

TAB

02-25-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #01

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

RACETRAC PETROLEUM, INC.,	)	
	)	Opposition No. 117, 623
Opposer,	)	
	)	
vs.	)	Trademark: <b>RACE WAY and</b>
	)	<b>Design, Serial No. 75/321,745</b>
ETW CORPORATION,	)	
	)	
Applicant.	)	

**OPPOSITION TO APPLICANT'S MOTION TO  
EXTEND THE TESTIMONY PERIOD**

Opposer, RaceTrac Petroleum, Inc., herein opposes yet another requested extension of Applicant's testimony period, filed by Applicant on February 10, 2003. This extension, if granted, would be the ninth such extension granted, and all essentially on the same vague basis, "because of personal commitments and ongoing and unanticipated scheduling conflicts." (Applicant's Motion mailed Feb. 10, 2003).

A Board Order dated December 5, 2002, noted that as of that time, Applicant had filed seven unconsented motions to extend its testimony, each alleging essentially the same vague and unsubstantiated bases as that described in paragraph one and ordered that "[A]pplicant is advised that no further extensions to its testimony period will be granted without Opposer's consent thereto or *a showing of extraordinary circumstances*" (emphasis added). The Board then extended the time for taking testimony, setting it to close on January 24, 2003.

In spite of the Board's obvious impatience, and expression of concern with its own administrative load, and with the Opposer's right to resolution, and its cautionary statement,

Applicant nevertheless filed yet another unconsented Motion to Extend on January 10, 2003. Opposer filed an answer in opposition. The Board did not respond to either Applicant's Motion or Opposer's Opposition to it. Presumably Applicant has decided, unilaterally, that the Motion was granted.

As the Board correctly noted, Opposer is entitled to have this matter brought to a conclusion. The continued delays and the uncertainties created by Applicant, not to mention the added expenses incurred by Opposer in dealing with Applicant's repetitive motions, are simply unfair to Opposer. These delays may be for the purpose of somehow placing Applicant in a position of advantage it would not otherwise have enjoyed if it had been ordered to take its testimony earlier. Finally, they create an administrative burden to the Board, only adding to its backlog of unresolved cases. The Board has since 1998 been working to limit the situations in which extensions would be granted and to curb abuses of the extension period. This case is exactly that type of case which calls for the Board, in the exercise of its discretion, to deny the Applicant's Motion for more time, and to rule that because Applicant did not go forward with its testimony taking by January 24, 2003, as ordered, that Applicant has forfeited its right to take testimony in this matter, or further, order Applicant to show cause why this Opposition should not be sustained.

Applicant has filed Opposition to Applicant's Motion to Compel as well and that will be addressed separately. Suffice it to say that Opposer's reliance on Applicant's assurances that responses to discovery would be forthcoming has worked to Opposer's detriment and that this Board should consider Applicant's failure to produce only another manifestation of its lack of cooperation with Opposer and with this process. Accordingly, the Motion to

Compel should be granted, even though filed out of time. It was filed out of time due to Applicant's representations that production would come prior to the opening of Opposer's testimony period all as more specifically dealt with in the accompanying Reply to Applicant's Opposition to Motion to Compel.

Respectfully submitted,  
RACETRAC PETROLEUM, INC.

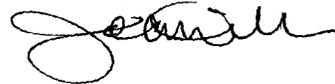
By: 

Joan L. Dillon  
3530 Ashford Dunwoody Road, PMB 235  
Atlanta, GA 30319  
Tel: 404 257 1708  
Fax: 404 250 1708  
Attorney for Opposer  
RaceTrac Petroleum, Inc.

Date: February 21, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner of Patents and Trademarks, BOX TTAB—NO FEE, 2900 Crystal Drive, Arlington, VA, 22202-3513 on February 21, 2003



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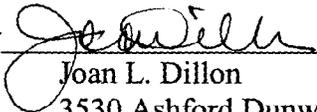
CERTIFICATE OF SERVICE

This is to certify that I have on this date served a copy of the foregoing OPPOSITION TO APPLICANT'S MOTION TO EXTEND THE TESTIMONY on Applicant's counsel by first-class mail, postage prepaid, addressed as follows:

Barbara A. Murphy, Esq.  
Adduci, Mastriani & Schaumberg, LLP  
1200 Seventeenth Street NW  
Fifth Floor  
Washington, D.C. 20036

This 21<sup>st</sup> day of February, 2003.

