

ESTTA Tracking number: **ESTTA771931**

Filing date: **09/21/2016**

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

Proceeding	91230032
Party	Defendant J.G.B. Enterprises, Inc.
Correspondence Address	BERNHARD P. MOLLDREM, JR. LAW OFFICE OF BERNHARD MOLLDREM 224 HARRISON STREET SUITE 200 SYRACUSE, NY 13202 molldrem@dreamscape.com;jody.sadler@verizon.net
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Bernhard P Molldrem Jr
Filer's e-mail	molldrem@dreamscape.com, jody.sadler@verizon.net
Signature	/BMolldrem/
Date	09/21/2016
Attachments	032ApplMotion.pdf(4090625 bytes) 032AttyAff.pdf(975405 bytes) 032ExhibitA.pdf(1911525 bytes) 032ExhBC.pdf(2328023 bytes) 032JDF-Aff.pdf(70220 bytes)

2. Applicant JGB has been marketing one particular hose under the trademark J-FLEX since at least as early as March 2007, and continues to market that hose under the J-FLEX mark.

3. Applicant JGB filed its application to register its J-FLEX mark as Appln. Ser. No. 86/861,515 on December 30, 2015.

4. Applicant's subject trademark J-FLEX was published in the Trademark Official Gazette on May 17, 2016.

5. On or about June 8, 2016, attorney Tyson Smith, associate at the law firm Pirkey Barber, PLLC, Austin, Texas, sent a letter to the undersigned, a true copy whereof is attached as Exhibit A to the accompanying Attorney Affirmation. The FedEx delivery record, attached to this letter in Exhibit A indicates that the letter did not arrive at the undersigned's address until 10:30 AM on Thursday, June 9, 2016. This was the first contact by Exxon Mobil or anyone connected with Exxon Mobil to anyone on Applicant JGB's side concerning the Applicant's J-FLEX trademark. Mr. Tyson's letter made a cease-and-desist demand at the bottom of page 1, and then at the top of page 2 requested a response. There is no mention anywhere in this letter about any ongoing settlement discussions, as there were none.

6. Applicant's undersigned attorney, after consultation with Applicant JGB, responded to

Mr. Tyson Smith on June 27, 2016, and true copy of that letter of response appears as Exhibit B to the Attorney Affirmation. This June 27 letter was the first communication from JGB's side to anyone connected with Opposer concerning Opposer's dispute over JGB's J-FLEX mark.

7. This June 27 letter made it clear that JGB saw no reasonable likely confusion as between JGB's J-FLEX mark and Exxon Mobil's asserted registered mark JAYFLEX, and further that JGB saw no realistic issue of either blurring or tarnishment.

8. The June 27, 2016, letter, on page 2 also notified attorney Tyson Smith, and his client, that the opposer's request for a 90-day extension (which requires a showing of good cause), rather than a 30-day extension (which is granted for the asking), was applied for on a basis that was contrary to the truth: Opposer Exxon Mobil had justified its 90-day extension request with the statement: "the potential opposer [Exxon Mobil] is in settlement discussions with applicant [JGB]" whereas in fact no such settlement discussions were taken place nor had ever taken place. There were no ongoing settlement discussions concerning JGB's J-FLEX mark, nor had the subject of settlement discussions even been raised in the opposer's counsel's June 8, 2016, letter. There were no settlement discussions of any sort between the parties prior to the June 8, 2016, date of the signing and filing of Opposer's extension of time request. That request was filed in the Office the same day as Opposer's counsel sent out the initial contact letter (Exhibit A), i.e., the first time that Applicant could have learned that there was any dispute to settle. In fact the first response to Opposer's counsel's June 8, 2016 letter was Applicant's counsel's June 27,

2016, letter, and neither one mentions or suggests settlement discussions.

