

04-29-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

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

In the matter of Trademark Application :
Serial 76-342,386 filed November 27, 2001 :
by Samick Music Corporation :
for the trademark :

"Samick"

: OPPOSITION NO. _____

: EXPRESS MAIL NO.: EU 937887155 US

: Date: April 29, 2003

LAWRENCE MUSIC, INC.

Opposer,

v.

SAMICK MUSIC CORPORATION

Applicant.

: I hereby certify that this paper
: paper or fee is being deposited
: with the United States Postal
: Service "Express Mail Post Office
: to Addressee" service under 37
: C.F.R. 1.10 on the date indicated
: above and is addressed to the
: Assistant Commissioner of
: Trademarks, 2900 Crystal Drive,
: Arlington, VA 22202-3513 by:

: _____
: Gregg R. Zegarelli
: Counsel for Opposer

REQUEST FOR EXTENSION OF TIME TO OPPOSE FOR EXTRAORDINARY CAUSE
PURSUANT TO C.F.R. § 2.102(c)
IN THE NATURE OF STAY OF PROCEEDINGS

In the matter of the above-identified application, published in the Official Gazette of December 31, 2002.

Lawrence Music, Inc., a Pennsylvania corporation having a principal place of business at 985 Castle Shannon Boulevard, Pittsburgh, PA 15234, by and through its attorneys, hereby request that the Board grant an indefinite extension of time to oppose in the nature of a stay in the above-identified application pursuant to Section 13 of the Trademark Act of 1946, as amended (15 U.S.C. §1063), and 37 C.F.R §2.102(c) (3) for extraordinary cause.

Said extraordinary cause is that the subject matter of this mark is at issue in the United States District Court for the Western District of Pennsylvania, Lawrence Music v. Samick Music, Case No.: 01 1029, of which potential Opposer is Plaintiff. A copy of the pleadings are attached hereto as Group Exhibit A.

In all prudence and caution, potential Opposer files a Notice of Opposition herewith, in conjunction with a Motion for Stay. If the motion made by potential Opposer herein is granted, then potential Opposer hereby withdraws the Notice of Opposition and the Motion to Stay. If the motion made by potential Opposer is denied, then potential Opposer herewith files Notice of Opposition and Motion to Stay. Copies of the Notice of Opposition and Motion for Stay are attached hereto as Exhibit B and Exhibit C, respectively. The filing fee for the Notice of Opposition is enclosed herewith.

WHEREFORE, Potential Opposer requests that its request for extension of time for extraordinary circumstances is granted.

April 29, 2003

Respectfully submitted,

Gregg R. Zegarelli, Esq.
Attorney for Applicant

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Attorney for Opposer
Lawrence Music, Inc.

COPY

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

LAWRENCE MUSIC, INC.,

Plaintiff,

v.

SAMICK MUSIC CORPORATION,

Defendant.

CIVIL ACTION NUMBER: 01 1029

Hon. William L. Standish

PLAINTIFF'S AMENDED REPLY TO DEFENDANT'S (AMENDED) COUNTERCLAIM AND AFFIRMATIVE DEFENSES

Filed on behalf of Plaintiff
Counsel of Record for this Party:

Gregg R. Zegarelli, Esq.
PA I.D. #52717

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PLAINTIFF LAWRENCE'S REPLY TO COUNTERCLAIM

Plaintiff, by counsel, hereby replies to Defendant Samick's counterclaim.

1.-2. Admitted.

3. Samick's place of business is admitted. Otherwise, Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments; therefore, Lawrence denies said averments.

4. Admitted.

5. It is denied that Lawrence is not a licensee. It is denied that the first page of Samick's Exhibit 2 was provided to Lawrence at any time heretofore. Otherwise, the averments contained in paragraph 5 of the Counterclaim constitute conclusions of law or reframe things that speak for themselves; therefore, Lawrence denies said averments as stated.



6. Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments; therefore, Lawrence denies said averments.

7. The averments contained in paragraph 7 of the Counterclaim constitute conclusions of law or reframe things that speak for themselves; therefore, Lawrence denies said averments as stated.

8. The averments contained in paragraph 8 of the Counterclaim constitute conclusions of law or reframe things that speak for themselves; therefore, Lawrence denies said averments as stated.

9. It is admitted that Reg. No. 1,705,696 was allowed to lapse by Samick and said registration was cancelled. Lawrence is without knowledge or information sufficient to form a belief as to why said registration was allowed to lapse. Otherwise, the averments contained in paragraph 9 of the Counterclaim constitute conclusions of law or reframe things that speak for themselves; therefore, Lawrence denies said averments as stated.

10. Lawrence admits receiving certain correspondence regarding the subject-matter averred by Samick in paragraph 10 of its Counterclaim. However, Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments as specifically averred; therefore, Lawrence denies said averments.

11.-13. Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments; therefore, Lawrence denies said averments.

14.-18. The averments contained in paragraphs 14-18 of Samick's Counterclaim are highly technical issues that are subject to debate depending upon the level of technical scrutiny rendered. Accordingly, Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments; therefore, Lawrence denies said averments.

19. In good faith, Lawrence admits that it completed any required "click-through" or appurtenant terms and conditions when acquiring the domain name "samickguitars.com", but Lawrence (as is commonplace) did not retain a printout of those terms and conditions. Accordingly, Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments; therefore, Lawrence denies said averments.

20. It is admitted that sometime on or about September 2, 1999, Lawrence purchased the Internet domain name "samickguitars.com" and that Lawrence has maintained the Internet domain name with Network Solutions. Otherwise, Lawrence is without knowledge or information sufficient to form a belief as to the truth of the averments; therefore, Lawrence denies said averments.