Respectfully submitted,  
JOAN DILLON LAW, LLC

By   
Joan L. Dillon  
3530 Ashford Dunwoody Road, PMB 235  
Atlanta, GA 30319  
Tel: 404 257 1708  
Fax: 404 250 1708  
Attorney for Opposer  
RaceTrac Petroleum, Inc.

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ETW CORPORATION,	)	
	)	
Applicant.	)	

TO: Assistant Commissioner for Trademarks  
Attention: BOX TTAB NO FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**REPLY TO APPLICANT'S OPPOSITION TO MOTION TO COMPEL**

Comes now Opposer, Racetrac Petroleum, Inc., and replies to the defenses filed by Applicant's counsel, Ms. Barbara Murphy, against Opposer's Motion to Compel Applicant to respond to discovery requests.

Applicant seeks to have denied Opposer's Motion to Compel on the sole basis that the Motion falls outside the period permitted for filing a Motion to Compel and argues that the Motion should have been filed prior to February 2002. Further, Applicant denies having received the Opposer's Interrogatories in this matter until the attachment of those Interrogatories to Opposer's recently filed Motion to Compel.

Applicant fails to address, and tellingly, does not bother to deny, Opposer's assertion and argument that Opposer's failure to timely file the Motion to Compel was based entirely

upon Applicant's representations that production would be forthcoming and encouraging Opposer to simply go on with its testimony taking.

Opposer had no reason to doubt that Applicant would produce its answers and documents based upon Applicant's repeated assurances that production would be forthcoming. Representative of these assurances see the attached March 11, 2002, letter (Exhibit A) from Ms. Murphy, Applicant's counsel; this writing an outgrowth of what had been the subject of a series of calls, and previous communications from Opposer's counsel demanding the production, exemplars of which are attached as Exhibit B. Ms. Murphy indicates in Exhibit A that indeed Applicant "hope[d] to have the discovery responses to [Opposer's counsel] in advance of the [Opposer's testimonial] deposition, with the goal of having them to [Opposer's counsel] next week." In reliance on repeated verbal and written assurances Opposer let its time for filing the Motion to Compel pass. After all, Opposer was never given any indication that the production would not be forthcoming, but indeed, was given to believe that production would be forthcoming if it just went on with its testimony taking. Opposer relied, to its considerable detriment, upon these assurances.

Perhaps Opposer should have titled its Motion to Compel, a Motion to Re-Open the Pre-testimony Period for the Purpose of Entering a Motion to Compel. Motions to Re-Open periods are granted regularly for excusable neglect. The instant situation should qualify as resultant from Opposer's counsel being lulled into the belief that production would be forthcoming. See *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 1552-53 (Fed. Cir. 1991) (Failure to take the proper steps at the proper time, not in consequence of the party's own carelessness, inattention, or willful disregard...but in consequence of promises made by

the adverse party.). Opposer submits that reliance on the affirmations of a fellow member of the Bar, particularly when Opposer had no reason to doubt the good faith of that person, constitutes excusable neglect. See *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 U.S.P.Q. 617, 618 (TTAB 1982), holding that excusable neglect resulted because the Opposer relied in good faith upon its interpretation of its agreement with the Applicant concerning extensions of the discovery period.

