

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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GCP

Mailed: June 1, 2016

Cancellation No. 92061981 (**Parent Case**)

Cancellation No. 92062710

*Kosher Supervision Service, Inc.*

v.

*Yoel Steinberg d/b/a CupK Kosher  
Supervision*

**By the Trademark Trial and Appeal Board:**

It has come to the Board's attention that the above-captioned cancellation proceedings involve common questions of law and fact and the parties are the same. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also, Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Accordingly, the Board, *sua sponte*, orders the consolidation of the above-captioned proceedings.

In view thereof, Cancellation Nos. 92061981 and 92062710 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file for these consolidated cases will be maintained in **Cancellation No. 92061981** as the "**parent**" case. As a general rule, from this point on only a single copy of any paper or motion should be filed in the parent case of the consolidated proceedings, but that copy should bear both cancellation proceeding numbers in its caption. **The only exception is that the answer to each petition to cancel must be filed in the respective corresponding proceeding.**

The parties are further advised that despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file.<sup>1</sup>

In accordance with Board practice, discovery, disclosure and trial dates are reset to conform to the dates latest set in the proceedings that are being consolidated. In this instance, however, the Board notes that there is a pending motion for reconsideration filed by Respondent in Cancellation No. 92061981 and a pending combined motion to dismiss and to strike filed by Respondent is Cancellation No. 92062710. Additionally, the Board will address Respondent's answer and

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<sup>1</sup> The parties should promptly inform the Board in writing of any other related *inter partes* proceedings. See Fed. R. Civ. P. 42(a).

counterclaim filed in Cancellation No. 92061981. The Board now turns to each of the foregoing.

**Respondent's Motion for Reconsideration in Cancellation No. 92061981**

On April 15, 2016, Respondent filed a motion for reconsideration of the Board's March 30, 2016, order issued in Cancellation No. 92061981.<sup>2</sup> Specifically, Respondent seeks reconsideration of the following rulings set forth in the Board's March 30, 2016, order:

- (1) the Board's requirement that Respondent obtain prior Board approval before filing any unconsented motions in Cancellation No. 92061981;
- (2) precluding Respondent from filing a motion to dismiss for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6) in Cancellation No. 92061981; and
- (3) the Board's granting of Petitioner's motion for leave to amend its pleading to correct the name of Petitioner.

Respondent's motion for reconsideration is **DENIED** in its entirety for the reasons stated below.

It has often been stated that the premise underlying a request for reconsideration under Trademark Rule 2.144 is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. *See* TBMP § 518 (2015) and authorities cited therein. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978). Rather, the request

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<sup>2</sup> By teleconference held on April 5, 2016 between the parties and the above signed administrative trademark judge, the Board granted Respondent permission to file his motion for reconsideration.

normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate changes. *See Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

First, the Board notes that it possesses the inherent authority to control the disposition of cases on its docket. *See Carrini Inc. v. Carlo Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2000). Pursuant to that authority, the Board may require a party to obtain prior Board approval before filing any unconsented motions in a Board proceeding if the Board believes that a party is unfamiliar with Board practice and procedure and/or the nature of a party's filings demonstrates such unfamiliarity. Respondent does not argue that the Board does not have such authority, which the Board clearly does, but instead requests that this requirement be made more lenient. The Board disagrees in light of the nature of Respondent's filings to date and since Respondent has failed to demonstrate that the Board committed legal error, Respondent's motion for reconsideration of this requirement is **DENIED**.

The Board next turns to the ruling that Respondent is precluded from filing a motion to dismiss for failure to state a claim in Cancellation No. 92061981. In its March 30, 2016, order, the Board noted that it reviewed Petitioner's pleading *sua sponte* and found that Petitioner had adequately alleged its standing, as well as its asserted grounds for cancellation, i.e., likelihood of confusion and dilution. *See* 15 TTABVUE p. 7 fn. 3. Because of this determination, the Board stated that

