

ESTTA Tracking number: **ESTTA704397**

Filing date: **10/26/2015**

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

Proceeding	91223882
Party	Defendant Samsung Electronics Co., Ltd.
Correspondence Address	DANIEL LANO IPHORGAN LTD 195 N ARLINGTON HEIGHTS RD , SUITE 125 BUFFALO GROVE, IL 60089-1768 UNITED STATES mail@iphorgan.net, dlano@iphorgan.net
Submission	Answer
Filer's Name	Christopher B. Lay
Filer's e-mail	clay@iphorgan.net, mail@iphorgan.net
Signature	/Christopher B. Lay/
Date	10/26/2015
Attachments	Answer - Final.pdf(457263 bytes)

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

EXPRESS COMMUNICATIONS, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91223882
)	Application Serial. No. 86391852
SAMSUNG ELECTRONICS CO., LTD.)	Mark: EXPRESS ME
)	
)	
Applicant.)	

ANSWER

Applicant Samsung Electronics Co., Ltd. (“Applicant”), by and through its attorneys IpHorgan Ltd, for its Answer to the Notice of Opposition filed by Express Communications, LLC (“Opposer”), alleges and states as follows:

Applicant denies each and every allegation contained in the un-numbered introductory paragraph of the Notice of Opposition.

1. Admitted.
2. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 of the Notice of Opposition and therefore denies each allegation.
3. Admitted.
4. Admitted.
5. Applicant denies each and every allegation contained in Paragraph 5 of the Notice of Opposition. In addition, the 60 day Request for Extension of Time to Oppose filed by Opposer on July 15, 2015, was filed without Applicant’s consent. Accordingly, Opposer did not file a proper Request for Extension of Time to Oppose, and the U.S.

- Trademark Trial and Appeal Board should dismiss the opposition for lack of jurisdiction.
6. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 6 of the Notice of Opposition and therefore denies each allegation.
 7. Applicant denies each and every allegation contained in Paragraph 7 of the Notice of Opposition.
 8. Applicant lacks sufficient information with which to form a belief as to the truth or falsity of the allegations contained in Paragraph 8 of the Notice of Opposition and therefore denies each allegation.
 9. Applicant denies each and every allegation contained in Paragraph 9 of the Notice of Opposition.
 10. Applicant denies each and every allegation contained in Paragraph 10 of the Notice of Opposition.
 11. Applicant denies each and every allegation contained in Paragraph 11 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

12. Lack of jurisdiction. The U.S. Trademark Trial and Appeal Board (the “Board”) lacks jurisdiction to adjudicate this opposition because Opposer did not file a proper Request for Extension of Time to Oppose prior to the July 15, 2015, deadline set forth in the Board Order of April 16, 2015. (Exh. 1.) Although Opposer styled its July 15, 2015, Request for Extension of Time to Oppose as one filed “with applicant’s consent” (Exh. 2), Applicant did not grant consent to the extension.

13. Specifically, Mr. Volk, Managing Member of Opposer, placed a telephone call on July 13, 2015, to Daniel Lano, one of the attorneys for Applicant. (Exh. 3, Lano Decl. ¶ 4.) During the conversation, Mr. Volk asked Mr. Lano for consent to file the request for extension of time. (*Id.*) Mr. Lano explicitly refused the request for consent. (*Id.*)
14. Mr. Volk sent an email to Mr. Lano approximately two hours after the phone call. (Exh. 4; Exh. 3 ¶ 5.) At the end of the email, Mr. Volk stated: “As I mentioned in our conversation, in lieu of filing an opposition, with the consent of Samsung, we’d like to file an additional 30 day extension of time to oppose. So please respond back to my request by this Wednesday 07/15” (Exh. 4.)
15. Mr. Lano did not respond to Mr. Volk’s email. (Exh. 3 ¶ 5.) No consent was provided by Applicant to Opposer. Because Opposer’s July 15, 2015, Request for Extension of Time to Oppose was filed without consent by the Applicant and without a showing of extraordinary circumstances, the Board could not grant and would not have granted an extension of time to file the opposition. 37 C.F.R. 2.102(c)(3).
16. The Board should dismiss the Opposition for lack of jurisdiction.
17. Unclean Hands. Applicant realleges and incorporates herein by reference the matters alleged in Paragraphs 12-16 of this Answer.
18. Opposer’s statement in its July 15, 2015, Request for Extension of Time to Oppose, that it was filed “with applicant’s consent” (Exh. 2), was a material, false representation of fact submitted in “bad faith for the improper purpose of obtaining a benefit from the Board to which opposer was not entitled.” *Central Mfg. Inc. v. Third Millenium Tech. Inc.*, 61 USPQ 2d 1210 (TTAB 2001).

19. But for Opposer's misrepresentation, the Board would not have granted Opposer's Request for Extension of Time to Oppose. 37 C.F.R. 2.102(c)(3).

20. Thus, the Board should dismiss the opposition for lack of jurisdiction. TBMP 211.02.

And, because of Opposer's bad faith and material, false representations of fact, the Board should exercise its inherent authority to dismiss the opposition with prejudice.

