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). The mark on the drawing must be a substantially exact representation of the mark on the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a); *see* 37 C.F.R. §2.72(a)(1). In addition, the drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.*

Therefore, applicant must submit one of the following:

- (1) A new drawing of the mark that agrees with the mark on the specimen but does not materially alter the original mark. See 37 C.F.R. §2.72(a)(2); TMEP §§807.12(a), 807.14 *et seq.* Amending the drawing to agree with the specimen would not be considered a material alteration of the mark in this case.; or
- (2) A substitute specimen showing use in commerce of the mark on the drawing, and the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The substitute specimen was in use in commerce at least as early as the filing date of the application.”** See 37 C.F.R. §§2.59(a), 2.193(e)(1); TMEP §§807.12(a), 904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

If applicant cannot satisfy one of the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. See TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. See 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or

signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark and/or service mark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

DISCLAIMER REQUIRED

Applicant must disclaim the descriptive wording “LAW GROUP” apart from the mark as shown because it merely describes an ingredient, quality, characteristic, function, feature, purpose or use of applicant’s goods and/or services. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); TMEP §§1213, 1213.03(a).

Specifically, the application lists applicant as providing legal services. The term LAW GROUP indicates applicant is a provider of those services..

The following is the standard format used by the Office:

No claim is made to the exclusive right to use “LAW GROUP” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner’s amendment will not incur this additional fee.

If the applicant has any questions or needs assistance regarding this action, please telephone the assigned examining attorney.

/Frank J Lattuca/
 Trademark Examining Attorney
 Law Office 109
 Tel: (571) 270-1518
 Email: Frank.Lattuca@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please

wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: May 3, 2011

85176628

Issue: 0000/00/00

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DESIGN MARK

Serial Number

85176628

Status

PUBLISHED FOR OPPOSITION

Word Mark

KONCEPT

Standard Character Mark

Yes

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Burda, Douglas INDIVIDUAL UNITED STATES P.O. Box 15533 Las Vegas
NEVADA 89114

Goods/Services

Class Status -- ACTIVE. IC 045. US 100 101. G & S: Legal services.
First Use: 2010/06/12. First Use In Commerce: 2010/06/12.

Filing Date

2010/11/15

Examining Attorney

GLASSER, CARYN

Attorney of Record

Douglas Burda

KONCEPT

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Print: May 3, 2011

85176628

Issue: 0000/00/00

DESIGN MARK

Serial Number
85176628

Status
PUBLISHED FOR OPPOSITION

Word Mark
KONCEPT

Standard Character Mark
Yes

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Burda, Douglas INDIVIDUAL UNITED STATES P.O. Box 15533 Las Vegas
NEVADA 89114

Goods/Services
Class Status -- ACTIVE. IC 045. US 100 101. G & S: Legal services.
First Use: 2010/06/12. First Use In Commerce: 2010/06/12.

Filing Date
2010/11/15

Examining Attorney
GLASSER, CARYN

Attorney of Record
Douglas Burda

KONCEPT

THIS IS EXHIBIT '29' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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To: The Concept Law Group, P.A. (scott@pats-tms.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85230890 - THE CONCEPT LAW GROUP - TCLG/TM
Sent: 5/3/2011 10:45:37 AM
Sent As: ECOM109@USPTO.GOV
Attachments:

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 5/3/2011 FOR
SERIAL NO. 85230890**

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable response time period. Your response deadline will be calculated from 5/3/2011 (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System Response Form.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.

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Side - 1



NOTICE OF ABANDONMENT
MAILING DATE: Nov 29, 2011

The trademark application identified below was abandoned in full because a response to the Office Action mailed on May 3, 2011 was not received within the 6-month response period.

If the delay in filing a response was unintentional, you may file a petition to revive the application with a fee. If the abandonment of this application was due to USPTO error, you may file a request for reinstatement. Please note that a petition to revive or request for reinstatement **must be received within two months from the mailing date of this notice.**

For additional information, go to <http://www.uspto.gov/teas/petinfo.htm>. If you are unable to get the information you need from the website, call the Trademark Assistance Center at 1-800-786-9199.

SERIAL NUMBER: 85230890
MARK: THE CONCEPT LAW GROUP
OWNER: The Concept Law Group, P.A.

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

FIRST-CLASS
MAIL
U.S. POSTAGE
PAID

SCOTT SMILEY
THE CONCEPT LAW GROUP, P.A.
716 NW 30TH CT
FORT LAUDERDALE, FL 33311-1722

THIS IS EXHIBIT '30' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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702-583-4940

FOLLOW
PandAON



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[CREDIT TIPS](#)

[TESTIMONIALS](#)

[CONTACT US](#)

Las Vegas Bankruptcy Lawyers

Xenophon M. Peters



Attorney Xenophon M. Peters is a founding partner at Peters & Associates, LLP in Las Vegas, where he concentrates on helping people and businesses in Las Vegas, North Las Vegas and Henderson, Nevada with Chapter 7 and Chapter 13 bankruptcy, debt settlement, loan modifications, foreclosure mediations, short sales, and deeds in lieu of foreclosure.

Mr. Peters' experience includes complex real estate law in the areas of real estate development, transactions and commercial finance. Mr. Peters has represented some of the largest developers in Las Vegas regarding apartment complexes, mixed-use projects, and high-rise resorts, condominiums and condominium-hotel developments. He has represented both buyers and sellers in the purchase and sale of hotels/casinos and developed/undeveloped land. Currently, Mr. Peters focuses his practice on residential and commercial loan modifications, foreclosure mediations, short sales and consumer bankruptcies.