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. *Id.*

Respondent does not contend that this ruling was legal error nor does Respondent cite to any case law or other legal authority which demonstrates that the Board made legal error in reaching its decision. Instead, Respondent makes reference to Fed. R. Civ. P. 12(g)(2) as a possible reason for not allowing Respondent to file a motion to dismiss under Fed. R. Civ. P. 12(b)(6). The Board notes that it did not base its decision to preclude Respondent from filing a 12(b)(6) motion to dismiss pursuant to Fed. R. Civ. P. 12(g)(2). Rather, the Board reviewed Petitioner's pleading in its entirety and found that Petitioner sufficiently pleaded its standing, as well as its grounds for cancellation. Accordingly, Respondent's motion for reconsideration of the Board's ruling that Respondent is precluded from filing a motion to dismiss under Fed. Civ. P. 12(b)(6) in response to Petitioner's pleading is **DENIED.**

Finally, the Board turns to its decision to grant Petitioner's motion to amend its pleading to reflect the proper plaintiff in Cancellation No. 92061981.

As background, Petitioner, in support of its motion to amend, requested 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 contended 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, 2015.

In its March 30, 2016, order, the Board noted that TBMP § 503.06(b) 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.

The Board further noted that the Office's Assignment Branch records indicated 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 Kosher 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.

Because the purported typographical error was corrected pursuant to appropriate Office procedure, the Board granted Petitioner's motion to amend its pleading to reflect that Kosher Supervision Service, Inc. is the sole plaintiff in Cancellation No. 92061981.

In support of its motion for reconsideration, Respondent improperly reargues the points presented in his brief responding to the motion to amend. Accordingly, such arguments have not been given any consideration. Additionally, Respondent maintains that the Board's order was ambiguous as to which procedure outlined in Section 503.06(b) of the TBMP the Board believes was followed by Petitioner. The Board's order was quite clear on its face. The order noted that the assignor of Petitioner's pleaded registration filed a *nunc pro tunc* assignment correcting the typographical error in the assignee's name under appropriate Office procedure. It appears, however, that Respondent is under the misconception that all rights, title and interest in Petitioner's pleaded registration were conveyed to Petitioner for the first time on the date the corrective assignment was executed. The corrective assignment, however, merely corrected the typographical error in the assignee's name. The conveyance of the rights, title and interest of Petitioner's pleaded registered mark occurred on the date of the original assignment, i.e., December 2, 2003, and not on the date the corrective assignment was executed. As noted above, the corrective assignment was nonetheless a *nunc pro tunc* assignment which means that the action has a retroactive legal effect, as though it had been performed at a particular, earlier date.

In view of the foregoing, Respondent's motion for reconsideration of the Board's granting of Petitioner's motion to amend its pleading is **DENIED**.

In sum, the Board did not err in (1) granting Petitioner's motion for leave to amend its pleading, (2) precluding Respondent from filing a motion to dismiss for

failure to state a claim under Fed. R. Civ. P. 12(b)(6), or (3) imposing a requirement that Respondent obtain prior Board approval for filing any unconsented motions in this case based on the nature of Respondent's filings to date.

Because Respondent has failed to demonstrate that the Board erred in reaching any of the aforementioned findings and/or rulings in its March 30, 2016, decision, Respondent's motion for reconsideration is **DENIED** in its entirety. The Board's March 30, 2016, order stands as issued.

**Respondent's Answer and Counterclaim in Cancellation No. 92061981**

On May 9, 2016, Respondent filed his answer to the amended petition to cancel in Cancellation No. 92061981, as well as various affirmative defenses, amplifications to the denials, and a counterclaim seeking to cancel Petitioner's pleaded Registration No. 927067. Respondent's answer, defenses and counterclaim are **STRICKEN** in their entirety without prejudice for failing to comply with Fed. R. Civ. P. 8 and 11 for the reasons discussed below.

Fed. R. Civ. P. 8(b) provides, in part, as follows:

(b) Defenses; Admissions and Denials.

(1) *In General*. In responding to a pleading, a party must:

(A) state in short and plain terms its defenses to each claim asserted against it; and

(B) admit or deny the allegations asserted against it by an opposing party.

(5) *Lacking Knowledge or Information*. A party that lacks knowledge or information sufficient to form a belief about the truth of an allegation must so state, and the statement has the effect of a denial.

With regard to Respondent's answer to the amended petition to cancel, the Board notes that Respondent does not merely admit or deny the allegations actually asserted in the amended petition to cancel in accordance with Fed. R. Civ. P. 8(b), but also argues the merits of the allegations and/or presupposes allegations that are not actually asserted and either admits or denies these hypothetical allegations.