Finally, Applicant has represented that she did not receive the Opposer's Interrogatories prior to their delivery to her along with the recently filed Motion to Compel. Applicant attaches hereto as Exhibit C the Certificate of Service which accompanied those Interrogatories and which indicates that on August 13, 2001, they were served by Mr. John R. Renaud, then an associate with the firm of Kilpatrick Stockton, LLP. A full copy of the Interrogatories was submitted along with Opposer's Motion. Opposer cannot further substantiate whether Ms. Murphy received the Interrogatories or not. The mails are subject to vagaries in performance; nevertheless, an inference can be drawn that these were received because on November 19, 2001, in Opposer's counsel's letter to Ms. Murphy (Exhibit D) Opposer's counsel states, "At this point we are requesting that you supply us with your client's responses to previously-served discovery. We are also supplementing *those interrogatories previously served* with a first set of Requests for Production of Documents." Ms. Murphy did not deny, at that time nor any time prior to her Opposition to this Motion to Compel, having received the Interrogatories. Had she done so, Opposer's counsel would surely have hastened to provide them to her.

Accordingly, Opposer respectfully requests that its Motion to Compel be granted, or that its period of time for filing the Motion be re-opened and then the Motion be entered and granted.

Respectfully submitted,  
RACETRAC PETROLEUM, INC.

By:   
Joan L. Dillon  
3530 Ashford Dunwoody Road, PMB 235  
Atlanta, GA 30319  
Tel: 404 257 1708  
Fax: 404 250 1708  
Attorney for Opposer  
RaceTrac Petroleum, Inc.

Date: Feb. 21, 2003

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A

ADDUCI, MASTRIANI & SCHAUMBERG, L.L.P.

ATTORNEYS AT LAW

V. JAMES ADDUCI II  
LOUIS S. MASTRIANI  
TOM M. SCHLAUMBERG  
BARBARA A. MURPHY  
HARVEY B. FOX  
GREGORY C. ANTRES  
STEVEN E. ADKINS  
WILL F. LEONARD  
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MAUREEN F. BROWNE  
MICHAEL L. DOANE  
MICHAEL G. McMANUS\*  
DAVID F. NICKEL\*  
SARAH E. HAMBLIN\*  
MARK R. LEVENTHAL  
\*ADMITTED TO A BAR OTHER THAN DC

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OF COUNSEL  
ROBERT A. WESTERLUND  
RAYMOND H.J. POWELL, JR.\*  
PHILIP L. ROBINS

March 11, 2002

VIA FACSIMILE

Joan L. Dillon, Esq.  
Kilpatrick Stockton LLP  
1100 Peachtree Street  
Suite 2800  
Atlanta, Georgia 30309-4503

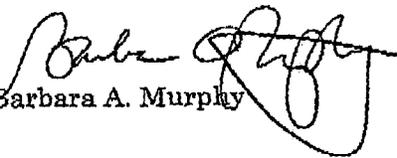
Re: Opposition No. 117,623,  
Racetrac Petroleum, Inc. v. ETW Corp.  
Trademark: RACEWAY and Design, Ser. No. 75/321,745

Dear Joan:

Pursuant to our telephone conversation today, we requested that you postpone the testimonial deposition scheduled for Tuesday, March 12<sup>th</sup>, until some time during the week of March 25<sup>th</sup>. This deposition was scheduled last week, with the hope of completing it during the Opposer's testimony period, which would otherwise expire on March 16, 2002. In the interim, we hope to have discovery responses to you in advance of the deposition, with the goal of having them to you next week.

Please contact me with any questions.

Sincerely,

  
Barbara A. Murphy

BAM:ss  
ETW300102

*3/11/02-T/c to MS Murphy.*



**KILPATRICK  
STOCKTON LLP**

Attorneys at Law

**B**

Suite 2800  
1100 Peachtree Street  
Atlanta, Georgia 30309-4530  
Telephone: 404.815.6500  
Facsimile: 404.815.6555  
Web site: www.KilpatrickStockton.com

February 13, 2002

**JOAN L. DILLON**  
E-mail: JDillon@KilpatrickStockton.com  
Direct Dial: 404.815.6533 Direct Facsimile: 404.541.3180

VIA FACSIMILE (202) 466-2006  
ORIGINAL BY U.S. FIRST CLASS MAIL

Ms. Barbara A. Murphy  
Adduci, Mastriani & Schaumberg LLP  
1200 "17th" Street, N.W., 5th Floor  
Washington, D.C. 20036

**Re: Opposition - Racetrac Petroleum, Inc., Opposer, vs. ETW Corporation,  
Applicant, Serial No. 75/321,745 RACE WAY and Design  
Opposition No. 117,623, Trademark Trial and Appeal Board  
Our Ref. No. 33317-204062**

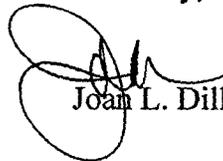
Dear Barbara:

We note that discovery has closed in connection with this Opposition. We had given you additional time to respond to outstanding recovery requests served by us in August 2001. On November 19, 2001, I asked that you get the responses to us.

