

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: March 30, 2016

Cancellation No. 92061981

Kosher Supervision Service, Inc.

v.

Yoel Steinberg

George C. Pologeorgis,
Administrative Trademark Judge:

This proceeding now comes before the Board for consideration of the following outstanding motions: (1) Respondent's motion (filed September 1, 2015) to extend his time to answer the petition to cancel by ninety days; (2) Respondent's motion (filed September 11, 2015) to strike certain allegations set forth in the petition to cancel; (3) Petitioner's motion (filed December 2, 2015) to amend its pleading to correct a typographical error of Petitioner's name in its pleading; and (4) Respondent's motion (filed December 11, 2015) for sanctions under Fed. R. Civ. P. 11.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to each motion.

Respondent's Motion to Strike

The Board first turns to Respondent's motion to strike. In support thereof, Respondent argues that Paragraph 6 of the petition to cancel and the allegations

contained therein should be stricken on the grounds that wording “stringent standards for certifying that goods meet the highest standards of Kosher law” contained in Paragraph 6 of the pleading does not form a basis for a permissible cause of action as it refers to a Doctrine of Religion that is not legally or even religiously definable, and therefore both impermissible and insufficient as a cause for claim. Additionally, Respondent maintains that, if these allegations are not stricken, the Board would be put in the position of applying religious doctrine and determining matters of religious law. Finally, Respondent argues that if these allegations are not stricken the Board effectively would be allowing religious doctrine into the record of a federal proceeding as a cause for complaint and therefore would be encouraging an institution of religion in violation of the First Amendment of the U.S. Constitution.

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See* Fed. R. Civ. P. 12(f).

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* § 1380 (1990).

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See* TBMP §§ 309.03 and 311.02 (2015). Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense.

The allegations in the petition to cancel which are subject to Respondent's motion to strike are found in Paragraph 6 of the petition to cancel which reads as follows:

By reason of third parties' extensive promotion, advertising and provision of high-quality goods in connection with Petitioner's marks for over 40 years, the public and the trade have come to recognize goods offered in connection with Petitioner's Marks as signifying Petitioner and its stringent standards for certifying that goods meet the highest standards of Kosher law.

Following a careful review of Paragraph 6 of the petition to cancel, the Board finds that the allegations asserted therein are not conclusions of law unsupported by evidence nor do they constitute immaterial, impertinent, or scandalous matter, but rather are allegations that serve as a factual foundation for the legal claims asserted by Petitioner in its petition to cancel, namely, likelihood of confusion and dilution. Respondent's argument that these allegations in some way support a basis for an impermissible claim other than those specifically pleaded in Petitioner's petition to cancel is without merit. Here, Petitioner has asserted only two grounds for cancellation: (1) likelihood of confusion, and (2) dilution. Petitioner has not asserted any standalone claim for cancellation based on any religion. Moreover, in making any final determination of the merits of Petitioner's claims, the Board will

not be determining matters of religious law nor will the Board be encouraging the institution of any religion in making its final determination of the merits of Petitioner's claims, as argued by Respondent. Indeed, the Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007).

Because the Board finds that the allegations in Paragraph 6 of Petitioner's pleading merely forms a factual foundation of its asserted claims and provides fair notice of such claims, Respondent's motion to strike these allegations is **DENIED**.

Petitioner's Motion to Amend the Pleadings

The Board next turns to Petitioner's motion for leave to amend its pleading. In support of its motion, Petitioner requests that Kosher Supervision Services Inc. be removed from the record as party plaintiff and that its pleading be amended to reflect such removal. Specifically, Petitioner contends that (1) Kosher Supervision Services Inc. and Kosher Supervision Service, Inc. are the same entity, (2) Kosher Supervision Services Inc. was the owner name listed on Petitioner's pleaded Registration No. 927067 at the time the petition was filed, but this name contained a typographical error, (3) to correct this error, a *nunc pro tunc* assignment effective December 2, 2003, of Petitioner's pleaded Registration No. 927067 to Kosher Supervision Service, Inc. was filed and recorded on November 12, 2105.

Section 503.06(b) of the Trademark Manual of Examining Procedure provides that “[i]f there is a typographical error in the recorded assignment document (or other document affecting title) rather than in the cover sheet, the party responsible for the erroneous document (e.g., the assignor) must either record a new document with the Assignment Recordation Branch or make corrections to the original document and re-record it.

In this instance, the Office’s Assignment Branch records indicate that the original owner of Petitioner’s pleaded registration, Harvey Senter d/b/a Kosher Supervision Service, originally assigned all rights, title and interest in the pleaded registration to Kohser Supervision Services Inc. on December 2, 2003. Because the recorded assignment purportedly contained a typographical error of the assignee’s name, the assignor, pursuant to Office rules and procedure, recorded a new assignment to correct the typographical error of the assignee’s name from Kosher Supervision Services Inc. to Kosher Supervision Service, Inc. The Board notes that the original assignment and the corrected assignment were both notarized.