Additionally, Respondent asserts the following affirmative defenses: (1) the Board lacks jurisdiction to entertain Petitioner's asserted claims, (2) the Board is the improper venue to complain against Respondent's registration, (3) defective service of process because Respondent was not served with the assignment concerning Petitioner's pleaded registration, (4) the petition is untimely, (5) no right to plead the registration, (6) failure to join the assignor of Petitioner's pleaded registration as party plaintiff in this case, and (6) unclear statements.<sup>3</sup> None of these defenses are proper and should not be included in the answer for the reasons discussed, *infra*. Respondent also asserts the defense that Petitioner lacks standing to pursue its case. The Board notes that "lack of standing" is not an affirmative defense. Standing is an element of Petitioner's claims. Petitioner must prove standing as part of its case. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011). Accordingly, lack of standing should not be included as a defense in Respondent's answer.

Additionally, Respondent's Amplification of Denials, i.e., Paragraphs 111-222 of Respondent's pleading, should not be included in his answer because these

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<sup>3</sup> The Board notes that Respondent also asserted the affirmative defenses of laches, acquiescence, estoppel, contractual estoppel, and unclean hands.

allegations merely argue the merits of Petitioner's pleaded claims. An answer to a pleading is not the appropriate vehicle for arguing the merits of a case. Moreover, Respondent's defense that Petitioner's pleading fails to state a claim upon which relief may be granted is also without merit since the Board has already determined that Petitioner has properly pleaded its standing, as well as its asserted grounds for cancellation.

The Board next turns to Respondent's counterclaim. With respect to any pleading, a plaintiff is certifying that, under Rule 11 of the Federal Rules of Civil Procedure, all claims and other legal contentions asserted therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law. *See* Fed. R. Civ. P. 11. Additionally, Rules 8(a)(2) and 8(e)(1) of the Federal Rules of Civil Procedure, require that a claim for relief must include "a ***short and plain statement of the claim*** showing that the pleader is entitled to relief" and that "each averment of a pleading ... ***be simple, concise and direct.***" Fed. R. Civ. P. 8 (emphasis added).<sup>4</sup>

The Board has carefully reviewed Respondent's counterclaim and notes that Respondent's counterclaim consists of approximately thirty-nine pages, with 201 separate paragraphs of allegations, and 17 grounds for cancellation. Clearly, Respondent's counterclaim does not constitute a short and plain statement of the grounds for cancellation nor are each of the averments simple, concise and direct. Moreover, many of Respondent's asserted claims do not constitute proper grounds

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<sup>4</sup> Fed. R. Civ. P. 8 and 11 are made applicable to Board proceedings pursuant to Trademark Rule 2.116(a).

for cancellation. For example, Respondent's asserted grounds that (1) Petitioner's pleaded mark constitutes the usurpation of the English and Hebrew language (Count 2); (2) Petitioner's pleaded registration as formulated is unenforceable (Count 7); (3) Petitioner's pleaded mark falsely suggests a connection with a third-party entity, i.e., the "KofK Congregation," (Count 13); and (4) Petitioner's pleaded mark dilutes marks owned by third-parties (Count 14) are not recognizable grounds for cancellation under the Trademark Act.<sup>5</sup> The Board also notes that Respondent identified on the ESTTA filing cover sheet of its answer and counterclaim the following additional grounds for cancellation: (1) deceptiveness under Section 2(a); (2) the mark is functional under Section 2(e)(5) of the Trademark Act; and (3) misrepresentation of source under Section 14(3) of the Trademark Act. Respondent's counterclaim, however, is devoid of any allegations to support these claims and/or does not sufficiently allege these grounds for cancellation. Respondent's claims that Petitioner made misrepresentations in its pleading (Counts 4 and 5) are also not recognizable grounds for cancellation of Petitioner's pleaded registration. If Respondent believes that certain allegations set forth in Petitioner's pleading are

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<sup>5</sup> The fact that the Board has not addressed the viability of every single ground for cancellation asserted by Respondent in his counterclaim or defense in response to Petitioner's pleading should not be construed as a finding that those grounds or defenses not specifically addressed by this order are proper grounds for cancellation or defenses to Petitioner's asserted claims. Notwithstanding, Respondent is ordered to review TBMP §§ 309.03 and 311 (2015) in their entirety, including the cases cited therein, prior to filing and serving his revised answer and counterclaim, as provided *infra*.