I have not had any responses nor have I heard from you about this and would appreciate your letting me know within the next couple of days when I might expect your responses, noting that our testimony period opens in a very few days.

I would like to have your discovery responses within a week or so, presumably you have worked with them. If you have not, we assume then that we can get your permission to extend our testimony period until we have received the benefit of your responses. I look forward to hearing from you.

Cordially,

  
Joan L. Dillon

2/27/02  
202-467-6300 - Barbara  
LJM.

JLD/sts

cc: Racetrac Petroleum, Inc.  
1303403.1

2/27/02

Re [REDACTED]  
[REDACTED]

2/28/02 - TIC to Ms. Murphy in return for  
chrs. 202-467-6300

3/4/02 - TIC to Mrs. Murphy. Any production?

Whether it would be coming - I'll  
look into it + get back to me.

Advised her of 3/12 notice of Test.  
No date.

- Done - Jeff Hassman,  
Director of Marketing



**KILPATRICK  
STOCKTON LLP**

Attorneys at Law

Suite 2800  
1100 Peachtree Street  
Atlanta, Georgia 30309-4530  
Telephone: 404.815.6500  
Facsimile: 404.815.6555  
Web site: www.KilpatrickStockton.com

March 13, 2002

JOAN L. DILLON  
E-mail: JDillon@KilpatrickStockton.com  
Direct Dial: 404.815.6533 Direct Facsimile: 404.541.3180

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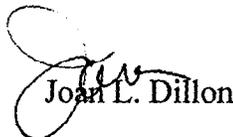
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**Applicant, Serial No. 75/321,745 RACE WAY and Design**  
**Opposition No. 117,623, Trademark Trial and Appeal Board**  
**Our Ref. No. 33317-204062**

Dear Barbara:

Thank you for your March 11, 2002 letter. I am glad that the client was able to accommodate you with its schedule. I have represented our consented extension of time, because I did not want you to be squeezed on your time. A copy of the extension request is enclosed. Neither did I want the Office to, in some excess of technicality, rule that we had taken testimony out of time. We now look forward to receipt of the responses to the outstanding interrogatories and document requests. I had prepared, as represented, a motion to compel these responses, but have withheld filing it upon your assurances that we should be receiving them shortly.

At present now, and in accordance with the client's request and your agreement, the deposition is scheduled for March 27, 2002 at 1:00 p.m. in our offices. We are enclosing a separate formal notice.

Cordially,



Joan L. Dillon

JLD/jnh

Enclosure

cc: Racetrac Petroleum, Inc.  
1317872.1

Dillon, Joan

Racetrack  
RETW

**From:** Dillon, Joan  
**Sent:** Friday, September 13, 2002 5:35 PM  
**To:** 'Barbara Murphy'  
**Subject:** RE: extension request

Why did I know I would be hearing from you at 5? Anyway, I will not oppose this extension provided you agree that any extensions we want for rebuttal and briefing will be consented or uncontested.

-----Original Message-----

**From:** Barbara Murphy [mailto:Murphy@adduci.com]  
**Sent:** Friday, September 13, 2002 5:01 PM  
**To:** 'JDillon@KilpatrickStockton.com'  
**Subject:** extension request

Joan,

I would like to ask you for a final extension request in the RACEWAY opposition. I would like to extend the Applicant's testimony period for four additional weeks--until October 11th. The rebuttal period for your client would end on November 29th under this proposal. I think the additional time will allow us to finalize things. Please let me know if you would consent to this extension.

