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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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CERTIFICATE OF SERVICE UNDER 37 CFR §§ 2.111

I hereby certify that the foregoing Reply to Brief In Opposition of Motion To Strike Matter from the Pleading in regard to the Proceedings of Cancellation No. 92061981, has been served via first class mail upon Petitioner on October 15, 2015, at Petitioner's address as reflected in the records of The United States Trademark Office as follows:

MICHAEL R FRISCIA
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Date: October 15, 2015

Yoel Steinberg

**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

Registrant/Respondent, *pro se*

Cancellation No. 92061981

Registrant's Reply to Petitioner's

Brief in Opposition to Motion to Strike

REGISTRANT'S REPLY TO PETITIONER'S BRIEF IN OPPOSITION TO MOTION TO STRIKE.

I, Yoel Steinberg, Registrant and owner of the mark with US Registration No. 3830599, in reply to the Brief filed on Oct 1 2015 by Petitioner KOSHER SUPERVISION SERVICES, Inc. in opposition to my Motion to Strike Matter of the pleading from the petition filed against my mark by said Petitioner, respectfully reply as follows:

MOTION IS BASED ON SUBSTANSIVE MATTERS OF MERIT

Within the purpose of Federal Rule of Civil Procedure 12(f), my Motion to Strike seeks to dispense of the expense of needless litigation. There is no need to litigate matters of Religious Doctrine for which the Board will eventually not be allowed to determine at Trial. Whether or not Petitioner's standards, or goods its Marks appeared on, are of a quality which must be gauged by Religious Doctrine, is in effect moot. Additionally, a motion need not satisfy every possible ground when the grounds it does satisfy are sufficient. It will also be further shown within my reply that Petitioner's allegations are impertinent and otherwise deficient.

PROTEST IN REPLY TO FOOTNOTE 1

Petitioner in footnote 1 of page unnumbered of the Opposition brief dated Oct 1, 2015, states among other things that "Petitioner intends to file a request to correct the spelling of the owner name on U.S. Registration No. 927,067 to Kosher Supervision Services, Inc. [emphasis added]".

In response to footnote 1, I make several objections (which may also apply even beyond this Motion):

Petitioner has already stated the exact same “intention” over 70 days ago in footnote 1 of page unnumbered of its petition dated Aug 7, 2015. But Petitioner has still not carried out this “intention” despite a correct spelling of the name being crucial to establishing ownership of the Registration, and to even the entire Petition. The Board may find Petitioner’s negligence and delay to be unreasonable. The spelling of the owner name within the Registration is especially crucial considering that Petitioner is not the original owner of the Registration (under any spelling), so that at this time, Petitioner Kosher Supervision Services, Inc. [even with comma] is neither the original owner of the mark, nor the Assignee of the mark and the mark’s Registration, nor of the mark’s associated good will. The Assignment record showing that the original owner of the mark and its associated good-will is someone other than Petitioner, is located at reel 2788, frame 0358, of The US Trademark Office records, and shows a recorded assignment date of 02/05/2004, and an execution date of 12/02/2003, almost 12 years ago.

Petitioner’s regulating this statement of intent to merely a footnote of the petition made it appear as if a mere amendment were required to correct a clerical error to change the name within the Registration, and that Petitioner can do this at its own initiative, and that the interim incorrect spelling would not negate Petitioner’s ownership of the mark, its Registration, and good will. However, Mr. Frisica and the petition omitted from the petition the material information that there was an assignment of Registration No. 927067, And that Petitioner is not the original owner of the mark, or the mark’s Registration, or its good will.

It is not enough for Petitioner to request to change the spelling of the owner name within the Registration, because the spellings in the Assignment data would first need to be changed. Since Petitioner is not the original owner of the mark, or the mark’s Registration, or its good will, Petitioner therefore does not have authority on its own to file a request to have the owner name changed within the Registration, since even as an averred assignee it must have the original owner re-assign the registration. *See* TMEP 503.06(b) ... **(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.* ... [emphasis added]. So far, the original owner has not done this.