The Board also notes that Respondent improperly cites to evidence, i.e., citations to various websites, references to third-party registrations, etc. within certain allegations in his counterclaim. See TBMP § 309.03(a)(2) (2015) ("Evidentiary matters should not be pleaded in a complaint. They are matters for proof, not for pleading."). Respondent will have the opportunity to submit such evidence and/or proof in support of his asserted counterclaim during Respondent's appropriate testimony period.

false, then Respondent should merely deny those allegations in its answer, if he has not already done so. Further, to the extent Respondent seeks to cancel Petitioner's registered mark on the grounds that Petitioner is not the owner of the pleaded registration or that the assignment of Petitioner's pleaded registration is invalid, then Respondent should assert short and concise statements supporting these grounds for cancellation.

In view of the deficiencies identified above and pursuant to the Board's inherent authority to manage its docket, Respondent's answer and counterclaim filed on May 9, 2016 is hereby *stricken in its entirety without prejudice*. See Fed. R. Civ. 12(f)(1); see also *Renshaw v. Renshaw*, 153 F.2d 310, 311 (D.C. Cir. 1946) (the striking of a pleading in its entirety that is in violation of Rule 8 of the Federal Rules of Civil Procedure is within the sound discretion of the court where there is a gross violation of the spirit of that rule).

Respondent is allowed until **June 20, 2016** in which to file and serve a revised answer which complies with Fed. R. Civ. P. 8(b) and a counterclaim which sets forth proper and recognized grounds for cancellation under the Trademark Act based on the circumstances of this case and which are in accordance with Fed. R. Civ. P. 8 and 11 in Cancellation No. 92061981, failing which judgment may be entered against Respondent and the counterclaim may be dismissed with prejudice.<sup>6</sup>

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<sup>6</sup> Respondent may re-assert his affirmative defenses of laches, acquiescence, estoppel, contractual estoppel and/or unclean hands, as long as these defenses are accurately stated and are supported by a factual foundation. Respondent should not assert amplifications of denials in his revised answer.

Petitioner, in turn, is allowed until **twenty (20) days** from the date indicated on the certificate of service of Respondent's amended pleading in which to file and serve its answer or otherwise respond to Respondent's amended counterclaim.

**Respondent's Motion to Dismiss filed in Cancellation No. 92062710**

On December 28, 2015, Respondent filed a combined motion to dismiss the petition to cancel in Cancellation No. 92062710 under Fed. R. Civ. P. 12(b)(1), 12(b)(4), 12 (b)(5) and 12(b)(6), as well as to strike allegations under the Fed. R. Civ. P. 12(f) on the ground that the allegations are impermissible, redundant, impertinent, immaterial or scandalous.<sup>7</sup> Petitioner filed a timely response to the motion on January 19, 2016.

For the reasons discussed below, Respondent's combined motion to dismiss and to strike is **DENIED** in its entirety.

A. Motion to Dismiss under Fed. R. Civ. P. 12(b)(1) – Lack of Jurisdiction

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. *See Conolty v. Conolty O'Connor NYC LLC*, 111USPQ2d 1302, 1309 (TTAB 2014); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082-83 (TTAB2014). The Board's determination of registrability does not require in every instance decision on every pleaded claim, and the Board uses its discretion to decide only those claims necessary to

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<sup>7</sup> The Board notes that Respondent incorporates by reference his motions for Rule 11 sanctions and to strike under Fed. R. Civ. P. 12(f) filed in Cancellation No. 92061981. For the same reasons stated in the Board's March 30, 2016, order issued in Cancellation No. 92061981, Respondent's motion for Rule 11 sanctions will be given no consideration (as it pertains to Cancellation No. 92062710) in light of Respondent's failure to comply with the safe harbor provision of the rule. See Fed. R. Civ. P. 11(c)(1)(A). Similarly, Respondent's incorporated motion to strike under Fed. R. Civ. P. 12(f) is also **DENIED** for the reasons set forth in the Board's March 30, 2016, order issued in Cancellation No. 92061981.

enter judgment and dispose of the case. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

Here, the Board notes that Petitioner seeks to cancel Respondent's subject registration in Cancellation No. 92062710 on the grounds of likelihood of confusion and dilution. Clearly, the Board has jurisdiction to entertain such claims under the Trademark Act. In view thereof, Respondent's motion to dismiss for lack of jurisdiction is **DENIED**.