9. A true copy of the Opposer's "First 90 Day Request for Extension of Time to Oppose for Good Cause" is attached as Exhibit C to the Attorney Affirmation. This request bears the name and electronic signature of "Philip Davidson", purporting to be Trademark Counsel for Exxon Mobil Corporation. The Request contains the affirmative statement that "potential opposer believes that good cause is established for this request by: - the potential opposer is engaged in settlement discussions with the applicant." It is this statement that is the basis of Applicant's averment that the Request was submitted in bad faith. The aforesaid statement was made in this paper signed by attorney Philip Davidson, and of which attorney Tyson Smith was presumed to be aware, and was most certainly made aware by the June 27, 2016, letter from Applicant JGB's counsel. Mr. Davidson's statement was made prior to any contact whatever with Applicant JGB, and certainly prior to the time that any settlement discussions could have been possible. In fact no settlement discussions about the subject trademark have ever taken place between these parties.

10. Applicant JGB is also attaching a supporting Affirmation or Declaration of Mr. Joseph DeFino, Vice President of Operations of Applicant JGB, stating that no one from Opposer Exxon Mobil or anyone on their behalf has ever contacted anyone at JGB to discuss Applicant's J-FLEX mark, Opposer's JAYFLEX mark, or to settle any trademark dispute whatever between these parties.

11. Opposer Exxon Mobil filed its Notice of Opposition for this proceeding on September 14, 2016, which was within the 90-day extension period (which would have expired on that date), but was well past the maximum of a 30-day extended period to which Opposer *would* have been entitled without a need to show good cause.

12. The rules of opposition practice are quite clear about improper requests for extensions of time to oppose, and after an opposition has been filed an instituted. See TBMP, Section 211.02. Applicant may raise the issue of the “good cause showing” statement having been made in bad faith by means of a motion to dismiss for lack of jurisdiction (as untimely).

13. In the case of an opposer’s false and bad faith assertions of good cause for an extension request, the Board should grant Applicant’s motion to dismiss. In *Central Mfg. V. Third Millennium Tech.*, 61 USPQ2d 1210 (TTAB 2001), the Board dismissed an opposition where the opposer had alleged consent to extend where the applicant had given no such consent. See also *Cass Logistics v. McKesson*, 27 USPQ2d 1075, n.2 (TTAB 1993).

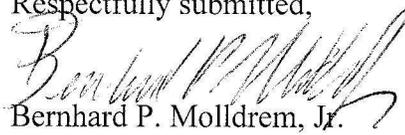
14. Moreover, appropriate relief is also available in the way of sanctions, and it is well within this Board’s inherent authority to sanction an opposer or an opposer’s legal representative for any bad-faith misconduct. *Central Mfg. v. Third Millennium, supra*; at 1213 ff; *NMS Res. Corp. v. Microsoft*, 113 USPQ2d 1029 (TTAB 2014); *High Beam Marketing v. Highbeam Research*, 85 USPQ2d 1902 (TTAB 2008).

15. In this matter, one or both signatory counsel, Mr. Tyson Smith and Mr. Philip Davidson, were aware that there were no ongoing settlement negotiations with JGB and that there had been none, yet nonetheless Exxon Mobile through its counsel went ahead and requested a 90-day extension, asserting “good cause” in bad faith. The taint of bad faith, even if on the part of a legal representative, attaches also to the principal Exxon Mobil. Under Rule 11 of the Federal Rules of Civil Procedure, any attorney or agent who signs his or her name to a paper submitted to this Board bears a personal and professional responsibility to certify the truth and reasonableness of the statements made in the paper.

16. In the above-cited *Central Manufacturing* case, the Board decided that for an opposer’s false statements made in an unwarranted extension of the time to oppose, the appropriate sanction would be (for that signatory) a requirement that “for any request for an extension of an opposition period in which it is alleged that the requested extension is on consent, or has been agreed to, or in which there is an allegation of any type of settlement discussion, to include a written agreement from the applicant to the truth of the allegation.” In *Central Manufacturing*, the opposer signatory was a pro-se, not represented by counsel. Where, as here, the opposer is professionally represented by counsel who ought to know better, the Board would be well within its discretion to impose a much stiffer sanction, restricting counsel’s future activity in a way that is more likely to discourage the submission of statements not made in good faith.

