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

Proceeding	92061981
Party	Defendant Yoel Steinberg
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Kosher Supervision Services, Inc.

Petitioner

v.

Yoel Steinberg  
D/B/A CupK Kosher Supervision

(*pro se*) Registrant/Respondent

Cancellation No. 92061981

**Respondent's Motion for Reconsideration  
of Board Order, March 30, 2016  
(with approval of the Board for  
unconsented motion)**

**RESPONDENT'S MOTION for RECONSIDERATION of DECISION on MOTION**

With approval of the Board: On March 30, 2016, The Board ordered that I be precluded from filing uncontested motions unless certain conditions would be met. And that failure to comply with the order would mandate sanctions. The Board exercised this discretion based on its assessment of whether I am familiar with FRCP and other Board procedures. The Board cited its inherent authority to control the disposition of cases on its docket. (The Board also issued other orders which will soon be addressed).

**GROUND FOR RECONSIDERATION**

The Board is respectfully implored to reconsider that exercise of discretion. Although I greatly appreciate and politely acknowledge the time and great patience which the Board has and would be providing during phone conferences, the Board upon reconsideration might find the mandate of sanctions for non-compliance to be unnecessarily harsh, and counterproductive in the balance of the Board's objective of conducting fair and equitable proceedings. The ends sought by the Board to control its docket might have been more effectively achieved by less severe remedies, such to simply not note any unconsented motions which are not preceded by a phone conference as set out by the Board. Alternatively, the Board on its own might find other

feasible solutions, (such as my obtaining guidance of a supervising attorney during the interim until I might find full counsel).

Additionally, since the time to Motion for reconsideration is limited, I ask that the Board at least note within the order itself that to the extent the order precludes me from uncontested motions, the order will be subject to review, so that I may seek Board approval to request reconsideration even at a later date if the Board were to approve.

The Board at phone conference seems to have also communicated (though not ordered) to the effect that I should take ‘only one bite at the apple’ [paraphrase not a quote] in requesting a conference. This would give Petitioner an uneven advantage in that when Petitioner motions in writing, it would be allowed to re-state its grounds by amending its briefs up to the accordingly allotted periods. -Whereas I would not be given opportunity to ‘amend’ my requests to seek further approval once the call is over. I am also particularly concerned that even when I am not filing a motion, or even when I am complying with a Board order, or otherwise acting not of my own initiative, that my words or even a typographical error might be construed as raising an unapproved motion upon which the Board would issue sanctions. I therefore humbly request that the Board reconsider.

### **Further Matter and Grounds for Motion to Reconsider**

During the phone conference the Board graciously invited me to bring to Board’s attention where it may have erred on the law. I accordingly proceed with all due respect to note as follows:

#### **Grounds for reconsideration of Order granting Motion to Amend:**

The Board did not consider the record before it. And considered what was not before it:

#### TIMELINE OF EVENTS

I. At telephone conference, The Board communicated that when it issued the order, it was unaware of the full record of timeline of events -particularly that the date of fifth year anniversary of the registration of my mark had already past prior to the execution date of the second assignment and its conveyance. (It would also seem from the context of the order that the Board did not consider the timeline of events on record). The date of Registration for my mark is on record as August 10, 2010. Neither Harvey Senter d/b/a/ Kosher Supervision Services (the purported

original owner of the Registration, and Assignor of the first and second assignment), nor Senter d/b/a Kosher Supervision Services Harvey (the purported Assignor for the second assignment) were ever added as a Petitioner. As of August 11 2015, Both Harvey Senter d/b/a/ Kosher Supervision Services and Senter d/b/a Kosher Supervision Services Harvey were no longer entitled to petition against my mark, They had had lost the right to sue. And they could no longer convey the right to sue or petition against my mark to anyone else.

Reel/frame 5667/0312, as well as reel/frame 5667/0314, of the USPTO Assignment data records show that Nov 6, 2015 was the date of the purported execution of conveyance for the (second) assignment, which is when the rights to sue based on the pleaded registration were purportedly conveyed to the Assignee. However at that date, the Assignor himself was no longer able to sue against my mark. As it comes out, even if the purported Assignment recorded on Nov 12, 2015 were to be authentic and valid, the conveyance of record would not have conveyed rights to petition against my mark. Petitioner Kosher Supervision Service, Inc. [with comma in singular, and Inc.], never received right's to sue against my mark from either of Harvey Senter d/b/a/ Kosher Supervision Services, or Senter d/b/a Kosher Supervision Services Harvey.

In reconsideration of these previously overlooked facts of the record which were before it, The Board might therefore find justified to reconsider whether Petitioner Kosher Supervision Service, Inc. was ever entitled to sue or petition against my mark based on the pleaded Registration. So that the Board may find that this petitioner may not plead the Registration on the petition against my mark, And that the petition may therefore not be amended to reflect that petitioner as pleading the Registration. (Timeliness and Assignment records were placed before the Board as stated in Opposition brief dated 12/15/2015, page 1,2, and other briefs and replies including page 6 and 7 of 12/11/2015 Motion to Strike with that motion referenced by brief *ibid* page 3. The order itself also addressed the Assignment data).

