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Filing date: **10/10/2016**

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

Proceeding	91230032
Party	Plaintiff Exxon Mobil Corporation
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Signature	/TDS/
Date	10/10/2016
Attachments	Response to Motion to Dismiss w-exs.pdf(890421 bytes)

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

In Re Serial No. 86/861,515	§	
Filed: December 30, 2015	§	
Mark: J-FLEX	§	
Published: May 17, 2016	§	
	§	
EXXON MOBIL CORPORATION,	§	
	§	Opposition No. 91230032
Opposer,	§	
	§	
v.	§	
	§	
J.G.B. ENTERPRISES, INC.,	§	
	§	
Applicant.	§	

OPPOSER’S RESPONSE TO APPLICANT’S MOTION TO DISMISS OPPOSITION

Before commencing this opposition proceeding, Opposer ExxonMobil requested a ninety-day extension of time to oppose. Based on its knowledge that it had sent (through counsel) a letter to Applicant J.G.B. Enterprises, Inc. before filing the request and its experience that settlement discussions are often initiated by sending such a letter, ExxonMobil asserted in good faith that settlement discussions were the “good cause” basis for the extension request. Because ExxonMobil properly identified the “good cause” for the extension request, Applicant’s Motion to Dismiss Opposition (4 TTABVUE) (the “Motion”) should be denied in its entirety, including Applicant’s request for sanctions.

I. Standard for Requesting a Ninety Day Extension of Time

A potential opposer may request a ninety day extension of time, provided good cause for the extension is shown. TBMP § 207.02. Various circumstances may constitute good cause, including settlement negotiations between the parties. *Id.* “Ordinarily, the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.” *Am.*

Vitamin Prods. Inc. v. DowBrands Inc., 22 U.S.P.Q.2d 1313, 1314 (T.T.A.B. 1992) (finding that Petitioner had shown good cause sufficient to justify an extension of the time to respond to respondent's outstanding discovery requests).

II. ExxonMobil Provided the Proper “Good Cause” for the Extension Request

On December 30, 2015, Applicant filed Application Serial No. 86/861,515 (the “Application”) with the USPTO seeking to register the mark J-FLEX. On the morning of June 8, 2016, ExxonMobil's outside counsel sent a letter to Applicant's counsel objecting to Applicant's use and registration of the mark J-FLEX. *See* Declaration of Philip M. Davison (“Davison Decl.”) ¶ 2, Ex. A (June 8, 2016 10:53 AM email from ExxonMobil's counsel to Applicant's counsel and attached letter). ExxonMobil's counsel sent the June 8 letter to Applicant's counsel via email at 10:53 AM and via overnight mail, and immediately informed ExxonMobil's in-house counsel, Mr. Philip Davison, that the letter had been sent. *See id.*

Later that afternoon, Mr. Davison filed a request on behalf of ExxonMobil for a 90-day extension of time to oppose the Application. *Id.* ¶ 3, Ex. B (ESTTA confirmation receipt for extension request). In Mr. Davison's experience, settlement discussions are frequently initiated with a letter such as the one sent to Applicant's counsel by ExxonMobil's counsel. *Id.* ¶ 4. As a result, and because he had been informed that the letter had already been sent to Applicant's counsel, Mr. Davison stated in the extension request on behalf of ExxonMobil that ExxonMobil “believes that good cause is established for this request” on the basis of settlement discussions. *Id.*

Based on these facts—ExxonMobil's knowledge that the letter had been sent to Applicant before it filed the extension request and Mr. Davison's experience that settlement discussions are often initiated by sending such a letter—ExxonMobil identified the proper reason in the request for “good cause” (i.e., on the basis of settlement negotiations).