One may wonder whether the original owner even wants to assign U.S. Registration No. 927,067 to Petitioner, considering the unreasonably long duration for which he has not done so.

Given the current record, and in consideration of Petitioner's unreasonable delay, Petitioner's standing at this point of the proceedings is as any John Doe who asserts that it intends to solicit assignment and ownership of the Registration from the Mark's owner. I therefore object to Petitioner's referring to a change (in the spelling of Assignee name in the cover sheet of the Assignment, or to a change) in the owner name in the Registration, as a 'correction' since it is no more "correct" (from a procedural viewpoint) to have Petitioner's name there than to have the name of any John Doe. By Petitioner's reasoning, (and from a procedural viewpoint) I should also be able to state that the owner name within the Registration should be "corrected" to be my own name, by asserting that I "intend" to file a request to have spelling "corrected". And (even from a viewpoint of the merits), Petitioner has not sufficiently asserted that I am not privy to the original owner of the Registration just as much if not more so than Petitioner is.

It should also be noted that even if the original owner were to decide at a later date that it does want to assign the Registration of U.S. Registration No. 927,067 to Petitioner, that this hypothetical assignment would not take effect retroactively. *See* TMEP 503.06(a)(ii) . Therefore, since the registration of my mark is already more than 5 years old, the petition can never be rectified as having been properly filed within the time limit for the grounds stated within the petition.

It should also be noted that by stating its intention to have the spelling corrected and by thereby attempting to have the pleading status which would have resulted from such a spelling change, Petitioner is in effect attempting to obtain rights for which it did not pay the required fee. A spelling change in the Owner information of a Registration –even when done by the owner as opposed to an assignee- bears a (\$100) fee. TMEP §1609.10(b), and 1201.02(c); 37 CFR §2.6(a)(9), and 15 USC §1057(h). So that unless this fee was paid, Petitioner may not assert any rights which would have required a change in the spelling and the payment of a fee.

I also protest that Petitioner's delay in "correcting" the spelling prolongs the many contradictions between how Mr. Friscia lists two plaintiffs, yet Petitioner states in footnote 1 of the (petition and) Opposition brief: "Petitioners Kosher Supervision Inc. and Petitioners Kosher Supervision Inc. are the same entity". The Petitioner Information document ESTTA 688428, filing date 08/07/2015 which precedes the petition itself, states: "Notice is hereby given that the following parties request to cancel indicated registration". The document lists Petitioner Information for two Petitioners. The first Petitioner is listed as Name: Kosher Supervision Services, Inc. . Entity: Corporation. . The second Petitioner is listed as Name: Kosher Supervision Services Inc. Entity: Corporation. Both list Address: 201 The Plaza, Teaneck, NJ 07666 United States. The Attorney Information there on document ESTTA 688428 lists Michael Friscia. According to this document, there are two petitioners.

In particular, Kosher Supervision Services Inc. [without comma] is stated to be a separate entity that is a corporation. And Michael Friscia is listed as the attorney whom Kosher Supervision Services has authorized to represent it. In the CERTIFICATE OF SERVICE section of document ESTTA 688428, Michael Friscia places his electronic signature dated 08/07/2015, to certify that "The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date. [Emphasis added]". The information is entered as if Kosher Supervision Services Inc. [without comma] is a corporation, and has an address, and that it has authorized Michael Friscia to be its attorney, and that it was mailed a copy of the filings via First Class Mail. Mr. Friscia repeats this representation in the (petition and) Opposition brief where he lists two Petitioner's at the left of the page (on page unnumbered) underneath the Header which says IN THE UNITED STATES PATENT AND TRADEMARK OFFICE. In summary, Mr. Friscia presents the facts as if Kosher Supervision Services Inc. exists as a legal entity that is a corporation with an address, and which has authorized Mr. Friscia to represent it. However, this presentation is contradicted by Michael Friscia himself in (the petition and in) the Opposition brief (in footnote 1 of page unnumbered). There Mr. Friscia seems to concede that Kosher Supervision Services Inc. [without comma] is merely a typographical error, but

that there is no such corporate entity as Kosher Supervision Services Inc. I therefore bring to the attention of The Board that there are administrative errors within The Record, and in how the petition was filed.