Even Before Counterclaim is Filed: Significantly, the issue of whether or not a valid assignment has been recorded prior to the fifth year anniversary of the registration of my mark, is relevant to denying Motion to amend -even if a counterclaim wasn't filed yet. It is not necessary to cancel the pleaded registration to deny the Motion to amend. What's at issue here is not whether Petitioner presently owns the mark's Registration, but rather whether Co-petitioner Kosher Supervision Service, may file a petition against my mark as an owner of the pleaded registration. - And particularly, whether the Assignor himself was still able to file a petition against my mark at the date the

assignment was executed.

II. Similarly, in footnote 1, page 5, The Board writes:

*“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”*

[my emphasis added]. Just as the Board finds that the required assignment had not yet been filed on Aug 7 2015 when the petition was filed, so too might the Board find that the required assignment of the pleaded registration had not yet been filed on Aug 11, 2015 -which is subsequent to the 5 year anniversary of the registration date of my mark. In reconsideration of this overlooked record, the Board may conclude that Kosher Supervision Service, Inc. should NOT be added as a petitioner to plead the Registration –even subsequent to a purported assignment having been recorded.

New versus Corrective:

III. In page 5 of the order, The Board writes *“the Office’s Assignment Branch records indicate that ... Harvey Senter ... originally assigned ... 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, ...”* [my emphasis added, ellipses removed].

And based on that presumed reading of the record, the Board concluded that,

*“Because the purported typographical error was corrected pursuant to appropriate Office procedure, Petitioner’s motion to amend its pleading is GRANTED”* [my emphasis added].

However, I politely remind the Board the record actually does say KOSHER. The order as formulated indicates that the Board erred in its reading of the record -that the original assignment purportedly contained a typographical error which was later corrected. The record does not show that the original assignment was ever pleaded or declared to be in error. There is no any error apparent within the spelling of the name as previously recorded. And even Petitioner has not specified what exactly is the purported error within the original assignment. Petitioner merely contends there is a typographical error, but does not plead nor declare there is an error. Neither does Petitioner state what was

intended to be typed. The Board should not have considered Mr. Friscia's footnote comments within the petition as if they are validly pleaded, or declared. And even those comments are not sufficient. Similarly, the Board should not have considered Mr. Friscia's undeclared assertions that the two petitioners are the same entity.

This is relevant because the later assignment was not filed on record as corrective but rather as new, with its own new conveyance for \$10 (Reel/Frame05667/0314) on 11-6-2015. Whereas Reel/Frame 2788/0359 shows the original conveyance was for \$1 on Dec. 2 2003. And that had the Assignor decided to at the time, he could have declined to convey any rights to the assignee. Even if the later assignment were to be valid, and even if it were nunc pro tunc, the fact still remains that, Kosher Supervision Service, Inc. was never conveyed the rights to sue against my mark. Furthermore, when the petition was filed and served to me, Kosher Supervision Service, Inc. was neither the valid owner, nor the owner of record, of the pleaded registration, And was not so at any time prior to the passing of the five year anniversary of the registration of my mark. -So that any subsequent amendment would NOT be timely.

IV. Additionally, I humbly and politely bring to the Board's attention that the date from the future listed in the order on bottom of page 4 given as 2105, further seems to indicate that the Board's interpretation of the record –at least as reflected by the order- did not consider that which actually shows on reel/frame 5667/0312.

Error In applying the Law, TBMP 503.06(b):

V. The Board quoted 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. [my emphasis added]*

With all due respect, and with my full and most humble apologies if I am incorrect, a simple reading of TMEP 503.06(b) indicates that a corrective assignment (e.g. “make corrections” “and re-record it”) is an alternative procedure to a new assignment (“record a new document”), but not that a new assignment “corrects” a previous assignment. The order as formulated seems to say that the Board believed the “new assignment” functioned to “correct” the previous assignment. The order is ambiguous as to which procedure outlined in TBMP 503.06(b) the Board believes was followed by Petitioner. As indicated above, this matter might be very relevant in determining the

merits or lack thereof of Petitioner's Motion to amend, and to Petitioner's claim in general. In reconsideration of the record before it, and for the sake of judicial economy, so that this issue need not be continually revisited, the Board might find it justified to clarify the Order to note that the second assignment was not corrective, And that the second assignment did not amend nor even refer to the purported conveyance recorded in the first assignment.

**Relevant Authorities:  
TBMP 518**

**37 C.F.R. §3.73(b)(1)** which requires the Assignment data to have been presented.

37 C.F.R. §3.73(b) states in part:

*(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either: (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to §3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. ... ; or (ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).* [emphasis added, ellipses removed].