Prior to becoming an attorney, Mr. Peters was a financial advisor at a major stock brokerage. There, he guided his clients to help attain their financial goals. With this financial background, Mr. Peters is not only able to give clients their best legal options out of debt, but also help them achieve their ultimate financial goals once their debt issues have been resolved.

Education:

J.D., Boyd School of Law, University of Nevada, Las Vegas
B.S., University of California - Davis

Admissions:

California State Courts
Nevada State Courts

Professional Associations/Memberships:

State Bar of California
State Bar of Nevada
Named as Super Lawyers Rising Star - 2011

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5426 SOUTH EASTERN AVENUE
SUITE 100
LAS VEGAS, NV 89119

TELEPHONE: 702-583-4940
FAX: 702-473-9138

Las Vegas Bankruptcy Lawyer Judah Zakalik



Attorney Judah Zakalik is a Partner in Peters & Associates, LLP, a Nevada law firm helping consumers in Las Vegas and Henderson find debt relief through a Chapter 7 or Chapter 13 bankruptcy or debt settlement, and helping homeowners avoid foreclosure through loan modifications and workouts, short sales, and deeds in lieu of foreclosure.

Mr. Zakalik's legal background includes experience in corporate litigation, real estate transactions, corporate bankruptcies, and intellectual property rights. As a courtroom litigator, Mr. Zakalik represented financial institutions in lawsuits brought by homeowners for violations of federal statutes. This

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... experience has proved invaluable in Mr. Zakalik's current practice, helping homeowners and businesses keep their residential and commercial property through the loan modification process and consumer bankruptcies.

As a Founding Member of the Diversity Committee within the State Bar of Nevada, Mr. Zakalik actively volunteers his time to increase diversity within the legal profession in the State of Nevada. When not practicing law, Mr. Zakalik enjoys the Las Vegas arts and music scene, traveling, and engaging in snow sports and martial arts.

Education:

J.D., *magna cum laude*, Seattle University School of Law
B.A., University of Washington

Admissions:

Nevada State Courts
Nevada Federal Courts

Professional Associations/Memberships:

State Bar of Nevada (Founding Member, Diversity Committee)

Jennifer Rigdon, Associate

Jennifer Rigdon is an associate at Peters & Associates, LLP, where she practices primarily in the area of consumer bankruptcy law in the Las Vegas, North Las Vegas and Henderson, Nevada regions, with a focus on debtor rights in Chapter 7 and Chapter 13.

Ms. Rigdon graduated with a Bachelor of Arts degree, *summa cum laude*, from the University of California, Los Angeles in 2004. She earned her Juris Doctorate from the University of Nevada, Las Vegas William S. Boyd School of Law in 2007. While attending law school, she served as a judicial extern to the Honorable Timothy P. Greeley of the United States District Court for the Western District of Michigan. She also served as an extern to the Nevada Attorney General's Office. She is admitted to practice before the state and federal courts of Nevada and is a member of the State Bar of Nevada.

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THIS IS EXHIBIT '31' TO THE DECLARATION
OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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Trademarks > Trademark Electronic Search System (TESS)

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 Standard Characters Claimed
 Mark Drawing Code (4) STANDARD CHARACTER MARK
 Serial Number 85272772
 Filing Date March 21, 2011
 Current Filing Basis 1A
 Original Filing Basis 1A
 Published for Opposition August 2, 2011
 Registration Number 4041945
 Registration Date October 18, 2011
 Owner (REGISTRANT) Douglas Burda INDIVIDUAL UNITED STATES 900 Las Vegas Boulevard South, Unit 1009 Las Vegas NEVADA 89101
 Attorney of Record Douglas Burda
 Type of Mark SERVICE MARK
 Register PRINCIPAL
 Live/Dead Indicator LIVE

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OF ANDREY PINSKY OF TORONTO, ONTARIO, CANADA

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EXHIBIT 2

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Pinsky Law

From: "Pinsky Law" <contact@pinskylaw.ca>
To: "Douglas Burda" <dbb@konceptlaw.com>
Sent: September 29, 2011 9:57 AM
Subject: Re: KONCEPT® Trademark - United States Registration Number 3981394
 Mr. Burda,

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Your consent to service with my Petition to Cancel via email was requested on September 23, 2011, and was expected not later than the following day. Giving your consent to service via email today, after I served you with my Petition to Cancel via FedEx, is preposterous. I do not consent to communication and service of documents via email. To ensure proper record, I require communication and service via fax. Please provide your fax number. My fax number is (416) 221-2640. Since you appear to have difficulty to comprehend my messages first time around, I repeat - you have to communicate with me via fax only. Your communications via email and phone will not receive my reply.

Yours truly,
 Andrey Pinsky

----- Original Message -----

From: Douglas Burda
To: Pinsky Law
Sent: Wednesday, September 28, 2011 7:59 PM
Subject: Re: KONCEPT® Trademark - United States Registration Number 3981394

Mr. Pinsky:

I consent to service of your Petition to Cancel via email to the email address you specified. Please specify the email address to which I should direct all papers in TTAB Cancellation Proceeding Number 92054551. Please also confirm your agreement that all such papers may be served via electronic transmission to such email address.