See Third Millenium, 61 USPQ 2d 1210.

WHEREFORE, Applicant respectfully requests that the Opposition to Application No. 86391852 for the mark EXPRESS ME be dismissed with prejudice, and in the alternative be denied, and that Applicant's mark be allowed to register.

DATED this Twenty-Sixth day of October, 2015

Respectfully submitted,

/Christopher B. Lay/
Christopher B. Lay
IpHorgan Ltd
195 Arlington Heights Rd.
Suite 125
Buffalo Grove, IL 60089
Telephone (847) 808-5500
Fax (847) 808-7238

EXHIBIT 1

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

Jeff Volk
Express Communications
PO Box 828
Pismo Beach, CA 93448

Mailed: April 16, 2015

Serial No.: 86391852
ESTTA TRACKING NO: ESTTA666939

The request to extend time to oppose is granted until **7/15/2015** on behalf of potential opposer **Express Communications**

Please do not hesitate to contact the Trademark Trial and Appeal Board at (571)272-8500 if you have any questions relating to this extension.

Note from the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, petition for cancellation, notice of ex parte appeal, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

EXHIBIT 2

ESTTA Tracking number: **ESTTA683953**

Filing date: **07/15/2015**

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

Applicant:	Samsung Electronics Co., Ltd.
Application Serial Number:	86391852
Application Filing Date:	09/11/2014
Mark:	EXPRESS ME
Date of Publication	03/17/2015

60 Day Request for Extension of Time to Oppose Upon Consent

Pursuant to 37 C.F.R. Section 2.102, Express Communications, PO Box 828, Pismo Beach, CA 93448, UNITED STATES respectfully requests that he/she/it be granted an additional 60-day extension of time to file a notice of opposition against the above-identified mark with applicant's consent.

The time within which to file a notice of opposition is set to expire on 07/15/2015. Express Communications respectfully requests that the time period within which to file an opposition be extended until 09/13/2015.

Respectfully submitted,

/Jeff Volk/
07/15/2015

Jeff Volk

Managing Member

Express Communications

PO Box 828

Pismo Beach, CA 93448

UNITED STATES

ExpressCommunications@RocketMail.com

805-542-0738

EXHIBIT 3

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

EXPRESS COMMUNICATIONS, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91223882
)	Application Serial. No. 86391852
SAMSUNG ELECTRONICS CO., LTD.)	Mark: EXPRESS ME
)	
)	
Applicant.)	

DECLARATION OF DANIEL LANO IN SUPPORT OF AFFIRMATIVE DEFENSES

I, Daniel Lano, declare as follows:

1. I am an attorney with the law firm IpHorgan Ltd, and one of the counsel of record for Applicant Samsung Electronics Co., Ltd., in *Express Communications, LLC v. Samsung Electronics Co., Ltd.*, Opposition No. 91223882, in the United States Patent and Trademark Office before the Trademark Trial and Appeal Board.
2. Express Communications, LLC (“Opposer”) filed on September 14, 2015, a Notice of Opposition against the EXPRESS ME trademark, U.S. Serial No. 86391852, owned by Samsung Electronics Co., Ltd. (“Applicant”).
3. Opposer filed two requests for extension of time to oppose. The first was filed on April 16, 2015, as a 90 day request based on good cause. The second request, filed by Opposer on July 15, 2015, – the deadline to file the opposition – was a 60 day extension request based on purported consent.
4. Two days earlier, on July 13, 2015, Mr. Volk, Managing Member of Opposer, called me at my office at about 1:30 p.m. Toward the end of the conversation, Mr. Volk

asked whether I would grant consent to a second extension of time to oppose. I told him no.

5. About two hours later, at 3:35 p.m., Mr. Volk sent an email to me, confirming his recollection of the contents of our earlier conversation. (See Exhibit 4 attached herein.) Mr. Volk concluded his email by reiterating his request for my client's consent to file another extension of time to oppose. Neither Samsung nor I, on behalf of Samsung, provided consent; in fact, I did not respond to Mr. Volk's request.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct, and that this declaration was executed on October 26, 2015, in Buffalo Grove, Illinois.


Daniel Lano

EXHIBIT 4

From: J V
Sent: Monday, July 13, 2015 3:35 PM
To: dlano@iphorgan.net
Subject: Express®, Express Yourself®, Ephone®, Etab™ & Xphone® Licensing/Acquisition Opportunity and request for consent for 30 day extension.
Attachments: Express TM Chart 03052015.pdf



Hi Daniel,

It was great to talk with you today.

As I mentioned in our conversation, we'd like to work out an amicable agreement with Samsung; In lieu of filing an opposition against their pending application for the intended mark Express Me, Ser. No. 86391852. It appears that Samsung might not be aware of our existence as well as our portfolio of TM's (see attached TM Chart), please forward this e-mail and information to Samsung for review. As I mentioned during our conversation, due to wireless technology market conditions, we have decided to license or possibly assign our Express® brands for phones, tablets and related to a larger company. Samsung is perfectly suited to acquire **Express®** U.S. Trademark Reg. No. 3026855. And our additional Express® family of affiliated brands **Ephone®** ("E" for Express®) Reg. No. 4106953), **Etab™** ("E" for Express®) Ser. Number. 85765586 and **Xphone®** (X for eXpress®), Ser. Number. 4505583 and other marks listed in TM Chart. -The saying "its all in the name" holds true more than ever.