In view of the foregoing averments and the facts presented, Applicant JGB respectfully requests an ORDER from this Board dismissing this opposition with prejudice, and imposing such sanctions upon Opposer and/or Opposer's legal representatives as the Board deems sufficient to discourage further bad-faith conduct.

Respectfully submitted,



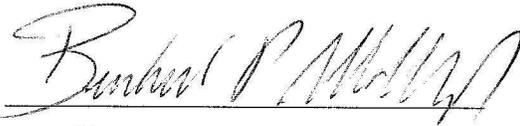
Bernhard P. Mollrem, Jr.
Attorney for Applicant

Law Office of Bernhard Mollrem
224 Harrison Street, Suite 200
Syracuse NY 13202
(315) 422-4323

Certificate of Service

I certify that a true and complete copy of the foregoing Motion to Dismiss Opposition, including Attorney Affirmation and Exhibits A, B, and C, and supporting Affirmation of Joseph DiFino, has been served THIS DATE on Tyson D. Smith, Pirkey Barber PLLC, 600 Congress Ave., Suite 2120, Austin, TX 78701 via First Class mail, postage pre-paid.

Signed



This 21st September, 2016.

Trademark Trial and Appeal Board Electronic Tracking Service, TTABVue.

The foregoing statements were made with the knowledge that willful false statements and the like so made may be punishable by fine, or imprisonment, or both, and that such false statements may jeopardize the trademark application or any registration ensuing thereon.

Dated Sept 21st, 2016

Signed Bernhard P. Molldrem, Jr.

Bernhard P. Molldrem, Jr.
Attorney for Applicant

Law Office of Bernhard Molldrem
224 Harrison Street, Suite 200
Syracuse NY 13202
(315) 422-4323

EXHIBIT A



Tyson Smith, Associate
(512) 482-5246 (direct)
tsmith@pirkeybarber.com

June 8, 2016

VIA EMAIL: MOLLDREM@DREAMSCAPE.COM
VIA OVERNIGHT MAIL

Bernhard P. Molldrem, Jr.
Law Office of Bernhard Molldrem
224 Harrison Street
Syracuse, NY 13202

Re: Unauthorized use of and application to register the mark J-FLEX
(Matter No. EXCO316)

Dear Mr. Molldrem:

This firm represents Exxon Mobil Corporation and its affiliated companies (collectively "ExxonMobil") in trademark, unfair competition, and related matters. We write concerning the use of and application to register the mark J-FLEX by your client J.G.B. Enterprises, Inc.

ExxonMobil is a major global producer of plasticizers, and for more than 50 years has widely and continuously used the mark JAYFLEX in connection with the sale and promotion of its plasticizer products. ExxonMobil also owns an incontestable federal registration for JAYFLEX for plasticizers. *See* U.S. Reg. No. 904,548. In order to protect the goodwill it has developed in its mark JAYFLEX and to ensure that consumers may continue to rely on that mark, ExxonMobil cannot permit the unauthorized use or registration of any confusingly similar marks.

It has come to our attention that your client J.G.B. Enterprises, Inc. is using the mark J-FLEX for a line of hydraulic hoses made of synthetic rubber. Your client has also filed Application Serial No. 86/861,515 with the U.S. Patent and Trademark Office seeking to register J-FLEX for "hydraulic hose formed of reinforced SBR rubber for use in industrial hydraulic systems and heavy equipment" in Class 17.

We are concerned that your client's use and registration of the mark J-FLEX is likely to confuse consumers into believing that its products are made by or from materials provided by ExxonMobil, or are in some other way affiliated with or authorized by ExxonMobil. We are also concerned that such use and registration is likely to dilute the distinctiveness of ExxonMobil's well known JAYFLEX mark.

We therefore request that your client (1) agree to permanently cease all use of the mark J-FLEX (and any other confusingly similar mark); (2) promptly abandon U.S. Application Serial No. 86/861,515; and (3) agree that it will not use or attempt to register the mark J-FLEX (or any other confusingly similar mark) in any manner in the future.