Sincerely,

koncept llc

douglasburda, esq. | o | +001 702.518.0075 | m | +001 248.217.0002 | e | dbb@konceptlaw.com | skype | douglas.burda | w | konceptlaw.com | tw | [@konceptlaw](https://twitter.com/@konceptlaw) | fb | konceptlaw | a | 900 las vegas blvd s, unit 1009 | las vegas, nevada 89101

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From: Pinsky Law <contact@pinskylaw.ca>
Date: Fri, 23 Sep 2011 08:58:58 -0400
To: Douglas Burda <dbb@konceptlaw.com>
Cc: Pinsky Law <contact@pinskylaw.ca>
Subject: Re: KONCEPT® Trademark - United States Registration Number 3981394

Mr. Burda,

I am asking you to confirm that I can serve you with my Petition to Cancel by forwarding it via FedEx to:

Douglas Burda
 Unit 1009
 900 Las Vegas Boulevard South
 Las Vegas, Nevada 89101
 USA

I am also requesting your written consent to serve you with my Petition to Cancel via the email address

dbb@konceptlaw.com

Yours truly,
Andrey Pinsky

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----- Original Message -----

From: Douglas Burda

To: Pinsky Law

Sent: Thursday, September 22, 2011 11:07 PM

Subject: KONCEPT® Trademark - United States Registration Number 3981394

Mr. Pinsky:

We are in receipt of a message sent by you through our website. I will reserve comment regarding whether such message was sent in accordance with the Terms of Use, to which you necessarily must have read and agreed so as to utilize our website and any message-sending functionality thereon.

Further, as you well know, your allegations regarding the Nevada Rules of Professional Conduct are baseless. Any complaint to the Nevada Bar will be reciprocated on a number of levels.

In any case, we believe the issues you purport to raise are without merit. Upon your filing of any cancellation proceeding involving our mark, we will contemplate a civil action against you in the federal courts of the United States of America as we believe that your threats are made fraudulently, in bad faith and with the objective of illegitimately interfering with our business. Additionally, we believe that your actions to date are in violation of the FCRP, which we will raise, together with your other claims made in bad faith, before the USPTO and elsewhere if necessary. In addition to your latest round of messages, we see your initial salvo as providing more than enough fodder to ensure that your actions are dealt with appropriately.

We will seek damages from you for any and all action you take regarding this matter, including without limitation for any and all attorney's fees resulting from your illegitimate actions. Nothing contained and/or omitted from this letter is intended to be or should be considered an admission of any fact or a waiver of any right or defense, all of which are expressly reserved.

Additionally, we are presently examining the applicability of The Canadian Bar Association's Code of Professional Conduct to your conduct, specifically with respect to certain rules in Chapter IX.

In any case, our office address is below which, by your own terms, settles your threat concerning the Nevada Bar complaint. We do not utilize a fax machine as it is an archaic technology. We welcome any further correspondence from you according to the applicable rules of practice.

Yours very truly,

koncept®

douglasburda, esq. | o | +001 702 518 0075 | m | +001 248 217 0002 | e | dbb@konceptlaw.com | w | konceptlaw.com | a | 900 las vegas blvd s. unit 1009 | las vegas, nevada 89101 USA

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Pinsky Law

From: "Douglas Burda" <dbb@konceptlaw.com>
To: "Pinsky Law" <contact@pinskylaw.ca>
Sent: September 22, 2011 8:14 PM
Subject: Re: Intellectual Property
 Mr. Pinsky:

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In addition to not taking my phone call earlier today, I note your now express declination of placing a phone call to me in furtherance of resolution without the need to resort to the USPTO because you are "not interested" in such a path.

My offer to discuss this matter prior to your threatened action remains open.

Sincerely,
 Douglas Burda

From: Pinsky Law <contact@pinskylaw.ca>
Date: Thu, 22 Sep 2011 20:51:04 -0400
To: Douglas Burda <dbb@konceptlaw.com>
Subject: Re: Intellectual Property

Mr. Burda,

I repeat, I am not interested in a discussion or a settlement. I am interested in a cancellation of your registration. Accordingly, I am the last time asking you for a fax number and physical address of your law firm in order to serve you with my Petition to Cancel. If you again refuse to provide them, I will proceed through a complaint with the Nevada Bar as I indicated in my original email to you. Please do not make it more painful and complicated than it should be.

Yours truly,
 Andrey Pinsky

----- Original Message -----

From: Douglas Burda
To: Pinsky Law
Sent: Thursday, September 22, 2011 8:35 PM
Subject: Re: Intellectual Property

Mr. Pinsky:

You misinterpret my use of the word "settle".

Final offer: contact me immediately regarding this matter.

Sincerely,
 Douglas Burda

From: Pinsky Law <contact@pinskylaw.ca>
Date: Thu, 22 Sep 2011 20:25:19 -0400
To: Douglas Burda <dbb@konceptlaw.com>
Subject: Re: Intellectual Property

Mr. Burda,

Thank you for your reply. I am not interested in a settlement. I am seeking a cancellation of your trademark registration. Please provide me with a fax number to serve you with my Petition to Cancel.

Thank you.

Yours truly,

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Andrey Pinsky

----- Original Message -----

From: Douglas Burda**To:** Anndrey Pinsky**Sent:** Thursday, September 22, 2011 8:15 PM**Subject:** Re: Intellectual Property

Mr. Pinsky:

Please contact me immediately by telephone. I believe we can settle this matter easier that you seem to think.

