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

Proceeding	91209569
Party	Defendant Inmarsat Global Xpress Limited
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Attachments	Motion to Dismiss Opposition - GLOBAL EXPRESS [FINAL].pdf (6 pages) (171298 bytes)

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

EXPRESS COMMUNICATIONS, LLC,

Opposer

v.

INMARSAT GLOBAL XPRESS LIMITED

Applicant.

Opposition No. 91209569

Application Serial No. 85/235,142

Mark: GLOBAL XPRESS

APPLICANT’S MOTION TO DISMISS AND MEMORANDUM IN SUPPORT

PLEASE TAKE NOTICE that the Applicant in the above proceeding, Inmarsat Global Xpress Limited (“Applicant”), by and through its attorneys, GREENBERG TRAURIG, LLP, hereby moves the Trademark Trial and Appeal Board (“Board”) to dismiss the above-captioned Opposition No. 91209569 pursuant to 37 C.F.R. § 2.127 and Rule 12 of the Federal Rules of Civil Procedure and for such other relief as may be just and proper.

Applicant’s Motion to Dismiss is based upon this Notice of Motion and the following Memorandum in Support thereof. For the reasons set forth below, the Board should grant Applicant’s Motion.

MEMORANDUM IN SUPPORT OF APPLICANT’S MOTION TO DISMISS

I. INTRODUCTION

The Board should dismiss this Opposition for two independent reasons. First, the thirty-day deadline to file a first request for an extension of time to oppose was missed thereby making any Notice of Opposition relying upon such an extension untimely. Trademark Act § 13(a); 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102(c); TBMP § 202.04. The timeliness requirement is statutory

and cannot be waived. *See, e.g., In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm’r 1995). Thus, the Board must dismiss this Opposition as untimely.

Second, even if the Board somehow concludes that the first request for an extension of time to oppose was timely, dismissal is still appropriate because the Notice of Opposition is not in the name of the party that requested the extensions of time to oppose (Jeff Volk). Ordinarily, an “opposition filed during an extension of time should be in the name of the person to whom the extension was granted,” unless there is privity between the two entities or the person requesting the extension of time was misidentified through mistake. TBMP § 201, 206. 02–03; 303.05; 37 C.F.R. § 2.102(b). Mr. Volk was the party to whom the extension was granted—not the named Opposer. Opposer has not made the requisite showing of privity between it and Mr. Volk or that it has otherwise been misidentified through mistake.

For these reasons, the Board should dismiss this Opposition.

II. FACTUAL BACKGROUND

The Applicant Inmarsat Global Xpress Limited (“Applicant”) filed a trademark application on the mark GLOBAL XPRESS, Ser. No. 85235142, on February 6, 2011. (Board Proceeding No. 85235142, Dkt. No. 1.) The PTO published Applicant’s GLOBAL XPRESS trademark on September 4, 2012. (*Id.*)

Mr. Volk filed his First 90 Day Request for Extension of Time to Oppose for Good Cause (“First Extension Request”) on October 5, 2012, **thirty one** days after the PTO published Applicant’s GLOBAL XPRESS trademark. (*Id.*) The First Extension Request expressly admits that “[t]he time within which to file a notice of opposition is set to expire on 10/04/2012.” (*Id.*)

Mr. Volk filed his subsequent 60 Day Request for Extension of Time to Oppose Upon Consent and Extraordinary Circumstances (“Second Extension Request”) on December 31, 2012. (BOARD Proceeding No. 82535142, Dkt. No. 3.)

The Notice of Opposition was filed on March 4, 2013. (Board Proceeding No. 91209569, Dkt. No. 1, 2.) The Notice of Opposition does not identify, much less describe, any relationship between Express Communications, LLC and Mr. Volk and/or allege facts relating to any misidentification through mistake of either Express Communications, LLC or Mr. Volk. (*Id.*)

III. LEGAL STANDARDS

A. A Request For An Extension Of Time To Oppose Must Be Filed Within Thirty Days Of Publication.

“A request for an extension of time to oppose *must* be filed prior to the expiration of the thirty-day period after publication (for opposition) of the mark which is the subject of the request....” TBMP § 202.04 (emphasis added); Trademark Act § 13(a); 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102(c); *In re Cooper*, 209 U.S.P.Q. 670, 671 (Comm’r 1980). “Because these timeliness requirements are statutory, they *cannot be waived* by stipulation of the parties, nor can the Director upon petition waive them.” TBMP § 202.04 (emphasis added); *see In re Sasson Licensing Corp.*, 35 U.S.P.Q.2d 1510, 1512 (Comm’r 1995); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 U.S.P.Q.2d 1477, 1478 (Comm’r 1994); *In re Cooper*, 209 U.S.P.Q. at 671.