June 8, 2016

Page 2

We request your response within ten days of your receipt of this letter giving your assurance that your client will promptly comply with the above requests. Thank you for your prompt attention to this matter.

Very truly yours,



Tyson Smith

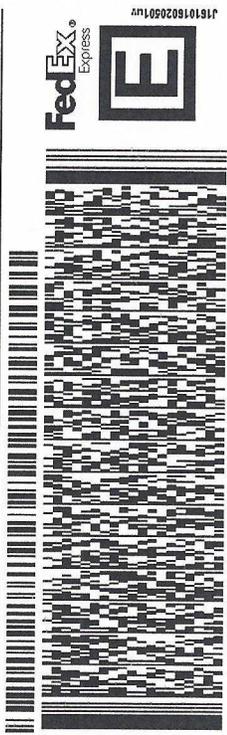
ORIGIN ID:ALISA (512) 322-5200
TYSON SMITH
PIRKEY BARBER PLLC
600 CONGRESS AVE
STE 2120
AUSTIN, TX 78701
UNITED STATES US

SHIP DATE: 08 JUN 16
ACT WGT: 0.10 LB
CAD: 1177909WNET3730
BILL SENDER

TO **BERNHARD P. MOLL DREM, JR.**
LAW OFFICE OF BERNHARD MOLL DREM
224 HARRISON STREET

540280BD/77F

SYRACUSE NY 13202
(512) 322-5200 REF: EXC0316
INV. PO. DEPT:



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Applicant's Motion to Dismiss
Opposition 91-230,032

EXHIBIT B

BERNHARD P. MOLLDDREM, JR.

mollddrem@dreamscape.com

(315) 422-4323
FAX (315) 422-4318

JODY L. SADLER, Paralegal

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SYRACUSE, NEW YORK 13202

INTELLECTUAL PROPERTY LAW
INCLUDING PATENTS, TRADEMARKS
COPYRIGHTS, TRADE SECRETS
AND RELATED LITIGATION

June 27, 2016

Tyson Smith
Pirkey Barber PLLC
600 Congress Avenue
Suite 2120
Austin TX 78701

Matter of J.G.B. Enterprises
Trademark Appln. Ser. No. 86/861,515 – J-Flex

Dear Mr. Smith:

We are in receipt of your letter dated June 8, 2016, alleging likely confusion of our client's J-Flex mark with that of Exxon Mobil's registered trademark JAYFLEX for plasticizers. We also note your request for a ninety-day extension of time to oppose registration of JGB's mark.

When we consider JGB's and your client's marks, each taken as a whole for the products they identify, our conclusion is that there is no reasonable likelihood of confusion as between "JAYFLEX" for plasticizers and "J-Flex" for hydraulic hoses formed of SBR rubber for use in industrial hydraulic systems and heavy equipment. The two marks are different, the two products are different, and the products travel in different streams of commerce to different customers. For each product, the customers are sophisticated enough not to confuse either the products or the marks, nor to confuse the sources of the two products. Moreover, both products have been marketed for quite some time under their respective trademarks without any issues of customer confusion.

Furthermore, there is no realistic issue of either blurring or tarnishment arising from my client's use of "J-Flex" on their hydraulic hoses. JGB's use of J-Flex does not impair any distinctiveness that your client's JAYFLEX mark may have, any more than would long-standing and continuing third-party use of "J-Flex" for unrelated goods, such as golf equipment, footwear, abrasives, or veterinary treatments. Your client's JAYFLEX mark, on a product directed only to the plastics industry, has not achieved fame sufficient that "JAYFLEX" can be said to have become part of the popular culture of the United States.

B-1

BERNHARD P. MOLLDREM

TM App. Ser. No. 86/861,515

June 27, 2016

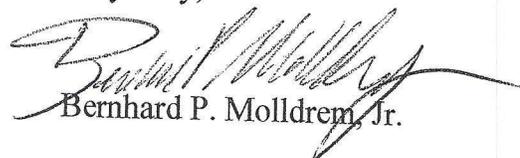
We ask that your client drop any objection to JGB's registration of its J-Flex mark for hydraulic hoses, as any continued effort to oppose registration would only be a waste of time and resources for both JGB and Exxon Mobil.