Sincerely,
Douglas Burda
Koncept
(248) 217-0002**From:** Anndrey Pinsky <contact@pinskylaw.ca>**Reply-To:** Anndrey Pinsky <contact@pinskylaw.ca>**Date:** Thu, 22 Sep 2011 17:52:00 -0500**To:** Douglas Burda <dbb@konceptlaw.com>**Subject:** Intellectual Property**Your Name:** Anndrey Pinsky**Your Email:** contact@pinskylaw.ca**Your Telephone:** (416) 221-2600**Your URL (YourURL.com):** www.pinskylaw.ca**Your Twitter URL (twitter.com/yourtwitterURL):****Preferred contact method:** Email**Subject:** Intellectual Property

Communication: Good day Mr. Burda, I am commencing trademark cancellation proceedings in respect of your trademark KONCEPT. I have to serve you with my Petition to Cancel. Unfortunately, you do not provide a physical address of your law office on your website. You also do not provide a fax number of your law office. This lack of physical address of your law office and lack of fax number precludes me from serving you with my Petition to Cancel and violates a number rules of the Nevada Bar Rules of Professional Conduct. Please provide me with your law office physical address, email, and fax number through which you permit me to serve you with my Petition to Cancel your trademark. Please provide this information not later than 14:00 on September 23, 2011. If I am not in receipt of this information by 14:00 on September 23, 2011, I will file a formal complaint with the Nevada Bar. I will be stating my inability to properly serve you with my Petition to Cancel as one of the grounds of my complaint, and I will be seeking from the Bar, inter alia, assistance to serve you with my Petition to Cancel. I sincerely hope that this will not be necessary and that you will provide me with an opportunity to properly serve you with my Petition to Cancel your trademark. Yours truly, Andrey Pinsky

EXHIBIT 3

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Andrey Pinsky (Pinsky Law)

From: "Douglas Burda" <dbb@konceptlaw.com>
To: <andrey@pinskylaw.ca>
Sent: November 19, 2011 3:35 PM
Subject: Re: Discovery Conference
 Mr. Pinsky:

As I've not yet heard back from Ms. Dunn regarding the availability of the Board for our Conference, and in light of the holidays which are rapidly approaching, I would recommend that we schedule our Discovery Conference presently, and amend our schedules if Ms. Dunn does have the opportunity to contact me regarding the Board's availability.

I am prepared to make myself available at any time after 1:00 p.m. Pacific time on Tuesday, November 22 or Wednesday, November 23. Please let me know which of these dates is acceptable, at what time, and the best telephone number at which to reach you. If you cannot be available on either of these dates, the following Tuesday or Wednesday at the same times also works for me.

Thank you for your consideration and prompt reply.

Sincerely,

koncept[®]

Douglas Burda, Esq. | o | +001 702 518 0075 | m | +001 248 217 0002 | a | 900 las vegas boulevard south | unit 1009 | las vegas nevada 89101-6860

//

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From: "Andrey Pinsky (Pinsky Law)" <andrey@pinskylaw.ca>
Date: Thu, 3 Nov 2011 14:22:18 -0400
To: Douglas Burda <dbb@konceptlaw.com>
Subject: Re: Discovery Conference

Mr. Burda,

1. You should not assume anything in life in general and in these proceedings in particular. I advised you that you would be communicating with me (and serving your documents) in a hard copy. Since you are unable (or not willing) to get a fax software to receive faxes, you leave mail as the only option for communication. I contacted you via email on an exceptional basis because we only have 10 days to schedule the Discovery Conference with participation of a Board Member. My mail would not reach you and your reply would not come back to me in these 10 days. All your correspondence to me after the Discovery Conference is scheduled must be in a hard copy.

2. Do not contact the Board behind my back without copying your correspondence to me. I consider contacts of the Board without copying correspondence to me to be a breach of Rules of Professional conduct and I will act accordingly. All your correspondence with the Board must be in writing and you must copy your correspondence to me.

3. You did not provide me with dates and times of your preference for the Discovery Conference. Please provide dates and times at which you are available for the conference in order to select a mutually convenient date and time.

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Yours truly,
Andrey Pinsky

----- Original Message -----

From: Douglas Burda
To: Andrey Pinsky (Pinsky Law)
Sent: Wednesday, November 02, 2011 6:11 PM
Subject: Re: Discovery Conference

Mr. Pinsky:

This email is sent on the assumption that communication via email is now acceptable to you. Please confirm your agreement to service of documents via email as well.

Regarding your dilatory request and message below, please note that I already requested via telephone, prior to your request, the presence of the Board at the Conference.

Further, I've been informed that Ms. Dunn has only recently returned to her office after being out on sick leave, so I would recommend that we accommodate Ms. Dunn's preferences on this matter, rather than your own.

Obviously, the Board's scheduling constraints take priority over our own, so it will be far more efficient for us to discuss our own availability after we are aware of the Board's. As such, after Ms. Dunn communicates the Board's availability, we will be in touch regarding same.

Note that the deadline for the Conference is December 2, 2011.

Sincerely,

koncept[®]

douglasburda, esq. | o | +001 702.518.0075 | m | +001 248.217.0002 | e | dbb@konceptlaw.com | a | 900 las vegas
blvd s, unit 1009 | las vegas, nevada 89101

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On 11/1/11 1:54 PM, "Andrey Pinsky (Pinsky Law)" <andrey@pinskylaw.ca> wrote:

Mr. Burda,

I filed a request for a Board Member participation in the mandatory Discovery Conference. A copy of the request is attached. Please provide dates and times at which you are available for the conference in order to select a mutually convenient date and time.

Yours truly
Andrey Pinsky

Tel: (416) 221-2600
Fax: (416) 221-2640
www.pinskylaw.ca
900 - 45 Sheppard Ave. East
Toronto, ON, M2N 5W9
Canada

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EXHIBIT 4

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

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DUNN

Mailed: December 1, 2011

Cancellation No. 92054551

Andrey Pinsky

v.

