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Filing date: **10/29/2015**

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

Proceeding	91223940
Party	Defendant Samsung Electronics Co., Ltd.
Correspondence Address	JAY F MOLDOVANYI FAY SHARPE LLP 1228 EUCLID AVE FL 5 CLEVELAND, OH 44115-1834 UNITED STATES jmoldovanyi@faysharpe.com
Submission	Answer and Counterclaim
Filer's Name	Christopher B. Lay
Filer's e-mail	clay@iphorgan.net, mail@iphorgan.net
Signature	/Christopher B. Lay/
Date	10/29/2015
Attachments	As Filed - Answer and Counterclaims for Cancellation.pdf(690035 bytes )

**Registrations Subject to the filing**

Registration No	3937502	Registration date	03/29/2011
Registrant	EXPRESS COMMUNICATIONS PO BOX 2212 LOMPOC, CA 93438 UNITED STATES		

**Goods/Services Subject to the filing**

Class 035. First Use: 2002/12/26 First Use In Commerce: 2002/12/26

All goods and services in the class are requested, namely: Retail and wholesale stores services featuring electronic devices, devices capable of storing, producing, transmitting, receiving of data, and signals such as sound, images, video, and text, namely, transceivers, telephones, cellular or mobile telephones and fax machines; Retail and wholesale stores services featuring electronic goods and accessories, namely, internal and external components, antennas, vehicle chargers, outlet chargers, batteries, hands-free headsets, carrying cases, pouches, holsters, vehicle mountings, housings, face plates and customizing

Registration No	3913116	Registration date	02/01/2011
Registrant	EXPRESS COMMUNICATIONS PO BOX 2212 LOMPOC, CA 93438 UNITED STATES		

**Goods/Services Subject to the filing**

Class 035. First Use: 1991/06/01 First Use In Commerce: 1992/12/13

All goods and services in the class are requested, namely: Advertising and promotional services; Retail and wholesale stores services featuring electronic devices, devices capable of storing, producing, transmitting, receiving of data, and signals such as sound, images, video, and text, namely, transceivers, telephones, cellular or mobile telephones and fax machines; Retail and wholesale stores services featuring electronic goods and accessories, namely, internal and external components, antennas, vehicle chargers, outlet chargers, batteries, hands-free headsets, carrying cases, pouches, hol-

sters, vehicle mountings, housings, face plates and customizing

Registration No	3026855	Registration date	12/13/2005
Registrant	EXPRESS COMMUNICATIONS PO BOX 2212 LOMPOC, CA 93438 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

### Goods/Services Subject to the filing

Class 009. First Use: 1991/06/01 First Use In Commerce: 1992/12/13

All goods and services in the class are requested, namely: apparatus for producing sound, images or audio, video and data communications systems, namely, electronic and optical instruments and components in the form of digital and analog signal transmitters, receivers and converters, radio and telephone transmitters, receivers [ and communications servers] ; telephones, wireless and cellular telephones [ and answering machines, ] telecommunication transmission, receiving, and storage apparatus, namely, telecommunication transceivers, data transmitters, [ facsimile machines, electronic mail apparatus for electronic exchange of data images and messages, pagers, paging equipment, facsimile transmitters and receivers, wireless fax machines, ] cellular telephone accessories, namely, protective leather cases for cellular telephones, specialty holsters for carrying cellular telephones, cellular telephone housings, hands-free head sets for cellular telephones

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

EXPRESS COMMUNICATIONS, LLC, )  
 )  
           Opposer, )  
 )  
           v. )  
 )  
 SAMSUNG ELECTRONICS CO., LTD. )  
 )  
 )  
           Applicant. )

Opposition No. 91223940  
Application Serial. No. 85799934  
Mark: SAMSUNG XPRESS

**ANSWER AND COUNTERCLAIMS FOR CANCELLATION**

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 2 of the Notice of Opposition and therefore denies each allegation.
3. Applicant denies that it filed the application under Section 44(d) of the Trademark Act. Applicant admits the remaining allegations in Paragraph 3 of the Notice of Opposition.
4. Admitted.
5. Applicant denies each and every allegation contained in Paragraph 5 of the Notice of Opposition.

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. The Opposition and the relief sought therefrom should be denied under the Doctrine of Unclean Hands.

WHEREFORE, Applicant Samsung Electronics Co., Ltd., respectfully requests that the Opposition to Application No. 85799934 for the mark SAMSUNG XPRESS be denied and that Applicant's mark be allowed to register.

**COUNTERCLAIMS FOR CANCELLATION OF  
OPPOSER’S U.S. REGISTRATION NOS.  
3937502, 3913116, AND 3026855**

Applicant counterclaims for cancellation of Opposer’s U.S. Registration Nos. 3937502 (EXPRESS YOURSELF), 3913116 (EXPRESS), and 3026855 (EXPRESS) on the ground of non-use and abandonment. Opposer does not use and has not used any of the marks in U.S. commerce in connection with any of the asserted goods and services, and has instead intended merely to reserve rights in the marks. Accordingly, the Board should cancel each of the three registrations asserted by Opposer in Opposition No. 91223940.