We also note that your client has justified its request for a ninety-day extension, rather than a thirty-day extension, on the stated basis that "the potential opposer is in settlement discussions with applicant." That statement is contrary to the truth. We are not, and have not ever been in settlement talks about registration of the J-Flex trademark. In fact, your client's request for the ninety-day extension of time to oppose was submitted to the USPTO on the same day as your June 8, 2016, letter, which we have not until just now responded to. That letter was the first time JGB was made aware of any potential conflict as between the JAYFLEX and J-Flex marks.

Please be aware that under the rules of practice before the USPTO, in particular, 37 CFR § 11.18(b)(1), the attorney's signature on anything submitted, even including a request for extension of time, means that all statements made in the submission are certified by the signatory as being true or if made on information and belief (after reasonable inquiry) are believed to be true. Here the statement about being in settlement talks was not true nor could it have been believed to be true. Any such false statement would subject the signatory to criminal penalties, and under §§11.18 (c) and (d) can also result in termination of any opposition proceeding and/or subject the practitioner to disciplinary action.

Please let us have your response to this letter, that your client has lost interest in opposing my client's J-Flex trademark.

Very truly,


Bernhard P. Molldrem, Jr.

BPM/mbs

B2

Applicant's Motion to Dismiss
Opposition 91-230,032

EXHIBIT C

ESTTA Tracking number: **ESTTA751190**

Filing date: **06/08/2016**

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

Applicant: **J.G.B. Enterprises, Inc.**
Application Serial Number: **86861515**
Application Filing Date: **12/30/2015**
Mark: **J-FLEX**
Date of Publication: **05/17/2016**

First 90 Day Request for Extension of Time to Oppose for Good Cause

Pursuant to 37 C.F.R. Section 2.102, Exxon Mobil Corporation, 5959 Las Colinas Blvd., Irving, TX 75039, UNITED STATES, a corporation organized under the laws of New Jersey, respectfully requests that it be granted a 90-day extension of time to file a notice of opposition against the above-identified mark for cause shown.

Potential opposer believes that good cause is established for this request by:

- The potential opposer is engaged in settlement discussions with applicant

The time within which to file a notice of opposition is set to expire on 06/16/2016. Exxon Mobil Corporation respectfully requests that the time period within which to file an opposition be extended until 09/14/2016.

Respectfully submitted,
/Philip Davison/
06/08/2016

Philip Davison

Trademark Counsel

Exxon Mobil Corporation

22777 Springwoods Village ParkwayEnergy 2, 4A.341

Spring, TX 77389

UNITED STATES

philip.m.davison@exxonmobil.com

832-625-0607

our trademark J-FLEX that we had been using on certain hydraulic hoses. On or about June 9 or June 10 2016, Mr. Molldrem sent me a copy of that letter of June 8, 2016.

Up until that time, I was not aware of Exxon Mobil's JAYFLEX trademark, and was not aware that Exxon Mobil saw any conflict between our J-FLEX trademark and their JAYFLEX trademark. No one from Exxon Mobil had contacted us about that, nor had anyone representing Exxon Mobil. To the best of my knowledge, no one else at J.G.B. Enterprises had heard from anyone at Exxon Mobil about any intellectual property matters and certainly not about any conflict between our J-FLEX and their JAYFLEX. We have not been in settlement discussions of any sort with anyone at Exxon Mobil, either before or after June 8, 2016.

I hereby declare that all statements appearing above that are of my own knowledge are true and that statements made on information and belief are believed to be true, and that I have been duly warned that any false statements or the like so made may be punishable by fine, imprisonment, or both and that any such false statements can adversely affect the validity any trademark registration that we may obtain on this matter.

9-20-16
Date


Joseph DeFino