Douglas Burda

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

On November 29, 2011, at the request of both parties, the Board participated in the discovery conference. The participants were Andrey Pinsky, petitioner acting pro se, Douglas Burda, respondent acting pro se, and Elizabeth Dunn, attorney for the Board.

As stated, discovery conferences may not be recorded. Inasmuch as the conference lasted more than an hour, this order only summarizes the main topics discussed. To the extent that each party accused the other of misrepresentations and other unethical conduct, the parties are advised to read this order carefully with respect to how such concerns may be addressed to the Board, the care with which such accusations

should be made, and the Board's unwillingness to tolerate anything but strict compliance with its rules.

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REPRESENTATION

The petition to cancel identifies petitioner as a Canadian attorney and respondent as a U.S. attorney. The amended answer admits that respondent is a U.S. attorney and alleges the affirmative defense (§14) that "petitioner lacks standing to practice before the [Office]." Patent and Trademark Rule 11.14(e) provides "Any individual may appear in a trademark or other non-patent matter in his or her own behalf."¹ Petitioner's occupation as a Canadian attorney does not preclude his self-representation in this proceeding. The Office's rules regarding recognition of Canadian attorneys applies only to those attorneys representing a third party. See Patent and Trademark Rule 11.14(e) ("No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client.") (emphasis added). Accordingly, the Board sua sponte strikes the affirmative

¹ While Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matter. 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).

defense that petitioner lacks standing to practice before the Board.

COMMUNICATION

In view of the mutual complaints about difficulties in communication, the parties are ordered to list a phone number at which he can be reached or a message left, and which is checked for messages on a daily basis, on all papers hereafter filed with Board. If the number changes, the party immediately must notify the Board in writing of an alternate phone number. In addition, the parties must respond to messages regarding this proceeding, whether left by the Board or the other side, by the end of the next business day. Before moving for Board action on the basis that this order has not been followed, a second message must be left, and a second response period must pass. While, as discussed, the Board will allow certain disputes to be resolved by oral motion, any motion to the Board regarding the failure to promptly respond to a phone message must be made in writing and accompanied by an affidavit or declaration pursuant to Trademark Rule 2.20.

Based on the strong preference expressed by each party for conflicting modes of electronic communication, as well as the acrimony displayed by the parties, the parties may only utilize facsimile or email service of if they file a

signed stipulation agreeing to such service with the Board. Absent such filing, service may be made ONLY by those alternate means set forth in Trademark Rule 2.119. Any paper filed which lacks proper proof of service will be given no consideration.

RELATED PROCEEDINGS

Neither party owns a pending application for a related mark. The parties are aware of no related proceedings before the Board or in any court. As set forth in the institution order, the parties must notify the Board promptly if they become parties to another Board proceeding or civil action which involve related marks which overlap with this case, and this obligation continues for the duration of this proceeding.

SETTLEMENT

While the Board may facilitate settlement by adjusting the schedule, the Board does not actively promote settlement, which remains wholly the choice of the parties. As explained, only 2% of all Board proceedings result in a final decision on the merits, and a substantial portion of the 98% of proceedings which terminate earlier do so as a result of an agreement between the parties. The discussion of settlement of this proceeding ended when petitioner treated respondent's

overtures as admissions that respondent would be unable to maintain the registration and was unethical in defending his registration. As the Board noted, the accusation is unwarranted.

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If interest in settlement occurs at a later point in this proceeding, and the parties wish to avoid the expense of trial preparation unless it is necessary, the parties should stipulate in writing to suspension of this proceeding. Absent suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines already set by the Board. *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations did not justify party's inaction or delay).

PLEADINGS

The petition to cancel claims priority of use and likelihood of confusion between petitioner's common law mark CONCEPT LAW and respondent's mark KONCEPT, the subject of Registration No. 85176628, both for legal services. On October 31, 2011 applicant filed its answer, and then on November 14, 2011, applicant filed an amended answer which denied the salient allegations of the petition to cancel. The amended answer is accepted. See Fed. R. Civ. P. 15(a)(1)(A) ("A party may amend its pleading once as a matter of course within 21 days after serving it").

Respondent asked whether he could file a motion to amend the answer to assert the affirmative defense that petitioner does not use the mark in commerce. Petitioner, as the party bearing the burden of proof in this proceeding, must demonstrate that he is the owner of superior rights to those of respondent with respect to the mark CONCEPT LAW for legal services. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Accordingly, petitioner must establish his rights as part of his case in chief, and the assertion that he lacks such rights is not an affirmative defense but an amplification of respondent's denial of the claim of likelihood of confusion. See *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1718 FN 2 (TTAB 2008).

Petitioner asked if there were any time limits on the ability to move to amend the pleadings. Subject to the movant demonstrating that the requested amendment is timely and not futile, the answer is no. *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008) ("The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.").

As discussed, if the parties lack access to a law library or legal research service, the USPTO website offers research

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options in the form of a searchable database of Board final decisions. On the Board's webpage, clicking "TTAB Final Decisions" brings the user to a search page where date parameters and a key word (such as confusion or generic) may be entered. The search will produce a listing of the Board final decisions which use that term within the specified period. By clicking on the proceeding number in the list, the user may read the full decision.

STIPULATION FOR EXPANDED INITIAL DISCLOSURES

The parties agree 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.