B. A Request For An Extension Of Time And Notice Of Opposition Must Ordinarily Be In The Name Of The Same Entity.

Ordinarily, an “opposition filed during an extension of time should be in the name of the person to whom the extension was granted. TBMP § 201, 303.05; 37 C.F.R. § 2.102(b). “No proceeding will be instituted ... [i]f an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show ... that it is in privity with the person who obtained the extension, or that the

person in whose name the extension was requested was misidentified through mistake.” TBMP § 309.04.

IV. ARGUMENT

A. The Opposition Must Be Dismissed Because It Is Untimely.

Mr. Volk missed the deadline to extend the opposition period or file a notice of opposition. From the time of publication, a party has thirty days to either file its notice of opposition or otherwise request an extension of time to oppose. TBMP § 202.04; Trademark Act § 13(a); 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102(c); *In re Cooper*, 209 U.S.P.Q. at 671. The deadline to oppose or request an extension is statutory in nature such that it **cannot be waived** by any party, including the Board itself. TBMP § 202.04; *see In re Sasson Licensing Corp.*, 35 U.S.P.Q.2d 1510, 1512 (Comm’r 1995); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 U.S.P.Q.2d 1477, 1478 (Comm’r 1994); *In re Cooper*, 209 U.S.P.Q. at 671.

Here, the PTO published the GLOBAL XPRESS application on September 4, 2012. (BOARD Proceeding No. 85235142, Dkt. No. 1.) Accordingly, the time period within which to file a notice of opposition or otherwise request an extension of time to oppose ended on October 4, 2012—thirty days after publication. Indeed, Mr. Volk was well aware of this deadline. In his extension request, Mr. Volk confirms that “[t]he time within which to file a notice of opposition is set to expire on 10/04/2012.” (*Id.*) Despite this knowledge, the “Filing Date” of Mr. Volk’s First Extension Request was “10/05/2012,” one day after the non-waivable deadline. (*Id.*) Thus, the Board must dismiss this Opposition as untimely.

B. The Oppositions Must Be Dismissed Because The Notice Of Opposition Is Not In The Name Of the Party That Requested the Extension.

Even if the Board somehow concludes that Mr. Volk timely filed his First Extension Request, dismissal is still appropriate. The Notice of Opposition was filed by Express

Communications, LLC, not by Mr. Volk, as required by the TBMP. Ordinarily, an “opposition filed during an extension of time should be in the name of the person to whom the extension was granted.” TBMP § 201, 303.05; 37 C.F.R. § 2.102(b). The exception to this rule permits an opposition to be filed in the name of a person other than the person who filed the request for an extension of time *only if* the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time. 37 C.F.R. § 2.102(b); TBMP § 303.05, 303.05(a).

Here, the Opposition was not filed in the name of the party that filed the *two* extension requests, namely Jeff Volk. Rather, the Notice of Opposition was filed on behalf of Express Communications LLC. (Board Proceeding No. 91209569, Dkt. No. 1, 2.) The Opposer has made no “showing” of privity “in the form of a recitation of facts” between Jeff Volk and Express Communications LLC as required by TBMP § 206.02; 303.05(b). (*See id.*) Nor has the Opposer made a “showing” in support of a claim of misidentification by mistake “in the form of a recitation of facts” as required by TBMP § 206.03; 303.05(c). (*See id.*) For this additional reason, The Board should dismiss this Opposition.¹

CONCLUSION

For the reasons set forth above, Applicant respectfully requests that the Board grant its Motion to Dismiss.

Dated: April 8, 2013

Respectfully submitted,

/s/ Herbert H. Finn
Herbert H. Finn
Matthew J. Levinstein
GREENBERG TRAURIG, LLP

¹ Of course, the Opposer is not without a potential remedy if the Board dismisses this Opposition. The Opposer’s remedy, if any, lies in filing a cancellation proceeding following the issuance of the trademark. TBMP § 306.04.

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the foregoing **APPLICANT'S MOTION TO DISMISS AND MEMORANDUM IN SUPPORT** is being electronically filed on April 8, 2013, with the United States Patent and Trademark Office ESTTA electronic document filing system.

/s/ Herbert H. Finn
Herbert H. Finn

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S MOTION TO DISMISS AND MEMORANDUM IN SUPPORT** has been served on Victoria Carver, counsel for Opposer, by mailing said copy on April 8, 2013, via First Class mail, postage prepaid to: Victoria Carver, Carver Law, PO Box 206, Bellefonte, PA 16823 and by emailing said copy on April 8, 2013 to: Victoria Carver at vc@etmlaw.com.

/s/ Herbert H. Finn
Herbert H. Finn