It will also be shown on the Public government record for State of NJ that even Kosher Supervision Services, Inc. [with comma] did not exist prior to 1986, so that an Assignment is therefore required from the mark's (as of yet unidentified) original owner of 1972 even for the mark of Application No. 86713509. (The Application file, and the petition, state the mark was first used in 1972).

I respectfully bring all this to the attention of The Board so that my position in this proceeding will not be prejudiced. And so that The Board may *sua sponte* take action on their own to do as they see fit. [I need not cite authorities when The Board is taking Action on their own].

I bring this to the attention of The Board now, in light of Petitioner's unreasonable delay to fulfill its stated "intention" to have the "spelling corrected", and the revelation that Petitioner's intention is not bona fide. And I bring this to the attention of The Board now, in light of the information discovered and confirmed by Miss Hind Abdelrazig of TTAB in phone conversation dated Sept 17, tracking # 1-355186687. As Miss Hind reports, Mr. Friscia, the attorney submitting the petition, paid \$600 to file the petition in the name of two plaintiffs -not just \$300 for one plaintiff. It is therefore now discovered that the listing of two plaintiffs in the petition is given therein not merely for information of record keeping, but is rather presented to The Board as if it were a bona fide filing with full legal consequences. (Mr. Friscia did not reveal within the footnote that there actually were two full filings for two petitioners with an actual \$300 fee being paid on behalf of each petitioner). [This newly discovered information was not available to me prior to hearing it from Miss Hind, because as she confirmed in the phone conversation, it is not available on-line, and it required research on her part to retrieve it internally from the system records of the TTAB].

This new information also indicates another administrative error, in that the record shows \$300 fee was paid to Trademark Office by "Petitioner" Kosher Supervision Services Inc. [without comma], even though as a typographical error phantom entity it has no money and cannot pay a fee.

Petitioner's delay also may have prejudiced my right to file a counterclaim since there currently may be no Juristic person owning the mark whom I can sue in good faith to be the counter-respondent whose mark's Registration will be cancelled. I also do not want it to appear that I in any way concede that Petitioner owns any mark. But my filing a counterclaim against Petitioner (as opposed to the mark's original owner) might make it appear as if Petitioner has a right to the Registration. It would also not be fair for me to need to pay two fees to counterclaim against two Petitioners.

REPLY TO BODY OF PETITIONER'S OPPOSITION BRIEF

PETITIONER'S SUMMARY OF THE PLEADED ALLEGATION AND OF THE PETITION AS A WHOLE

Petitioner cites numerous case law which actually weigh in favor of a Motion to Strike, and might be applicable even to the petition as a whole. However, I humbly disagree with Petitioner's summary (toward end of Opposition brief) that "Petitioner's claims of likelihood and confusion are plausible and that Petitioner's claims of likelihood and confusion and dilution are plausible and that Petitioner's right to relief is not merely speculative." The Board may find that Petitioner's claims of likelihood and confusion are not plausible; Petitioner's claims of likelihood and confusion and dilution are not plausible; and Petitioner's right to relief is not more than merely speculative. Although (due to time constraints and other factors including not being informed of the Conventions of Practice before The Board) this Motion addressed paragraph 6 of the petition, The Board on their own might find many more allegations within the petition as a whole which were "bald", "conclusory", non-conclusive, and which fail to pertinently contribute toward asserting a plausible cause for relief. However, I respectfully reserve the right to file a full Motion to Dismiss at a later time.