**FACTS COMMON TO ALL CLAIMS**

1. Applicant Samsung Electronics Co., Ltd., the Petitioner in the Counterclaims for Cancellation (“Samsung”, “Applicant”, or “Petitioner”), is a South Korean corporation with an address of 129 Samsung-ro, Yeongtong-gu, Suwon-si Gyeonggi-do, Republic of Korea.

2. Opposer Express Communications, LLC, the Respondent in the Counterclaims for Cancellation (“Opposer” or “Respondent”), purports to be a limited liability company of the State of Nevada having an address of P.O. Box 2212, Lompoc, California 93448.

3. Opposer asserts that it owns U.S. Registration 3937502 for EXPRESS YOURSELF in International Class 35.

4. Opposer asserts that it owns U.S. Registration 3913116 for EXPRESS in International Class 35.

5. Opposer asserts that it owns U.S. Registration 3026855 for EXPRESS in International Class 9.

6. On September 21, 2015, Opposer, asserting U.S. Registration Nos. 3937502, 3913116, and 3026855, filed a Notice of Opposition against Applicant's applied-for SAMSUNG XPRESS mark, U.S. Serial No. 85799934.

7. Applicant Samsung has standing to assert its Counterclaims based on its position as the defendant in the opposition initiated by Opposer, Opposition No. 91223940.

**Opposer Does Not Use Its Asserted Marks**

8. On information and belief, Opposer currently has no "brick and mortar" location from which it can render the Class 35 retail and wholesale store services described in its 3937502 and 3913116 registrations.

9. The photograph on the lower right corner of page 2 of the current home page of Opposer's website, as seen in Exhibit 1, purporting to show an Express establishment, is misleading at best. On information and belief, that establishment could not have existed after 2007. (*See also* Exh. 2, enlarged screen shot of photograph.) No evidence suggests the establishment represented in the photograph ever existed. No evidence has been found showing an alternate street location.

10. The home page referenced in Paragraph 9, including the misleading photograph, is virtually identical to the specimen Opposer used in support of its Declaration of Use and Incontestability in connection with the 3026855 registration. (Exh. 3.)

11. Moreover, Opposer's website, [express.fm](http://express.fm), whose top level domain is the country code for the Federated States of Micronesia, is static; nothing can be purchased or even perused on the website.

12. Indeed, on information and belief, no information concerning any of Opposer's goods and services as claimed in the asserted registrations can be found on the Internet.

13. In sum, on information and belief, Opposer has not used and does not intend to use its asserted marks in commerce, and at most is using those marks to reserve rights and to parlay those purported rights into licensing agreements.

14. Because Opposer has not used any of its three marks in commerce since their registration dates, the most recent being March 29, 2011, for U.S. Registration No. 3937502, Opposer's nonuse exceeds three consecutive years, providing *prima facie* evidence of abandonment and an inference that Opposer intends not to resume use (if indeed there ever was use) of its asserted marks.

**COUNTERCLAIM I**  
**(Abandonment of U.S. Registration No. 3937502)**

15. Applicant realleges and incorporates herein by reference the matters alleged in Paragraphs 1-14 of this Complaint.

16. Opposer has not used the EXPRESS YOURSELF mark, U.S. Registration No. 3937502, in commerce in connection with any of the asserted Class 35 services for at least three consecutive years immediately preceding the filing of this Answer And Counterclaims For Cancellation.

17. On information and belief, Opposer has never rendered in commerce the Class 35 services identified in the EXPRESS YOURSELF mark, U.S. Registration No. 3937502.

18. On inference and belief, to the extent Opposer has ever used the EXPRESS YOURSELF mark, U.S. Registration No. 3937502, in commerce in connection with any of the asserted Class 35 services, Opposer has long since discontinued use of the mark and has no intent to resume such use.

19. Accordingly, Opposer has abandoned U.S. Registration No. 3937502. The Board should cancel the registration in its entirety.

**COUNTERCLAIM II**  
**(Abandonment of U.S. Registration No. 3913116)**

20. Applicant realleges and incorporates herein by reference the matters alleged in Paragraphs 1-19 of this Complaint.

21. Opposer has not used the EXPRESS mark, U.S. Registration No. 3913116, in commerce in connection with any of the asserted Class 35 services for at least three consecutive years immediately preceding the filing of this Answer And Counterclaims For Cancellation.

22. On information and belief, Opposer has never rendered in commerce the Class 35 services identified in the EXPRESS mark, U.S. Registration No. 3913116.

23. On inference and belief, to the extent Opposer has ever used the EXPRESS mark, U.S. Registration No. 3913116, in commerce in connection with any of the asserted Class 35 services, Opposer has long since discontinued use of the mark and has no intent to resume such use.

24. Accordingly, Opposer has abandoned U.S. Registration No. 3913116. The Board should cancel the registration in its entirety.