21. Denied.

22. Lawrence incorporates herein paragraphs 19 and 20 of its Reply by this reference.

23. It is admitted that Samick contacted Lawrence regarding the general PRS situation averred, however, because Lawrence is without knowledge or information sufficient to form a first-hand belief as to the truth of the averments, since Samick is in sole possession or control of the same, or said averments are conclusions of law, Lawrence therefore denies said averments. It is denied that Samick was not familiar with the "samickguitars.com" site. Specific proof of the averred costs and resources is hereby demanded, Samick profiting from sales related to Lawrence's development of the "samickguitars.com" site.

24. Admitted.

25. The first sentence of paragraph 25 is denied.¹ Otherwise, Lawrence admits making adjustments to the site in the nature of "SamickGuitars.com is a division of Lawrence Music, Inc. Authorized Dealer Of Samick Musical Instruments".

26. Denied.

27. Lawrence hereby incorporates paragraphs 1 through 26, inclusive, by this reference.

28.-30. Denied.

31. Lawrence hereby incorporates paragraphs 1 through 30, inclusive, by this reference.

32.-35. Denied.

¹ Any monetary references made during conversations between counsel after the date of the cease and desist letter referenced in paragraph 24, were claimed damages to Lawrence at the time, based upon Samick threats to take the domain name after years of Lawrence effort developing the site with Samick's knowledge and assistance, and were expressly for settlement purposes only. Samick's references to such conversations are inappropriate.

36. Lawrence hereby incorporates paragraphs 1 through 35, inclusive, by this reference.

37.-39. Denied.

40. Lawrence hereby incorporates paragraphs 1 through 39, inclusive, by this reference.

41.-43. Denied.

44. Lawrence hereby incorporates paragraphs 1 through 43, inclusive, by this reference.

45.-47. Denied.

48. Lawrence hereby incorporates paragraphs 1 through 47, inclusive, by this reference.

49.-52. Denied.

53. Lawrence hereby incorporates paragraphs 1 through 52, inclusive, by this reference.

54. It is admitted that on or about September 2, 1999, that Lawrence acquired the domain name "samickguitars.com".

55. The averments contained in paragraph 55 of the Counterclaim constitute mixed conclusions of law or facts about which Lawrence is without knowledge or information sufficient to form a belief as to the truth thereof; therefore, Lawrence denies said averments as stated.

56. Admitted.

57. Denied.

58. Lawrence hereby incorporates paragraphs 1 through 57, inclusive, by this reference.

59.-61. Denied.

62. Lawrence hereby incorporates paragraphs 1 through 61, inclusive, by this reference.

63.-66. Denied.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Samick has failed to state a claim upon which relief may be granted.

Second Affirmative Defense

Samick lacks standing to maintain the claims asserted in the Counterclaim.

Third Affirmative Defense

Samick's claims are barred in whole or in part by the doctrine of waiver, laches, estoppel and/or acquiescence.

Fourth Affirmative Defense

Samick's claims are barred by the doctrine of license.

Fifth Affirmative Defense

Samick's claims are barred by the doctrine of release.

Sixth Affirmative Defense

Samick's claims are barred as a result of none of the acts or omissions alleged in the Counterclaim violated any of Samick's rights.

Seventh Affirmative Defense

Samick has abandoned one or all of its trademarks.

Eight Affirmative Defense

Samick does not use the averred marks as trademarks.

Ninth Affirmative Defense

Samick's claims are barred by the doctrine that Plaintiff has a legitimate interest in the mark at issue.

Tenth Affirmative Defense

Samick's state law claims are preempted.

Eleventh Affirmative Defense

Samick has failed to join an indispensable party.

Twelfth Affirmative Defense

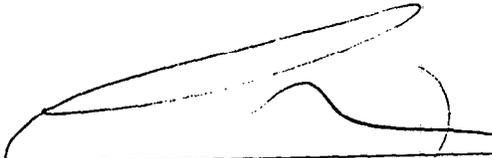
Samick has not suffered any damages as a result of the matters alleged in the Counterclaim.

Thirteenth Affirmative Defense

Samick's claims are barred in whole or in part by the applicable statute of limitations.

WHEREFORE, Lawrence requests that this Honorable Court dismiss Samick's Counterclaim.

Dated: June 13, 2002



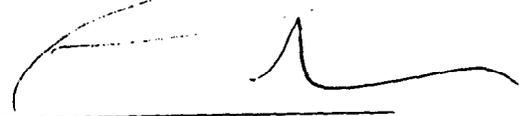
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CERTIFICATE OF SERVICE

I hereby certify that one (1) original of the foregoing Reply to Counterclaim with Affirmative Defenses was served on this 13th day of June, 2002, by depositing the same in the United States Mail, First Class, Postage Pre-Paid, upon the following:

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TTAB

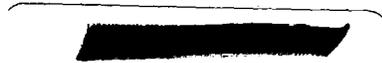


Writer's Direct Information
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April 29, 2003

VIA EXPRESS MAIL
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04-29-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22
APR 29 2003

Re: "Samick"
Serial No.: 76/342386

Dear Trademark Trial and Appeal Board:

Kindly find enclosed a **Request for an Extension of Time to File Notice of Opposition for Extraordinary Circumstances** with regard to the above-referenced mark. In the event that the Request is not granted, I have also enclosed a **Notice of Opposition** regarding the above-reference mark, as well as a **Motion to Stay Opposition**. All documents are in triplicate. The filing fee is enclosed, if necessary for filing of a Notice of Opposition.

Thank you for your attention in this regard; please call me if you have any questions.

Very truly yours,

Z E G A R E L L I
Technology & Entrepreneurial
Ventures Law Group, P.C.

By: Gregg R. Zegarelli/hq
Gregg R. Zegarelli, Esq.

Enclosures

cc. Lawrence Music, Inc.
(with enclosure)