Because the purported typographical error was corrected pursuant to appropriate Office procedure, Petitioner’s motion to amend its pleading is **GRANTED** and Petitioner’s petition to cancel filed on August 8, 2015 is deemed amended to reflect that Kosher Supervision Service, Inc. is the sole plaintiff in this matter.¹

¹ The Board notes that a filing fee for two petitioners was submitted at the time the petition to cancel was filed. The Board can only assume that a filing fee for two petitioners was filed because the corrective assignment of the pleaded registration had not yet been recorded with the Office at the time the petition for cancellation was filed.

Respondent's Motion for Rule 11 Sanctions

Turning now to Respondent's motion for sanction, the Board notes that the crux of Respondent's motion for sanctions concerns the manner in which Petitioner has sought to correct a purported typographical error in its pleaded registration and Petitioner's motion to amend its pleading to reflect the correction. That being said, the Board finds that Respondent's motion for sanctions, based on Rule 11 of the Federal Rules of Civil Procedure, does not indicate that Respondent complied with the safe harbor provision of the rule. *See* Fed. R. Civ. P. 11(c)(1)(A). Accordingly, the motion is procedurally premature and, therefore, will be given no further consideration. Even if Respondent had complied with the safe harbor rule or if Respondent's motion was not brought under Fed. R. Civ. P. 11, the Board finds, based upon the current record, that neither Petitioner nor its counsel has undertaken any action during the course of this proceeding thus far that would warrant the imposition of any sanctions. Accordingly, the Board finds that Respondent's motion, whether filed under Fed. R. Civ. P. 11 or not, is without merit and has been given no consideration.²

Respondent's Motion to Extend

Respondent's motion to extend is **GRANTED** as conceded but only to the extent noted below. Respondent originally requested a ninety-day extension of time to file an answer or otherwise respond to Petitioner's petition to cancel. In light of the time

² To the extent Respondent's motion for sanctions concerns the validity of the assignment of Petitioner's pleaded registration, the appropriate procedure would be to file a counterclaim against Petitioner's pleaded registration pursuant to an appropriate and sound legal basis and not a motion for sanctions.

that has transpired since the filing of Respondent's motion to extend, the Board finds that Respondent has now had ample time to review Petitioner's pleading and to formulate a response thereto. Accordingly, Respondent is allowed until **April 29, 2016** in which to file an answer to the petition to cancel.³

The petition to cancel filed by Petitioner consists of 23 paragraphs setting forth the basis of Petitioner's claim of damage. In accordance with Fed. R. Civ. P. 8(b), which is made applicable to this proceeding by Trademark Rule 2.116(a), it is incumbent on Respondent to answer the petition to cancel **by specifically admitting or denying the allegations contained in each paragraph. If Respondent is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, he should so state and this will have the effect of a denial.**

As a final matter, it appears from Respondent's filings to date that Respondent is not familiar with Board practice and procedure or the federal rules of civil procedure. Accordingly, the Board reiterates its suggestion that Respondent attempt to retain competent trademark counsel to represent him in this matter. Notwithstanding, in light of the nature of Respondent's filings, Respondent is ***precluded*** from filing any further ***unconsented*** motions in this matter without first: (1) contacting both counsel for Petitioner and the assigned interlocutory attorney to coordinate a mutually agreeable time for the Board and the parties to

³ The Board has *sua sponte* reviewed Petitioner's pleading and finds that Petitioner has adequately alleged its standing, as well as its asserted grounds for cancellation, i.e., likelihood of confusion and dilution. Accordingly, Respondent is ***precluded*** from filing a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6) in response to Petitioner's pleading.

participate in a telephone conference to address the basis for any unconsented motion proposed by Respondent; (2) participating in such a telephone conference; and (3) receiving the Board's approval to file any proposed unconsented motion. *See Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) (“[T]he Board possesses the inherent authority to control the disposition of cases on its docket.”). If Respondent fails to comply with this mandate, sanctions may be entered against him, including the entry of judgment. *See id.*; *see also NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1038 (TTAB 2014) (acknowledging the Board's inherent authority to control the disposition of cases on its docket, including the inherent authority to enter sanctions).

Trial Schedule

Proceedings herein are resumed. Trial dates are reset as follows:

Time to Answer Petition to Cancel	4/29/2016
Deadline for Discovery Conference	5/29/2016
Discovery Opens	5/29/2016
Initial Disclosures Due	6/28/2016
Expert Disclosures Due	10/26/2016
Discovery Closes	11/25/2016
Plaintiff's Pretrial Disclosures Due	1/9/2017
Plaintiff's 30-day Trial Period Ends	2/23/2017
Defendant's Pretrial Disclosures Due	3/10/2017
Defendant's 30-day Trial Period Ends	4/24/2017
Plaintiff's Rebuttal Disclosures Due	5/9/2017
Plaintiff's 15-day Rebuttal Period Ends	6/8/2017

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.