Importantly, the language in the extension request also specifically requires the filer to state it “believes” that good cause has been established for the reason identified in the request, and it was ExxonMobil’s belief at the time of filing that settlement negotiations had been initiated when the letter was sent. The fact that ExxonMobil sent a letter and filed an extension request before filing a Notice of Opposition also shows its intent to resolve the matter short of litigation—i.e., through settlement discussions—and further supports ExxonMobil’s good faith belief that its June 8 letter effectively commenced settlement discussions. Whether Applicant believes settlement discussions had been commenced is irrelevant. The facts demonstrate that the “good cause” ExxonMobil provided in its extension request was based on good faith and a reasonable belief that settlement discussions had been initiated when the letter was sent. In addition, ExxonMobil requested a ninety day extension at the outset when it could have requested only a thirty day extension without showing good cause, and thus cannot be accused of being negligent or lacking diligence in requesting the extension of time.

Further, the facts in *Central Mfg. Inc. v. Third Millennium Tech* case cited by Applicant as supporting its Motion are starkly different from the facts in this case. In *Central Mfg.*, the potential opposer¹ was “engaged in delaying issuance of applicant’s registration to force applicant to pay money to opposer in exchange for allowing applicant’s registration to issue,” rather than settlement discussions as the opposer claimed. *Central Mfg. Inc. v. Third Millennium Tech.*, 61 U.S.P.Q.2d 1210, 1212 (T.T.A.B. 2001). The opposer in *Central Mfg.* also lied about having obtained the applicant’s consent to an extension, sent letters threatening that the opposition proceeding would be prolonged and financially ruin the applicant, and had a track record of submitting false

¹ The opposer in *Central Mfg.* was Leo Stoller, who the Board recognized had a “pattern” of misconduct before the Board. *Central Mfg.* at 1214-15.

statements to the Board. *Central Mfg.*, 61 U.S.P.Q.2d at 1212. None of those elements are present in this case.

Accordingly, Applicant's motion to dismiss because ExxonMobil's extension request was purportedly made in bad faith should be denied.

III. Sanctions are Inappropriate

A party certifies upon filing of any paper with the Board that “[t]o the best of the party’s knowledge, information and belief, formed after an inquiry reasonable under the circumstances, the paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office” TBMP § 527.07; 37 CFR § 11.18; *see also* FED. R. CIV. P. 11(b). A party that violates Rule 11(b) or 37 CFR § 11.18 may be subject to sanctions. *Id.*

As demonstrated above, and in contrast to the opposer in *Central Mfg.* referenced in Applicant’s Motion, ExxonMobil’s extension request was not filed to harass, cause unnecessary delay, or needlessly increase the cost of litigation to Applicant. Davison Decl., ¶ 4; *see also Central Mfg.*, 61 U.S.P.Q.2d at 1214-15. ExxonMobil’s extension request was filed in good faith and based on a reasonable belief that settlement discussions were the appropriate basis of “good cause” for the request. *Id.* Accordingly, sanctions are inappropriate in this case, and Applicant’s motion for sanctions should be denied. *See Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1221 (T.T.A.B. 1990) (denying motion for sanctions; applicant had reasonable basis for allegations in its pleading).

For the foregoing reasons, ExxonMobil respectfully requests that the Board deny Applicant’s motion that this Opposition be dismissed for lack of jurisdiction and that sanctions be imposed on ExxonMobil.

Respectfully submitted,

Date: October 10, 2016

/Tyson D. Smith/
Stephen P. Meleen
Tyson D. Smith
PIRKEY BARBER PLLC
600 Congress Avenue, Suite 2120
Austin, Texas 78701
512.322.5200

ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served on Applicant's counsel on October 10, 2016 via First Class Mail, postage prepaid at the following address:

Bernhard P. Molldrem, Jr.
Law Office of Bernhard Molldrem
224 Harrison Street, Suite 200
Syracuse, New York 13202

/Tyson D. Smith/

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

In Re Serial No. 86/861,515	§	
Filed: December 30, 2015	§	
Mark: J-FLEX	§	
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	§	Opposition No. 91230032
Opposer,	§	
	§	
v.	§	
	§	
J.G.B. Enterprises, Inc.,	§	
	§	
Applicant.	§	

**DECLARATION OF PHILIP M. DAVISON IN SUPPORT OF OPPOSER'S RESPONSE
TO APPLICANT'S MOTION TO DISMISS OPPOSITION**

I, Philip M. Davison, declare as follows:

1. I am employed by Opposer Exxon Mobil Corporation ("ExxonMobil") as Counsel, Trademark & Copyright Law. I am over eighteen years of age, and I am fully competent to make this Declaration. I have personal knowledge and/or knowledge based on my review of ExxonMobil's business records of the facts stated herein.