CIRCUMSTANCES OF FAME NOT DIRECTLY ALLEGED

1) The petition itself does not directly state in paragraph 6 or even in the petition as a whole that fame is demonstrated within paragraph 6. I humbly remind The Board that Fed R. Civ. P. 8(d)(1) requires in part that "Each allegation must be simple, concise, and direct". [emphasis added]. The Board might interpret that Rule to determine that a demonstration of fact which merely might be derived outside of the context of the allegation is not a direct allegation. Paragraph 6 of the petition subordinated within it via the phrase "By reason of", the set of

circumstances from which Petitioner in its Opposition brief (page 3) asserts that fame for its Marks are “demonstrated”. (Note that Paragraph 6 of the petition does not use any verb to directly aver these things *were* done. Petitioner rather uses nouns and subordinates this assertion as “*By reason of*”).

2) However, even within Petitioner’s assertion that fame is demonstrated, –and even if paragraph 6 of the petition were interpreted most favorably for Petitioner- whether this first set of circumstances stands alone as a direct averment must be evaluated within the context of how they relate to the second set of asserted resulting circumstances at the end of the sentence that “...the public and the trade have come to recognize goods... as signifying ...stringent standards ... highest standards of Kosher law” [omissions replaced by ellipses]. In other words, within paragraph 6 of the petition there is no direct averment which addresses fame or anything other than matters referring to quality of certification standards as gauged by Kosher law. The word “fame” or “famous” is not even mentioned.

3) Furthermore, Petitioner’s assertion is contraindicated by the allegation itself. If the allegation intended to demonstrate widespread use or fame for the Marks, the allegation should have not restricted itself to discussing only “high-quality goods”, when including goods of *all* qualities would have better demonstrated this intended assertion. The intent of the allegation is therefore *affirmatively* not about fame or recognition.

IMPERTINENT INCONCLUSIVE ARGUMENT RATHER THAN AN ALLEGATION

4) Petitioner in Paragraph 6 of the petition, seems to misunderstand the nature of a certification mark. A certification mark does not indicate that the goods originate from the certifying party. As such, goods in connection with the marks Petitioner asserts to own do not "signify" Petitioner or its certification standards. Similarly, even within Petitioner’s assertion that its mark was used by third parties, this does not pertinently establish that anyone knows who Petitioner itself is, or that a corporation called Kosher Supervision Services, Inc. even exists. Petitioner’s assertion that kosher certified products have come to signify “Petitioner” is simply incorrect.

5) Additionally, an assertion of extensive promotion, advertising, and provision of high commercial quality goods in connection with marks Petitioner asserts it owns is impertinent to "creating an impression among

public and trade" as to whether the kosher certification standards for the marks would be of high or low quality or if the kosher certification standards would be "stringent" or lenient. Nowhere in the petition has Petitioner even asserted the unsupported notion that high commercial quality is at all related to or a function of a high standard of kosher. The petition also fails to specify the gauge by which the goods offered for sale were plausibly of high kosher quality.

6) Furthermore, even if hypothetically an "extensive promotion, advertising, and provision of high-quality of goods in connection with" marks Petitioner asserts it owns did happen for 40 years, this would still not create a perception "among public and trade" that Petitioner or the marks it asserts to own have "high" or "stringent" certification standards, as even a certification mark which has dismally low standards would likewise not refuse to certify a product of high standards. Petitioner has not sufficiently stated within the petition what the public perceives about whether Petitioner selectively refuses to certify any specific product as not meeting its standards for kosher certification. Nowhere in the petition is it even asserted that Petitioner does not certify products of low and even non-existent kosher quality. As such, the allegation is impertinent to a plausible claim for relief.