B. Motion to Dismiss under Fed. R. Civ. P. 12(b)(4) and 12(b)(5)

In support of his motion to dismiss under Fed. R. Civ. P. 12(b)(4) and 12(b)(5), Respondent contends that Petitioner does not own the pleaded marks due to error, omissions, and invalid process; and that the petition itself and the required assignment are fatally defective. Additionally, Respondent maintains that Petitioner failed to serve with its pleading the assignment records of Petitioner's pleaded registration or the chain of title for the assignment. Respondent also contends that he was never served with Petitioner's pleading; instead, Respondent maintains he was only served with the ESTTA filing receipt of Petitioner's filing of its petition to cancel.

In response, Petitioner contends that it did serve Respondent with a copy of its pleading, as well as a copy of the ESTTA electronic filing receipt.

The difference between Fed. R. Civ. P. 12(b)(4) and 12(b)(5), which "is not always clear, nor always observed," is:

An objection under Rule 12(b)(4) concerns the form of the process rather than the manner or method of its service. Technically, therefore, a [R]ule 12(b)(4) motion is proper only to challenge noncompliance with the provisions of Rule 4(b) or any applicable provision incorporated by Rule 4(b) that deals

specifically with the content of the summons. A Rule 12(b)(5) motion is the proper vehicle for challenging the mode of delivery or lack of delivery of the summons and complaint.

*U.S. v. Hafner*, 421 F.Supp.2d 1220, 1223 n. 3 (D.N.D. 2006) (quoting 5A Wright & Miller, *Federal Practice and Procedure*, § 1353, pp. 334–35 (3d ed. 2004)); *Richardson v. Alliance Tire & Rubber Co., Ltd.*, 158 F.R.D. 475, 477 (D. Kan. 1994).

It appears that Respondent is moving to dismiss under Fed. R. Civ. P. 12(b)(4) on the grounds that Petitioner did not include copies of the assignment of Petitioner's pleaded registration with its petition to cancel and that the assignment of Petitioner's pleaded registration is invalid and therefore Petitioner's pleading constitutes defective process. Respondent is mistaken. There is no requirement for a plaintiff to serve with its pleading copies of assignments of its pleaded registrations. Respondent's reliance on Trademark Rule 3.73(b)(1) is misplaced. Trademark Rule 3.73(b)(1) provides that in order to take action in a trademark matter, the assignee must establish ownership of trademark property. Trademark Rule 3.73(b)(1). The rule does not specifically require that a plaintiff in a Board proceeding submit copies of any assignment of its pleaded registration with its pleading. Instead, the rule states that a plaintiff *may* include the assignment documents with the pleading. *Id.* The rule also states that an assignee may establish ownership of trademark property by recording the assignment with the Office, which Petitioner has done in this case. Trademark Rule 3.73(b)(1)(i). Furthermore, an allegation that an assignment of a pleaded registration is invalid or defective is not a proper ground to dismiss a complaint under Fed. R. Civ. P. 12(b)(4).

Accordingly, Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(4) is **DENIED**.

The Board next turns to Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(5). Although we look to Trademark Rule 2.111 to determine the requirements for proper service and whether service of process in a cancellation proceeding has been properly completed, we look to Fed. R. Civ. P. 12(b), made applicable to this proceeding by Trademark Rule 2.116(a), for the procedure by which a party may raise the defense of insufficient service of process under Fed. R. Civ. P. 12(b)(5).

Federal Rule 12(b) allows the affirmative defense of insufficient service to be presented by motion. Any such motion must be timely filed to be effective. To be considered timely, a motion to dismiss for insufficient service of process should be filed prior to, or concurrently with, the defendant's answer. Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(5) was filed before an answer has been filed and therefore the motion is timely.