This stipulation is intended to save both parties time and money but does not replace or prevent discovery on the issue of first use if either party believes it necessary.

DISCLOSURES, DISCOVERY, TRIAL EVIDENCE

The parties did not agree to adopt ACR (accelerated case resolution) procedures or any other measures (in addition to the stipulation set forth above) to expedite this proceeding. As discussed, in addition to approving adoption of ACR (accelerated case resolution) procedures, the Board will entertain any stipulations designed to save the parties time and money, such as stipulating to facts, agreeing to a

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shortened schedule of disclosure, discovery, and trial, and/or stipulating as to the admissibility of evidence. However, in the absence of written agreements filed with the Board, disclosures, discovery and the submissions of trial evidence must comport with the relevant Trademark Rules as well as the relevant rules of civil procedure.

As discussed in connection with communication, 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. The Board's standard protective order governs the disclosure of confidential information in this proceeding, and is available from the Office website. Once initial disclosures have been filed, a party may seek discovery. The parties are expected to cooperate in the exchange of disclosures and discovery.

An opposition before the Board is similar to a civil action in a federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written

transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accord with the applicable rules.

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MOTIONS FOR SANCTIONS

As discussed, one party's opinion about the conduct or character of the other party is irrelevant to this proceeding and should not be expressed orally or in writing to the Board. If pertinent to a motion requesting specific action from the Board, specific actions by the other party should be described without comment. While a failure to produce proper disclosures or requested discoverable information generally is addressed by a motion to compel, more serious breaches of conduct or the Board's rules may be the subject of a motion for sanctions. The TBMP describes several bases for a motion for sanctions.

Fed. R. Civ. P. 11 certification standards apply to parties as well as attorneys. See *Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.*, 498 U.S. 533, 547, 111 S.Ct. 922, 112 L.Ed.2d 1140 (1991) and *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). Fed. R. Civ. P. 11(b) states: By presenting to the court a pleading, written motion, or other paper – whether by signing, filing, submitting, or later

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advocating it – an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

- (1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;
- (2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;
- (3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

Fed. R. Civ. P. 11(c)(2) provides a "safe harbor" provision allowing the party or attorney an opportunity to withdraw or correct a challenged submission. This provision delays filing of a motion for sanctions before the Board for twenty-one days after service of the challenged submission and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected. The Board will deny motions for Fed. R. Civ. P. 11 sanctions which fail to comply with this requirement.

ORAL MOTIONS OR RESPONSES

With the exception of motions for sanctions or failure to return phone calls (which must be in writing), the parties may request to bring oral motions on contested matters. If a written motion is filed, the responding party may request to

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bring his response orally. Before requesting the Board to hear a contested motion by phone, the requesting party must contact the other party for available times and dates. In addition, even if the parties do not request it, the Board may order parties to appear by phone for a conference on a pending motion. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) §502.06 (3rd ed. 2011).

EX PARTE COMMUNICATIONS

The availability of the Board to expedite the proceeding by deciding motions in a conference with the parties should not be mistaken for availability of the Board for ex parte communications. Parties may telephone the Board to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or any particular issue. The Board may not conduct research for the parties, recommend particular action, or suggest which rules are applicable to the party's circumstances. TBMP §105 (3rd ed. 2011).

DATES REMAIN THE SAME

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

EXHIBIT 5

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

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ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**REGISTRANT'S OPPOSITION TO
PETITIONER'S SUMMARY OF TELEPHONE CONVERSATION**

Respondent, Douglas Burda (Registrant) hereby requests that the Trademark Trial and Appeal Board (Board) deny Petitioner's Summary of Telephone Conversation, filed with the Board by Petitioner in the above-referenced proceeding on December 5, 2011.

REGISTRANT'S OPPOSITION TO PETITIONER'S SUMMARY OF TELEPHONE CONVERSATION (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 December 6, 2011 pursuant to the Board's Order of December 1, 2011 (Order) and the applicable rules of practice before the Board, Registrant telephoned Petitioner to request Petitioner's consent to file Registrant's amended answer thereby

obviating the Board's involvement in having to consider granting leave to Registrant to do so. Petitioner did not respond and Registrant left a voice message on Petitioner's voice messaging system. When Petitioner did eventually return Registrant's call, Petitioner denied Registrant's request for Petitioner's consent.

On December 7, 2011, Registrant filed Registrant's Motion for Leave to File Second Amended Answer and Affirmative Defenses to Petition for Cancellation. On the same day, Petitioner filed its 2011-12-07 Summary of Telephone Conversation December 7, 2011.pdf (Conversation Summary), to which this paper is in opposition.

II. LEGAL STANDARDS.

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 Discovery Conference Summary at 2.

III. ARGUMENT.

A. Petitioner's Conversation Summary Should Be Denied because The Nature of Petitioner's Paper is Unclear and May Have Been Filed for An Improper Purpose.

Registrant notes that the nature and purpose of Petitioner's Conversation Summary is ambiguous and that Petitioner's Conversation Summary 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 respond to the Conversation Summary 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.

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To the extent Registrant's further substantive response to the Conversation Summary is necessary, Registrant would respectfully reserve Registrant's rights to supplement and/or withdraw all or part of Registrant's Opposition based upon treatment of the Conversation Summary by the Board.

IV. CONCLUSION.

For the forgoing reasons, Registrant respectfully requests that the Board deny Petitioner's Conversation Summary 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 Conversation Summary.