**COUNTERCLAIM III**  
**(Abandonment of U.S. Registration No. 3026855)**

25. Applicant realleges and incorporates herein by reference the matters alleged in Paragraphs 1-24 of this Complaint.

26. Opposer has not used the EXPRESS mark, U.S. Registration No. 3026855, in commerce in connection with any of the asserted Class 9 goods for at least three consecutive years immediately preceding the filing of this Answer And Counterclaims For Cancellation.

27. On information and belief, Opposer has never used in commerce the Class 9 goods identified in the EXPRESS mark, U.S. Registration No. 3026855.

28. On inference and belief, to the extent Opposer has ever used the EXPRESS mark, U.S. Registration No. 3026855, in commerce in connection with any of the asserted Class 9 services, Opposer has long since discontinued use of the mark and has no intent to resume such use.

29. Accordingly, Opposer has abandoned U.S. Registration No. 3026855. The Board should cancel the registration in its entirety.

**PRAYER FOR RELIEF**

WHEREFORE, Applicant respectfully requests judgment as follows:

1. That Opposer's Opposition be dismissed and Applicant's mark allowed to proceed to registration; and

2. That Opposer/Respondent's asserted registrations, U.S. Registration Nos. 3937502, 3913116, and 3026855, be cancelled in their entireties.

DATED this Twenty-Ninth 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**

# Express<sup>®</sup>

PRODUCTS

SERVICES



-Your communications devices are a big part of your life, and we're here to help provide you with the best combination of products and services to keep you in contact. -We counsel you to help custom tailor to your individual communications needs, you are a VIP.

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-Everything you need from mobile phones and land line phones, walkie-talkies, to tablets and all accessories, unlimited voice/data plans and Cloud services.

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**Express<sup>®</sup>**

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Call to place an order, for advisors & locations

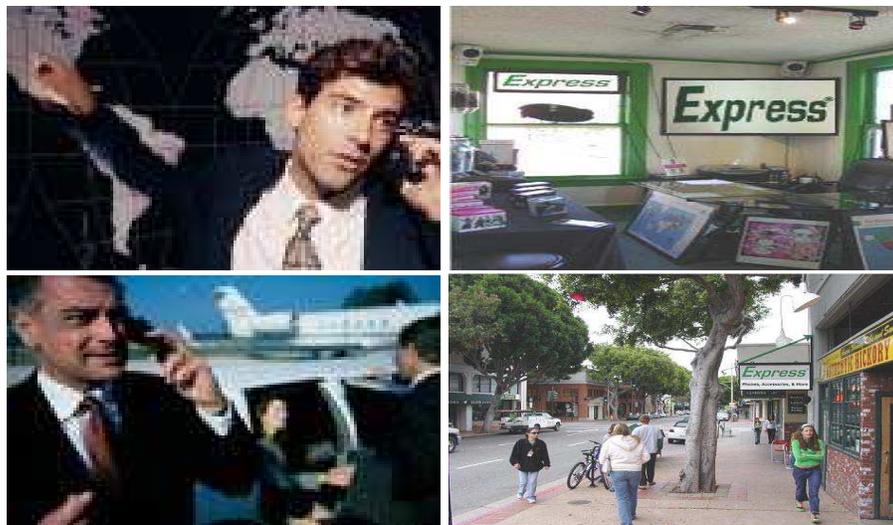
-We proudly feature our **Express<sup>®</sup>** family of brands including **Ephone<sup>®</sup>** and **Xphone<sup>®</sup>**, additionally, we carry products by Apple<sup>®</sup>, LG<sup>®</sup>, HTC<sup>®</sup>, Nokia<sup>®</sup>, Motorola<sup>®</sup>, Samsung<sup>®</sup>, and other great brands, as well as hard to find vintage phones, cell phones, and accessories for all phones and tablets.

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**"We treat you the best & give you the Most"**



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# **EXHIBIT 2**



# **EXHIBIT 3**

# Express®

PRODUCTS

SERVICES



-Your communications devices are a big part of your life, and we're here to help provide you with the best combination of products and services to keep you in contact. -We counsel you to help custom tailor to your individual communications needs, you are a VIP.

-We provide nationwide/worldwide communications -Everything from cell phones and land line phones, to walkie-talkies and all accessories, and unlimited voice/data plans

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"We treat you the best & give you the most"



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

EXPRESS COMMUNICATIONS, LLC, )  
)  
Opposer, )  
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v. )  
)  
SAMSUNG ELECTRONICS CO., LTD. )  
)  
)  
Applicant. )

Opposition No. 91223940  
Application Serial. No. 85799934  
Mark: SAMSUNG XPRESS

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing ANSWER AND COUNTERCLAIMS FOR CANCELLATION has been served on the Opposer's Attorney of Record, Matthew M. Googe, by sending said copy on October 29, 2015, via overnight courier, postage prepaid, to:

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

/Christopher B. Lay/  
Christopher B. Lay

10/29/15  
Date