2. On the morning of June 8, 2016, ExxonMobil's outside counsel sent a letter to counsel for Applicant J.G.B. Enterprises, Inc. via email at 10:53 AM and via overnight mail objecting to Applicant's use and registration of the mark J-FLEX. *See* Exhibit A (June 8, 2016 10:53 AM email from ExxonMobil's counsel to Applicant's counsel and attached letter). That same morning, shortly after sending the letter, ExxonMobil's outside counsel informed me that that the letter had been sent to Applicant's counsel.

3. Later in the afternoon of that same day (June 8, 2016), I filed a request for a ninety day extension of time to oppose Applicant's application for J-FLEX (Application Serial No.

86/861,515) on behalf of ExxonMobil. *See* Ex. B (ESTTA confirmation receipt for extension request).

4. In my long experience as a trademark attorney, settlement discussions are frequently initiated with a letter such as the June 8 letter referred to above. As a result, and because I had been informed that the letter had already been sent to Applicant’s counsel, I stated in good faith on behalf of ExxonMobil in the extension request that ExxonMobil “believes that good cause is established for this request” on the basis of settlement discussions. *See* Ex. B. ExxonMobil did not file the extension request to harass, cause unnecessary delay, or needlessly increase the cost of litigation to Applicant, or for any other improper purpose.

I declare under penalty of perjury that the foregoing is true and correct. Executed in Spring, Texas on October 7, 2016.


Philip M. Davison

EXHIBIT A

Eric Olson

From: Rose Sullivan
Sent: Wednesday, June 08, 2016 10:53 AM
To: molldrem@dreamscape.com
Cc: Tyson Smith; Steve Meleen
Subject: J.G.B. Enterprises, Inc. use and application to register J-FLEX
Attachments: EXCO316 J-FLEX.pdf

Follow Up Flag: Follow up
Due By: Wednesday, June 22, 2016 7:00 AM
Flag Status: Completed

Mr. Molldrem,

Tyson Smith requested that I send you the attached.
Thank you for your attention to this matter,

Rose

Rose E. Sullivan

Legal Assistant | Pirkey Barber PLLC

600 Congress Avenue, Suite 2120 | Austin, Texas 78701 | USA

512-482-5227 (direct dial) | 512-322-5200 (main) | rsullivan@pirkeybarber.com



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
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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

EXHIBIT B

Eric Olson

From: estta-server@uspto.gov
Sent: Wednesday, June 08, 2016 4:09 PM
To: Davison, Philip M
Subject: ESTTA. Request for extension of time to file notice of opposition confirmation receipt
ID: ESTTA751190

Request for extension of time to file notice of opposition

Tracking No: ESTTA751190

ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

The Trademark Trial and Appeal Board (Board) has received a filing titled ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS submitted through the Electronic System for Trademark Trials and Appeals (ESTTA). This Notice verifies receipt of the filing and includes an ESTTA Tracking Number.

Unless the filing fails to meet all applicable minimum legal requirements for filing , the Board will not retract the filing or refund any fees paid.

The filing, and any Board proceeding, may be viewed on TTABVUE at ttabvue@uspto.gov. Please allow up to two hours for the system to process this filing.

If the filer has a question, or if the filing is not viewable in TTABVUE, the TTAB Assistance Center is available at 571-272-8500, Monday to Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET), or email at estta@uspto.gov . Please provide your ESTTA Tracking No.

ESTTA server at <http://estta.uspto.gov>

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

/Philip Davison/

06/08/2016

Philip Davison

Trademark Counsel

Exxon Mobil Corporation

22777 Springwoods Village Parkway Energy 2, 4A.341 Spring, TX 77389 UNITED STATES

philip.m.davison@exxonmobil.com Phone:832-625-0607