December 22, 2011

Respectfully submitted,

Douglas Burda
KONCEPT® LLC
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Phone. (248) 217-0002
Email. dbb@konceptlaw.com
Attorney & Registrant

EXHIBIT 6

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PINSKY LAW

Intellectual Property & Technology Law

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December 7, 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

Mr. Burda placed a call to me yesterday December 6, 2011, at 19:33 Pacific Time which was 22:33 Eastern Time and left a message on my answering machine. Mr. Burda did not specify what was the reason for his call or why he would like to talk to me. I returned Mr. Burda's call the following morning December 7, 2011, first time at 11:30 Eastern Time which was 8:30 in Pacific Time. Mr. Burda did not answer his phone. I placed my second call to Mr. Burda at 12:00 Eastern Time. At that time I was able to reach Mr. Burda.

Mr. Burda advised me that:

1. He was seeking my written consent to file his Second Amended Answer;

I advised Mr. Burda that:

1. He had to put his request for my consent in writing.

Mr. Burda refused to provide his request in writing and advised me that he would interpret my request to put his request in writing as my refusal of his request. I reiterated to Mr. Burda that I would provide my written reply to his written request.

I further advised Mr. Burda that:

1. I would not carry out oral communications about this matter;

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2. All communications from Mr. Burda to me must be in writing;
3. Communications that are not in writing will not receive my reply;
4. I will not return Ms. Burda telephone calls;
5. I will provide the Board with a summary of our telephone conversation.

Mr. Burda took notes and wrote down the above five points.

Yours truly,

A handwritten signature in cursive script that reads "Andrey Pinsky".

Andrey Pinsky

EXHIBIT 7

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

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ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**REGISTRANT'S MOTION FOR LEAVE TO FILE SECOND AMENDED ANSWER AND
AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION**

Respondent, Douglas Burda (Registrant) hereby moves the Trademark Trial and Appeal Board (Board) for leave to allow Registrant to file REGISTRANT'S SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION (Second Amended Answer) in the above-referenced proceeding.

Registrant's motion (Motion) is supported by Registrant's BRIEF IN SUPPORT OF MOTION, below, the [Proposed] REGISTRANT'S SECOND AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION, attached hereto as Exhibit 1, the papers on file with the Board in this matter, and any other matters properly before the Board.

BRIEF IN SUPPORT OF MOTION

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I. BACKGROUND.

On October 31, 2011 Registrant filed its answer in this matter, and then on November 14, 2011, Registrant filed its amended answer. On November 29, 2011, the Board participated in the discovery conference between Petitioner and Registrant. During the discovery conference, Registrant brought up to the Board Registrant's affirmative defense that "Petitioner lacks standing to practice before the United States Patent and Trademark Office." See Registrant's First Amended Answer and Affirmative Defenses to Petition for Cancellation (First Amended Answer), ¶14 (the Use Defense). The Board *sua sponte* struck the Use Defense, and in so doing, the Board modified the Registrant's First Amended Answer on the basis that no construction of the Use Defense would warrant Registrant's intended meaning of same. On December 1, 2011, the Board issued its Discovery Conference Summary Order confirming the Board's *sua sponte* action regarding the Use Defense. Registrant received the Board's Discovery Conference Summary Order on December 5, 2011 and contacted Petitioner telephonically on December 6, 2011 to seek Petitioner's written consent to file a Second Amended Answer in response thereto. Petitioner refused to provide such written consent and Registrant filed this Motion on December 7, 2011.

II. LEGAL STANDARD.

The policy of granting leave to amend is a liberal one, and should ordinarily be granted whenever doing so will not unduly delay trial or prejudice the other party. *Microsoft Corp. V. Quantel Business Systems, Inc.*, 16 USPQ2d 1732, 1733 (TTAB 1990). Likewise, FRCP 15(a) reflects an underlying policy that disputes should be

determined on their merits, not on the technicalities of pleading rules, and that leave sought, as the rules require, should be “freely given”. *Foman v. Davis*, 371 U.S. 178, 181-182 (1962).

Additionally, the Board has firmly established that “amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that the entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” *American Optical Corp. V. American Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1970).

There are typically four factors that are relevant to determining whether leave should be granted: (1) whether there has been undue delay; (2) whether the moving party has acted in bad faith or with a “dilatory motive”; (3) whether the amendment would be futile because the claims appear on their face to be frivolous; and (4) whether the non-moving party would be prejudiced by granting leave to amend. *Foman* at 182.

As set forth herein, each of the four factors weigh in favor of granting the leave sought by Registrant.

III. ARGUMENT.

A. Amendment Will Not Prejudice Petitioner.

Petitioner could not possibly be prejudiced by Registrant’s amendment because the issue addressed by Registrant’s amendment, namely the Use Defense, is not a new one. In fact, Registrant included the Use Defense in its original answer. Additionally, Registrant brought this issue up to the Board during the Discovery Conference where the Board found the Use Defense impermissible as to form only, and struck it *sua*

sponte on the basis of such defect. Thus, the purpose of Registrant's Second Amended Answer, as discussed herein, is merely to correct that defect that the Board indicated during the discovery conference, namely that no construction of the Use Defense would warrant the reading Registrant intended thereby. 145

While Registrant's amendment would not force Petitioner to confront any new issues, denying Registrant leave would prejudice Registrant. For example, Registrant may lose its ability to challenge certain aspects of Petitioner's claims, including at least one such aspect that may be dispositive to this matter.