PERTINENT FAME NOT DEMONSTRATED

7) Even within Petitioner's new assertion, that "strength" or "fame" is demonstrated by "third parties' promotions [etc.]... of high quality goods in connection with Petitioner's Marks for over 40 years", This is not pertinent to showing that "Petitioner's Marks are referred to in spoken language as "Kof K"" has itself taken place for 40 years nor at any time prior to the Registration of my mark. The Board might find that Petitioner's entire plausibility of claim for relief is hinged on Petitioner's "information and belief" that "Petitioner's Marks are referred to in spoken language as "Kof K"". And on a novel but untenable legal theory that similarities in how "Marks are referred to in spoken language" is somehow a DuPont factor of similarity in sound even though Petitioner avoids a direct averment that its marks are *pronounced* as "Kof K". It is therefore impertinent how much "fame" or "recognition" may have been accruing for "Petitioner's Marks" since the issue in question (See Petitioner's citation of *Hillery*) as asserted by Petitioner is whether there is confusion between Cup K and Kof K. (Petitioner did not seem to *specifically* assert any similarity other than this). And that without an assertion of

pertinent confusion between Cup K and Kof K, there is no assertion of plausible confusion or dilution between the marks themselves.

PERTINENT FAME REQUIRES A PERTINENT AUDIENCE

8) Furthermore, even if the allegations within paragraph 6 of the petition were to be accepted as true, and even if as asserted by Petitioner in its Opposition brief, this would still be impertinent to what KOSHER consumers perceive about the marks or about Petitioner or about its certifications or standards. As Professor McCarthy, in 4th Edition of McCarty on Trademarks and Unfair Competition § 16:7 writes, “ ... *there must be public exposure to create trademark rights.*”, and also that “...*Similarly, shipping goods to another company as part of the manufacturing process does not establish priority.*” , and Professor McCarthy also notes there that “*A company which receives goods as part of the manufacturing process is not among the relevant class of consumers.*”, and that “*Intra-corporate shipments are not public and serve no source identifying role.*” The petition does not plausibly assert that the high-quality goods of its paragraph 6 were consumer goods (as opposed to industrial chemicals and ingredients such as those listed for Application No. 86713509). Similarly, the petition does not sufficiently assert that the high-quality goods of its paragraph 6 were promoted, advertised, or provided to anyone who cares about Kosher, or even to anyone who knows that Kosher exists. The Board might therefore find Paragraph 6 of the petition to be impertinent, since the allegation doesn’t sufficiently assert anything other than (an unsupported conclusion that) an impertinent “public and trade” “have come to recognize goods... as signifying” etc... And even that assertion is merely a conclusion rather than an averment.

IMPERTINENT MARKS ARE IMPERTINENT

9) Additionally, although paragraph 3 of the petition designates the marks of U.S. Registration No. 927067 and U.S. Application No. 86713509 as “Petitioner’s Marks”, this designation is not stated within the petition to be exclusive. The USPTO TSDR records, and specimen submissions for Applications and subsequent Renewals of the marks being pleaded show multiple marks specimens over the years, with the Registered mark not being used, and being abandoned for newer marks even before it was registered, and with the Applied for mark not being used until after the Registration of my trademark. So that even within Petitioner’s new interpretation that

Paragraph 6 of the petition is pertinent to demonstrating that past certifications establish fame for the marks of Registration No. 927067 and Application No. 86713509, the allegation itself does not sufficiently aver a plausible cause for claim that the pertinent marks of Registration No. 927067 and Application No. 86713509 (as opposed to a third and fourth mark formerly used by Petitioner) were those which appeared on high-quality goods which were extensively promoted advertised and provided by third parties, nor that the marks of Registration No. 927067 and Application No. 86713509 have become famous etc. as a result. The averment does not sufficiently specify which marks it refers to. Additionally, even without the specimen records, the allegation still does not specify that it does not refer to the impertinent marks. The allegation lacks the required specificity for it to pertinently contribute toward asserting a plausible claim for relief.

In conclusion: My Motion dated September 11, 2015, to Strike Matter from The Pleading in regard to the Proceedings of Cancellation No. 92061981 , should be GRANTED IN FULL .

Respectfully submitted,

Dated October 15, 2105

By:

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