Trademark Rule 2.111 provides as follows:

- (a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.111(b) and 2.119.
- (b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. The petitioner must include with the petition for cancellation proof of service, pursuant to § 2.119, on the owner of record, or on the owner's domestic

representative of record, if one has been appointed, at the correspondence address of record in the Office.

Under this procedure, a cancellation is commenced only when two conditions are fulfilled: (1) petitioner makes sufficient efforts to serve the petition to cancel, and (2) the Board is notified of the service at the time the petition to cancel is filed.

In this case, the second service condition, notification to the Board, has been met. By utilizing ESTTA to file its petition to cancel, Petitioner was assured that the petition to cancel would contain a certificate of service attesting to service. “[A]ny plaintiff who files through ESTTA is viewed by the Board as having included proof of service with its pleading.” *Schott AG v. L’Wren Scott*, 88 USPQ2d 1862, 1863 fn. 3 (TTAB 2008).

The issue to be decided in this case concerns the first condition, namely, whether Petitioner failed to actually serve Respondent with a copy of the petition to cancel on Respondent’s “correspondence address of record,” as that phrase is used in Trademark Rule 2.111(a), nullifies the petition.

The Board notes that the foregoing rule does not require a petitioner to provide proof of receipt of a petition to cancel, but only proof of service thereof. The Board notes that Petitioner’s certificate of service indicates that a copy of the petition for cancellation was served upon Respondent by mail at Respondent’s correspondence address of record. Accordingly, in the absence of facts rebutting service, actual service is presumed. Trademark Rule 2.119(a) (certificate of service constitutes *prima facie* proof of service). Petitioner has not admitted that it did not serve a copy of the petition to cancel; rather, Petitioner maintains that it did serve a copy of its

pleading on Respondent at Respondent's correspondence address of record. The only fact alleged in support of Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(5) is Respondent's alleged non-receipt of its service copy of the petition to cancel. However, the fact that the service copy of the petition to cancel was not received does not negate Petitioner's *prima facie* proof of actual service, because non-receipt may have resulted from other causes, such as misdelivery. Further, despite Respondent's alleged non-receipt of a service copy of the petition to cancel, the Board finds no harm to Respondent under the circumstances inasmuch as Respondent is clearly on notice of the petition to cancel and its contents since Respondent filed a timely motion to dismiss the petition to cancel.

In view thereof, Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(5) is **DENIED**.<sup>8</sup>

C. Motion to Dismiss under Fed. R. Civ. P. 12(b)(6)

To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark.

*Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter,

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<sup>8</sup> To the extent that Respondent argues that Petitioner's service of its petition to cancel is defective because it was not delivered to Respondent as an individual or whether the petition does not specifically indicate whether Respondent is "being sued as an individual or as a corporation," such arguments are without merit. The record clearly demonstrates that Petitioner's certificate of service indicates that the petition to cancel was served on Respondent at Respondent's correspondence address of record. Further, the petition to cancel clearly identifies Respondent as "Yoel Steinberg d/b/a CupK Kosher Supervision." See ¶ 2 of Petition. The petition does not refer to Respondent as a corporation in any manner, but only as an individual doing business as "CupK Kosher Supervision."

accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S.662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. In particular, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010).

For purposes of determining such motion, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. *See Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

### Standing

A party has standing to oppose a particular application when it demonstrates that it has a real interest in the proceeding, and a reasonable basis for the belief that it will be damaged by the issuance of a registration. *Herbko Int’l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Cunningham v. Laser*

Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

The Board, after reviewing Petitioner's pleading in Cancellation No. 92062710, finds that Petitioner has sufficiently alleged a "real interest" and a "direct and personal interest" in the outcome of this proceeding. Specifically, Petitioner alleges that (1) it is the owner of U.S. Registration No. 927067 for the certification mark  for "food" in International Class A (§ 3 of Petition); (2) it is the owner of pending application Serial No. 86713509 for the certification mark  for various Kosher foods in International Class A (§ 3 of Petition); (3) since at least as early as April 1, 1971, Petitioner's mark  has been used continuously by third parties authorized by Petitioner to use this mark to certify Kosher quality of food (§ 5 of Petition); (4) since at least as early as 1972, Petitioner's mark  has been used continuously by third parties authorized by Petitioner to use this mark to certify the Kosher quality of food and other products covered by this mark (§ 5 of Petition); (5) if Respondent is permitted to continue to own its subject registration, confusion in trade resulting in damage and injury to Petitioner will continue to be caused and will result by reason of similarity between Respondent's mark as reflected in the registration and Petitioner's marks (§ 18 of Petition); and (6) Petitioner has been damaged by Respondent's mark and will continue to be damaged if the Registration continues to exist because Respondent, through its Registration, has obtained right

sin Respondent's Mark in violation and derogation of Petitioner's established prior rights. (¶ 20 of Petition).