There are many recent examples of successful joint ventures in the telecommunication space, such as the trademark license agreement between Lucasfilm® and Verizon® for the Droid™ brand. As well as the coexistence agreement between Cisco and Apple for the iPhone® mark, and the sale of the Sidekick® mark between Motorola® and T-Mobile®.

Express®, Ephone®, Etab™ & Xphone® flow and vocalize beautifully and instantly ring a bell in the minds of consumers worldwide. These are the best names for phones and tablets. The Express® "Word Mark" translates the same and is spelled the same in English, French, German and Spanish. Express® Reg. 3026855 is a "word mark" and some of our products have "Express®" spelled in varied ways on some of our products -eXpress & Xpress, so we have trademark protection for phonetic equivalent marks. Anyone can clearly see the incredible growth potential for these awesome flagship brands of Express®, it's obvious. The window of opportunity is better than ever for the future of these marks.

We applied for Trademark protection for our house brand of Express® more than 10 years ago (03/31/2004). Back in '04, in addition to selling our Express® brand, we were also selling a lot of other brands including Motorola®, Nokia®, Samsung®, Sony-Ericsson®, and T-Mobile® and other

products and services. Since the early 90's, we've been selling our Express® brand of products in addition to other great brands. We have come a long way from our humble beginnings at booths at Farmers markets, college campuses, retail locations and distributors around America; these awesome IP's obviously have a tremendously unlimited room for growth. In the early 90's we started selling our Express® products in addition to custom Motorola® Star-Tac's, Micro-Tac's, and custom Nokia's customized by Express®, among other phones and communications devices and accessories. In the early 2000's, we focused more on GSM phones and continued to sell our custom Express® brand of phones and accessories. All of these years, we've kept Express® alive, and now is the time to join with a larger company, pass the torch, so to speak.

As you know, there has been a trend in the mobile electronics industry in the last few years to use names for phone models instead of alpha numeric models. Samsung has been filing 100's of intent to use applications for every cool sounding name. Whereas, in 2004 we applied for trademark protection for our "Express" brand of phone products, after having engaged in commerce since the early 90's. Back in 2004 Samsung company phone model names were all alpha-numeric, such as X-105, and V-205. Samsung recently filed applications for Galaxy Express, Samsung Xpress, Samsung also recently filed for Express Me (which we filed an extension of time to oppose which expires on 07/15/15, and now they just filed for Galaxy Tab E. Technically all 4 of these Samsung marks should of been refused because of Trademark Section 2D, likelihood of confusion and because of priority of registrant, as well as TMEP §1207.01(b)(iii). -Express® is the same as Xpress and Etab™ is the same as Tab E. The root brand Express® is better than longer marks derived Express®.

A few years ago T-Mobile company was refused for their application to register "Express" in association with trademark class 9 cell phone products. Please see attached PDF of USPTO examining attorney office actions and refusals in USPTO application for serial number 77491117. The USPTO examining attorney made final refusals of the application by T-Mobile for IC classes 009 because of likelihood of confusion with our mark "Express®" 3026855. If T-Mobile contacted us prior to applying for "Express" they would find out that we are looking to team up with a larger company in order to build our "Express" brand up to the next level, however, we reserve our rights to find the best candidate, and we stand up for our trademark rights. We firmly believe Samsung to be a better candidate work with on expanding our IP's.

Recently a USPTO examining attorney issued final refusal for mark: "Express Tablet" for: Computer cursor control devices, namely, digitizer tablets; Electronic device to charge and secure tablet PCs; Electronic writing tablets; PC tablets; Protective covers and cases for tablet computers; Tablet computer. -The logic and and comprehensive case law supporting the refusal was solid. Please see attached PDF of USPTO examining attorney office actions and refusals in USPTO application for serial number 85688464.

We have maintained our pristine Express® brands, and very selectively built and maintained our distribution channels for the last 20 years, however, now it's time for these incredible brands to go to the "Big Leagues". As I mentioned in our conversation, in lieu of filing an opposition, with the consent of Samsung, we'd like to file an additional 30 day extension of time to oppose. So please respond back to my request by this Wednesday 07/15, so that we can have so that we can avoid an opposition and have more time to reach a fair and equitable agreement with Samsung.

Thanks, Excellent Regards,

Jeff Volk
Managing Member

Express Communications LLC

PO Box 828
Pismo Beach, CA 93448

Tel: 805-542-0738, 1-866-867-9939
ExpressCommunications@RocketMail.com

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER has been served on the Opponent's Attorney of Record, Matthew M. Googe, by mailing said copy on October 26, 2015, via First Class Mail, postage prepaid, to:

Matthew M. Googe
Robinson IP Law, PLLC
9724 Kingston Pike, STE 1403
Knoxville, TN. 37922

/Christopher B. Lay/
Christopher B. Lay

10/26/15
Date