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

Proceeding	92055641
Party	Plaintiff The Port Authority of New York and New Jersey
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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The Port Authority of New York and New Jersey,	:	
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Petitioner,	:	
	:	
v.	:	Cancellation No. 92055641
Yitzhak Birnhack,	:	
	:	
Registrant.	:	
	:	
-----X	:	

**PETITIONER’S REPLY TO RESPONSE TO  
NOTICE OF DEFAULT AND ORDER TO SHOW CAUSE**

Petitioner, The Port Authority of New York and New Jersey (“Petitioner”), via its counsel, submits this reply in response to Rabbi Birnhack’s Response to Notice of Default and Order to Show Cause (Birnhack’s “Response”).

**BACKGROUND**

On May 21, 2012, Petitioner filed a Petition to Cancel (the “Petition”) U.S. Registration No. 3,244,713 for E-ZPASSPORT (Stylized) (the “Registration”) owned by Yitzhak Birnhack, the registrant of record as of such date. Petitioner timely served Mr. Birnhack and his attorney of record at the addresses for each indicated in the Registration record. The Trademark Trial and Appeal Board (“TTAB”) issued an order on May 22, 2012 (the “Order”) setting a July 1, 2012 deadline (the “Answer Deadline”) for Mr. Birnhack’s Answer to the Petition. However, no Answer was filed by the Answer Deadline. Consequently, on July 24, 2012, the TTAB issued a Notice of Default (the “Notice”) ordering Mr. Birnhack to show cause within thirty (30) days why a default judgment should not be entered in this proceeding. On August 23<sup>rd</sup> — the last day

of the 30 day period set by the TTAB to respond to the Notice (the “Response Deadline”) — a Response and proposed Answer were filed by Rabbi Birnhack, the purported current owner of the Registration by an assignment executed on August 20, 2012 (the “Assignment”).<sup>1</sup> For the reasons set forth below, the TTAB should enter a default judgment in this proceeding, as neither Yitzhak Birnhack nor Rabbi Birnhack has shown good cause for the failure to timely file an Answer in this proceeding.

### ARGUMENT

It is well established that a registrant must demonstrate good cause to discharge a notice of default, by making a showing that: (1) the delay in filing is not the result of willful conduct or gross neglect; (2) the delay will not result in substantial prejudice to the opposing party; and (3) the defendant has a meritorious defense. *See DeLorne Publishing Co., Inc. v. Eartha’s, Inc.*, 60 U.S.P.Q.2d 1222 (TTAB Nov. 2, 2000); Fed. R. Civ. P. 55(c). As explained below, neither Yitzhak Birnhack nor Rabbi Birnhack has made any such a showing, and therefore the TTAB should not permit the Answer to be filed outside of the Answer Deadline, and should issue a default judgment.

First, as evidenced by the PTO records for the Registration and the August 20th Assignment, at the time the Petition was filed and the Answer was due to be filed, Yitzhak Birnhack was the owner of the Registration. Significantly, Yitzhak Birnhack has not filed **any** response setting forth the reason why he failed to file an Answer, presumably because he had no plausible excuse and had simply decided not to respond to the Petition. Rather, it is Rabbi Birnhack — who was **not** the owner of the Registration at the relevant time and only recently

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<sup>1</sup> The August 20 Assignment was filed with the U.S. Patent and Trademark Office (“PTO”) on August 23, 2012 and recorded at Reel 4848/Frame 0112. As noted in the Response, the assignee, Rabbi Birnhack, is Yitzhak Birnhack’s father. *See Response*, at pg. 2.

was assigned the Registration just three days prior to the August 23<sup>rd</sup> Response Deadline — who submitted the Response (without any affidavit or statement from Yitzhak Birnhack).

Second, like Yitzhak Birnhack, Rabbi Birnhack has not provided any reason whatsoever for the default. Notably, Rabbi Birnhack does not deny that Yitzhak Birnhack timely received the Petition and Notice and was aware of the Answer Deadline, or that Yitzhak Birnhack timely transferred such documents to Rabbi Birnhack. Rather, Rabbi Birnhack merely makes vague assertions regarding addresses on the PTO record. These assertions, tellingly, fall far short of providing any reason for the delinquency, and are never alleged to have had any impact on the service of Yitzhak Birnhack. Indeed, it is clear that Yitzhak Birnhack received the Petition and Order, which were both mailed to Yitzhak Birnhack's address on record at the PTO (the "Record Address"), since the TTAB's subsequent Notice (which was also sent to the Record Address), was responded to by the Response Deadline.