Clearly, these facts, if proved, would be sufficient to establish Petitioner's real interest in this proceeding, that is, an interest beyond that of the general public, and that is all the law requires. *See International Order of Job's Daughters v. Lindeburg and Company*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991). In view thereof, the Board finds that Petitioner's allegations regarding its standing are sufficiently pleaded. Accordingly, Respondent's motion to dismiss is **DENIED** to the extent Respondent contends that Petitioner has not sufficiently pleaded its standing.

#### Likelihood of Confusion

In order to properly state a claim of likelihood of confusion, an plaintiff must plead (and later prove) that (1) defendant's mark, as applied to its goods or services, so resembles plaintiff's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) it has priority of use. *See Fed. R. Civ. P. 8; King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Following a careful review of Petitioner's pleading, the Board finds that Petitioner has sufficiently pleaded its likelihood of confusion claim. Specifically, Petitioner has alleged (1) that its pleaded marks were first used in April 1971 and 1972 and that these dates are long prior to the date when Respondent filed its application for Respondent's mark, and long prior to the date that Respondent alleges Respondent's mark was first used (¶ 11 of Petition); (2) Respondent's mark

is similar in sound, appearance, and commercial impression to Petitioner's Marks, particularly in light of the similarity in sound between CUPK and "Kof K," which is how Petitioner's marks are referred to in spoken language (§ 13 of Petition); (3) Respondent's mark is used on or in connection with services that are highly related to Petitioner's certifications provided in connection with Petitioner's marks (§ 14 of Petition); and (4) in view of the similarity between Petitioner's marks and Respondent's mark, the related nature of the goods and services on or in connection with which the marks of the respective parties are used, and the related nature of customers and channels of trade for these respective goods and services, Respondent's mark so resembles Petitioner's marks previously registered and/or used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake and deceive. (§ 16 of Petition).

The Board finds the foregoing allegations sufficient to assert a claim of priority and likelihood of confusion. In view thereof, Applicant's motion to dismiss is **DENIED** with regard to Petitioner's claim of likelihood of confusion.

#### Dilution

The Board set forth the standard for properly pleading a claim of dilution under Section 43(c) of the Trademark Act as amended in *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001) ("Toro"). Under Toro, the pleading must include allegations that Petitioner's pleaded marks are famous and that such fame was acquired before Respondent began commercial use of his involved mark.

After a careful review of Petitioner's pleading, the Board finds that Petitioner's dilution claim is legally sufficient. Specifically, Petitioner has alleged that its pleaded marks are famous and were famous prior to the filing date of Respondent's mark and prior to Respondent's first use of Respondent's mark, and as a result Respondent's mark is likely to cause, and will cause, dilution of the distinctive quality of Petitioner's marks. (¶¶ 22 and 23 of Petition).

Accordingly, Respondent's motion to dismiss Petitioner's claim of dilution is **DENIED**.

In view thereof, Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(6) is **DENIED** in its entirety.<sup>9</sup>

To the extent Respondent seeks to strike any allegations set forth in Petitioner's petition to cancel under Fed. R. Civ. P. 12(f) in Cancellation No. 92062710 above and beyond its incorporated motion to strike from Cancellation No. 92061981, the motion is **DENIED**. The Board has reviewed Petitioner's petition to cancel in

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<sup>9</sup> To the extent Respondent has argued the merits of Petitioner's asserted claims, the Board has given no consideration to such arguments since a motion to dismiss for failure to state a claim does not involve a determination of the merits of the claims. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (A motion to dismiss is a test solely of the legal sufficiency of the plaintiff's pleadings ... No matters outside the pleadings are considered. A motion to dismiss does not involve a determination of the merits of the case).