Leave to amend is typically granted even more liberally when the proceeding is still in the discovery stage because this circumstance lessens any potential prejudice that an amendment might otherwise bring. *Microsoft* at 1733-34 (finding that undue prejudice will not result from amendment while the proceeding remains in discovery stage.) Here, Registrant's amendment will not prejudice Petitioner in any regard because this matter is in its very early stages. Indeed, the discovery conference was concluded just over one (1) week before the date of this filing, neither party has served its initial disclosures, and this Motion is the first true motion in this matter. Discovery has only been open for five (5) days, since December 2, 2011, and notably, as explained more fully herein, Registrant acted with swiftness in filing this Motion when the ground for same became objectively apparent.

As such, because Petitioner will not experience any prejudice by entry of Registrant's amendment, this factor weighs in favor of granting Registrant's Motion.

B. Registrant Acted Swiftly.

Registrant has acted swiftly in seeking leave to file the Second Amended Answer, and the Board should grant the Registrant's Motion as this Board has firmly established that the timing associated with a motion for leave to amend a pleading is of paramount significance in determining whether a party would be prejudiced by the entry that amendment. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (*motion to amend permitted when Movant filed prior to opening of petitioner's testimony*); *Microsoft Corp.*, 16 USPQ2d 1732 (*movant acted quickly since proceeding still in discovery period*). Indeed, the Board's Order, to which this Motion is responsive, was issued on December 2, 2011, mailed to Registrant the same day, and received by Registrant on December 5, 2011. On December 6, 2011, Registrant contacted Petitioner to seek Petitioner's written consent to file Registrant's Second Amended Answer in lieu of having to file this Motion. When Petitioner baselessly refused Registrant's request on December 7, 2011, Registrant immediately filed this Motion and thus, acted with the necessary measure of haste in doing so, with the object of expediently addressing this matter.

Further, this Board has established that a motion like Registrant's Motion must be filed when the impetus for such a filing becomes apparent. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008). "A motion for leave to amend should be filed as soon as any ground for such amendment [] becomes apparent. *Id.* In this case, Registrant immediately filed the instant Motion when the grounds for same were provided for in the Board's Discovery Conference Summary Order. The only delay between issuance of the Board's Discovery Conference Summary Order and the filing

of this Motion is due squarely to the delay between the time that Registrant sought Petitioner's written consent to file the Second Amended Answer in lieu of this Motion, and the time that Petitioner took to ultimately deny Registrant's request. Thus, Registrant filed Registrant's Motion when the time was ripe and other reasonable options had been exhausted.

Moreover, even if undue delay is somehow imparted to Registrant, the Board can mitigate any prejudice that may result therefrom by enlarging the discovery period pursuant to, for example, Petitioner's motion for same, which Registrant would consent to. *Microsoft*, 16 USPQ2d at 1733-34.

As such, because Registrant acted swiftly and timely in seeking leave to amend via this Motion, this factor also weighs in favor of granting Registrant's Motion.

C. Amendment Will Not Be Futile.

The amendment that Registrant seeks in this instance will by no means be futile in any regard. It is established that "[i]f the underlying facts or circumstances relied upon by a [party] may be a proper subject of relief, he ought to be afforded an opportunity to test his claim on the merits." *Foman*, 371 U.S. at 182. Here, the Second Amended Answer, being responsive to the Board's Order (as discussed herein), seeks to clarify a basis that Registrant may assert as a ground for filing a dispositive motion, namely, the Use Defense. Thus, even if the purpose of Registrant's Motion were less impactful, reason would still exist to grant Registrant's Motion because the affirmative defense that Registrant seeks to clarify is well-established by the trademark laws and the case law interpreting such laws, and most significantly, supported by undisputed facts in this matter.

Moreover, even if Registrant's proposed amendment was not filed with the purpose of correcting a defect previously cited by this Board, as it presently is, this Board may still grant Registrant's Motion since, at minimum, the Second Amended Answer "may serve simply to amplify allegations already included in the [Registrant's] pleading." TBMP § 507.02. which in this case, Registrant asserts that it does, at minimum.

As such, because Registrant's amendment will not be futile by any means, this factor also weighs in favor of granting Registrant's Motion.

D. Registrant Acted In Good Faith and With No Dilatory Motive.

Registrant has acted only in good faith and with no dilatory motive, not only with respect to this issue specifically, but throughout the short duration of this matter in general. As mentioned, Registrant's Motion is sought only for the purpose of correcting a form-based defect in the First Amended Answer, and even then only because of a single affirmative defense that the Board determined during the discovery conference did not allow for the construction that Registrant intended thereby. In fact, Registrant's amendment, if granted, will likely have the effect of accelerating the resolution of this matter.

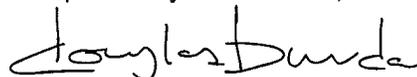
As such, because Registrant acted in good faith and Registrant's amendment will serve to facilitate resolution of this case, this factor also weighs in favor of granting Registrant's Motion.

IV. CONCLUSION.

For all of the forgoing reasons, Registrant respectfully requests that the Board grant Registrant's Motion and accept and enter the Second Amended Answer.

December 7, 2011

Respectfully submitted,



Douglas Burda
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Email. dbb@konceptlaw.com
Attorney & Registrant

EXHIBIT 8

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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

-
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 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 to 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, nor 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 a cost of \$1.00 to him. There may be dozens if not hundreds of 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 jeopardises 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

EXHIBIT 9

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

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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.¹ 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.

¹ 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).² 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.

² TBMP §106.02 (3rd 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."

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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.³ If the call does not result in agreement, the parties then may move the Board to settle the dispute.⁴ 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

³ 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.

⁴ 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.⁵ 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

⁵ 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.