Specifically, Rabbi Birnhack asserts, "[a]s indicated in Petitioner's Notice of Ineffective Service filed on June 19, 2012, and also noted in the OSC, a mailing address utilized in the E-ZPASSPORT Registration was outdated." (emphasis added). The "outdated" address to which Rabbi Birnhack's statement refers is clearly the counsel of record's address (which was the subject of the Notice of Ineffective Service and OSC statement referenced therein). However, the issue with counsel's address had no impact on Yitzhak Birnhack's notice of the proceeding, since Petitioner also sent the Petition, and the TTAB sent the Order, to Yitzhak Birnhack's Record Address, and neither received any "undeliverable" message or other indication that such address was incorrect.<sup>2</sup> Petitioner's service of the Petition and the Board's service of the Order,

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<sup>2</sup> Rabbi Birnhack's contention that the TTAB and Petitioner indicated that a mailing address was "outdated" is simply inaccurate. Rather, the TTAB and Petitioner noted that, while the mail addressed to Yitzhak Birnhack's counsel of record was returned, the mail addressed to Yitzhak Birnhack was NOT returned, and therefore service was effected.

both on Yitzhak Birnhack at the Record Address, were clearly sufficient to provide notice of the proceeding and his duty to answer. *See* 37 CFR § 2.111(b).

Rabbi Birnhack also nebulously notes that “Registrant’s mailing address had also changed” (without providing any evidence or indicating when such change occurred) and that the Registration was assigned. *See* Response at 2. Notably, Rabbi Birnhack does not at all suggest that these changes had any effect on service of the Petition or Order whatsoever. In any event, the Assignment is entirely irrelevant to the delay in filing the Answer, since any address change associated with the Assignment occurred months after the Petition and Notice were issued. At the time both papers were served, they were properly directed to the Registrant of record at the Record Address. Further, even assuming, *arguendo*, that Yitzhak Birnhack’s address had changed, he had a duty to update this information with the PTO, which he did not do. *See* TMEP 609.03 (“The owner of an application or registration has a duty to maintain a current and accurate correspondence address. If the correspondence address changes, the PTO must be promptly notified in writing, preferably through TEAS”); 37 C.F.R. §2.18(b)(1). Consequently, any issues with the mailing addresses are solely attributable to Yitzhak Birnhack’s negligence and failure to comply with PTO rules rather than any error by Petitioner.

Third, any suggestion that the Petition and Notice were not timely received by Yitzhak or Rabbi Birnhack is belied by the timing of the Assignment — just three days before the Response Deadline and, conveniently, to his father — and the recording of the Assignment and filing of the Response on the very day of the Response Deadline. Indeed, the timing of these actions indicate that the Assignment was nothing more than a transparent attempt to avoid a default judgment by deflecting attention away from Yitzhak Birnhack’s neglect and obfuscating the underlying reason for the default. Nonetheless, Yitzhak Birnhack cannot escape the simple fact that he had

notice of the Answer Deadline, and failed to provide any excuse whatsoever for his failure to act. Such conduct points to the conclusion that the default was either willful or due to gross neglect.

Additionally, neither Yitzhak nor Rabbi Birnhack have established, or even addressed, the other factors necessary to show “good cause” under Federal Rule of Civil Procedure 55(c), i.e., that the delay will not result in substantial prejudice to Petitioner, and that Rabbi Birnhack has a meritorious defense. Consequently, because Petitioner cannot demonstrate the requisite “good cause,” the TTAB should enter a default judgment in this proceeding.

### CONCLUSION

For the reasons set forth above, the TTAB should issue a default judgment against Registrant.

Respectfully submitted,

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Attorneys for Petitioner

Date: September 5, 2012

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**CERTIFICATE OF SERVICE**

I hereby certify that on September 5, 2012, I caused one true and correct copy of the foregoing Petitioner's Reply to Response to Notice of Default and Order to Show Cause to be served by first class mail upon Registrant Rabbi Birnhack by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Registrant's counsel of record as follows:

Jonathan W. Brown, Esq.  
Lipsitz Green Scime Cambria LLC  
42 Delaware Avenue, Suite 120  
Buffalo, NY 14202

Date: September 5, 2012

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