Additionally, to the extent Respondent's motion seeks to dismiss the petition to cancel on the ground that the claims asserted therein are time-barred because the assignment of the registration upon which Petitioner relies in support of its claims was not effectuated until after the 5-year anniversary of Respondent's subject registration, the motion is **DENIED**. As explained herein, the assignment of Petitioner's pleaded registration occurred prior to the commencement of this consolidated proceeding and prior to the 5<sup>th</sup> anniversary of Respondent's subject registration.

Cancellation Nos. 92061981 and 92062710

Cancellation No. 92062710 and finds that none of the allegations asserted therein should be stricken pursuant to Fed. R. Civ. P. 12(f).

Because the Board has denied Respondent's combined motion to dismiss and to strike in its entirety, Respondent is allowed until **June 20, 2016** in which to file his answer to the petition to cancel in Cancellation No. 92062710.

Three final matters need to be addressed. First, the requirement that Respondent obtain prior Board approval before filing any unconsented motions is now applicable to this consolidated case.

Second, the Board notes that the margins of Respondent's filings to date are only approximately ½ inch on all sides. Although there is no specific Board rule regarding the size of margins for papers filed in a Board proceeding, the Board hereby imposes the requirement on both parties that a 1 inch margin be present on all sides of every paper filed with the Board. Additionally, the requirements that all papers submitted with the Board be printed in at least 11-point type and double-spaced, *see* Trademark Rule 2.126, remain operative in this consolidated case. The aforementioned requirements are imposed in order to avoid any potential subterfuge of the page limitations set forth under Board rules in this consolidated case. ***Any papers filed with the Board that do not comply with the aforementioned requirements will be given no consideration.***

Finally, the Board once again strongly urges Respondent to retain competent trademark counsel to represent him in this consolidated case. The Board neither has the time nor the resources to educate Respondent on Board rules and procedure

which the Board has effectively already done in entertaining the papers filed by Respondent to date.

### Summary

1. Cancellation Nos. 92061981 and 92062710 are *sua sponte* consolidated;
2. Respondent's combined motion to dismiss and to strike filed in Cancellation No. 92062710 is **DENIED** in its entirety; Respondent is allowed until **June 20, 2016** in which to file and serve his answer to the petition to cancel in Cancellation No. 92062710;
3. Respondent's motion for reconsideration of portions of the Board's March 30, 2016, order filed in Cancellation No. 92061981 is **DENIED** in its entirety; and
4. Respondent's answer and counterclaim filed on May 9, 2016 in Cancellation No. 92061981 is **STRICKEN in its entirety without prejudice**; Respondent is allowed until **June 20, 2016** in which to file and serve a revised answer and counterclaim in Cancellation No. 92061981 consistent with this order; Petitioner is allowed until **twenty (20) days** from the date indicated on the certificate of service of Respondent's revised answer and counterclaim in which to file its answer or otherwise respond to Respondents' revised counterclaim.

### Trial Schedule

These consolidated proceedings are resumed. Trial dates for this consolidated case are set as follows:

Deadline for Discovery Conference	<b>July 30, 2016</b>
Discovery Opens	<b>July 30, 2016</b>
Initial Disclosures Due	<b>August 29, 2016</b>
Expert Disclosures Due	<b>December 27, 2016</b>
Discovery Closes	<b>January 26, 2017</b>
Plaintiff's Pretrial Disclosures	<b>March 12, 2017</b>
30-day testimony period for plaintiff's testimony to close	<b>April 26, 2017</b>
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	<b>May 11, 2017</b>
30-day testimony period for defendant and plaintiff in the counterclaim to close	<b>June 25, 2017</b>
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	<b>July 10, 2017</b>
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	<b>August 24, 2017</b>
Counterclaim Plaintiff's Rebuttal Disclosures Due	<b>September 8, 2017</b>
15-day rebuttal period for plaintiff in the counterclaim to close	<b>October 8, 2017</b>
Brief for plaintiff due	<b>December 7, 2017</b>
Brief for defendant and plaintiff in the counterclaim due	<b>January 6, 2018</b>
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	<b>February 5, 2018</b>
Reply brief, if any, for plaintiff in the counterclaim due	<b>February 20, 2018</b>

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