**TBMP 307.02 Petition That Must Be Filed Within Five Years from the Date of Registration**

**TBMP 303.06 Joint Opposers or Petitioners**

*Two or more parties may file an opposition or a petition for cancellation jointly. However, the required fee must be submitted for each party joined as opposer or petitioner for each class in the application for which registration is opposed or for each class in the registration for which cancellation is sought. When parties file jointly, the notice of opposition or petition for cancellation must name each party joined as plaintiff. In addition, the notice of opposition or petition for cancellation should include allegations concerning the standing of each party plaintiff and the ground or grounds for opposition or cancellation.*

*[Note 29] See Custom Computer Services, Inc. v. Paychex Properties, Inc., 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (entity named in extensions was not a "different existing legal entity" from entity that filed opposition) and Cass Logistics Inc. v. McKesson Corp., supra at 1077 (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). See also TMEP § 1503.04. [emphasis added].*

Rule 15 of FRCP and the notes regarding "relating back".

**Grounds for Reconsideration of Additional Matter Within the Order:**

VI. In regard to footnote 3 page 7 of the order, which pre-emptively precluded me from motioning pursuant to Rule 12(b)(6) of FRCP, even without my being able to present the merits of such motion before the Board:

The Board has not noted that this would be due to my having previously Motioned to Strike. If I may presume,

this is because Rule 12(g)(2) of FRCP would not necessarily preclude another motion under rule 12. “Limitation on Further Motions. *Except as provided in Rule 12(h)(2) or (3), a party that makes a motion under this rule must not make another motion under this rule raising a defense or objection that was available to the party but omitted from its earlier motion.” [emphasis added]. And that if not for footnote 3 of the order, I would be able to motion to dismiss pursuant to Rule 12(b)(6). The footnote (if it is an order) unfairly and preemptively denied me of the right to fairly defend my case. I ordinarily would be given time to research the merits of a motion to dismiss and raise that motion at least until the date that my answer/plea will be submitted.*

Therefore, to the extent the footnote of the order precludes motioning on FRCP 12(b)(6), the Board might find it fair to at least modify it to allow me to raise the Motion after seeking preapproval as the Board may see fit. To the extent that it is not an order, I respectfully request that the footnote be modified in my favor. To the extent it is an order, I respectfully request that it be modified in my favor and noted as an order. This ambiguity in communication prejudices my position in that it is not fair to be precluded from motion based on FRCP 12(b)(6), yet at the same time be held liable for not having motioned it. I reserve the rights to plea the merits within my defenses. And if the Board will allow, I reserve the right to Motion on it. I also respectfully request the right to request additional phone conferences.

Out of prudence, I refrain from revealing within this brief the merits which I might present within a motion to dismiss. But even without noting any merits, in light of "While Opposer argued that the TTAB was required to take its pleaded allegations as true, the TTAB held that this was not the case where the allegations were contradicted by the PTO records, and, therefore the TTAB granted applicant's motion to dismiss for failure to state a claim". (-See 89 U.S.P.Q.2d 1251 (T.T.A.B. 2009) and id at 1256). ” and in reconsideration of the true record before it, the Board might find it fit to reformulate the order in terms more favorable toward myself.

### CONCLUSION

**In conclusion:** In light of all the above, I motion that the Board reconsider its order dated March 30, 2016, to modify the order to terms more favorable toward myself: So that In regard to the order precluding me from raising an uncontested motion, the Board will reverse the order, or at least modify the order, to terms more

favorable toward myself as stated above. And that in regard to the order granting Motion to amend, that the Board will reconsider its order granting such motion, to instead DENY the Motion to Amend, so that Kosher Supervision Service, Inc. will not be listed as a plaintiff or Petitioner in regard to the pleaded Registration of these proceedings. And in regard to remaining portions of the order, I further respectfully request that the order be re-evaluated and altered as stated above, and as the Board may find fit to do so in my favor.

Respectfully submitted,

Dated April 15, 2105

By: Yoel Steinberg  
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Phone (718) 232-4275  
(*pro se*) Registrant / Respondent

[Miscellaneous: I reserve the right to any and all Denials, Defenses, Counterclaims, Motions (when allowed), as well as all other rights. This includes but is not at all limited to counterclaims of fraud and affirmations of unclean hands. Statements or omissions within the foregoing brief should not be construed as any concession, waiver, acquiescence, or as anything else not to my favor.]

CERTIFICATE OF SERVICE UNDER 37 CFR §§ 2.111

I hereby certify that the foregoing Respondent's Motion for Reconsideration of Decision on Motion, in regard to the Proceedings of Cancellation No. 92061981, has been served via first class mail upon Petitioner on April 15, 2015, at Petitioner's address as reflected in the records of The United States Trademark Office as follows:

MICHAEL R FRISCIA  
MCCARTER & ENGLISH, LLP  
FOUR GATEWAY CENTER, 100 MULBERRY STREET  
NEWARK, NJ 07102-4056 UNITED STATES

Date: April 15, 2015

Yoel Steinberg