Thank you in advance for your consideration and cooperation, Barbara

Barbara A. Murphy  
Adduci, Mastriani & Schaumberg, L.L.P.  
202-467-6300, ext. 217

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

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Opposer, )

vs. )

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Applicant. )

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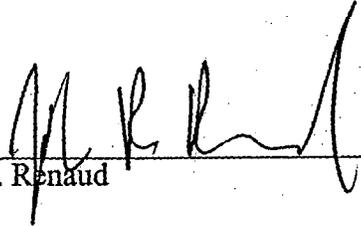
Trademark: RACE WAY and  
Design, Serial No. 75/321,745

CERTIFICATE OF SERVICE

This is to certify that I have served a copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT on Applicant's counsel by first-class mail, postage pre-paid, addressed as follows:

Barbara A. Murphy, Esq.  
Adduci, Mastriani & Schaumberg, L.L.P.  
1200 Seventeenth Street, N.W.  
Fifth Floor  
Washington, D.C. 20036

This the 13th day of August 2001.

  
\_\_\_\_\_  
John R. Renaud



**KILPATRICK  
STOCKTON LLP**

Attorneys at Law

Suite 2800  
1100 Peachtree Street  
Atlanta, Georgia 30309-4530  
Telephone: 404.815.6500  
Facsimile: 404.815.6555  
Web site: www.KilpatrickStockton.com

November 19, 2001

JOAN L. DILLON  
E-mail: JDillon@KilpatrickStockton.com  
Direct Dial: 404.815.6533

VIA FACSIMILE (202) 466-2006  
ORIGINAL BY U.S. FIRST CLASS MAIL

Ms. Barbara A. Murphy  
Adduci, Mastriani & Schaumberg LLP  
1200 "17th" Street, N.W., 5th Floor  
Washington, D.C. 20036

**Re: Opposition - Racetrac Petroleum, Inc., Opposer, vs. ETW Corporation,  
Applicant, Serial No. 75/321,745 RACE WAY and Design  
Opposition No. 117,623, Trademark Trial and Appeal Board  
Our Ref. No. 33317-204062**

Dear Barbara:

It appears that my client has had time now to review and to thoroughly consider the outstanding settlement offer made by you on behalf of your client. Accordingly, it appears we are going to go forward with the opposition to the registration of your client's mark. I recall that there are discovery requests outstanding, served by us on August 13, 2001, and to which a response was due September 12, 2001. We gave you additional time to respond during the discovery period for the reason that we had hoped that perhaps some settlement or acceptable accommodation could be made.

At this point, we are requesting that you supply us with your client's responses to previously-served discovery. We are also supplementing those Interrogatories previously served, with a First Set of Requests for Production of Documents. We note our discovery period closes on **December 16, 2001**, and accordingly, we would appreciate your getting the responses in within the next week or so, or perhaps agreeing to a stipulated extension of the discovery periods, perhaps another three months, to March 16, 2002. Please give me a call after you have had a chance to consider this and let me know how you would propose to approach this.

Cordially,

  
Joan L. Dillon

JLD/jnh

Enclosure

cc: Racetrac Petroleum, Inc.

1260523.1

ATLANTA AUGUSTA BRUSSELS CHARLOTTE LONDON MIAMI RALEIGH RESTON STOCKHOLM WASHINGTON WINSTON-SALEM

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Applicant.	)	

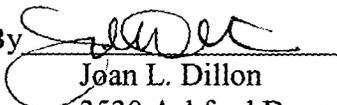
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Barbara A. Murphy, Esq.  
Adduci, Mastriani & Schaumberg, LLP  
1200 Seventeenth Street NW  
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Washington, D.C. 20036

This 21<sup>st</sup> day of February, 2003.

Respectfully submitted,  
JOAN DILLON LAW, LLC

By   
Joan L. Dillon  
3530 Ashford Dunwoody Road, PMB 235  
Atlanta, GA 30319  
Tel: 404 257 1708  
Fax: 404 250 1708  
Attorney for Opposer  
RaceTrac Petroleum, Inc.



JOAN DILLON LAW, LLC

February 21, 2003

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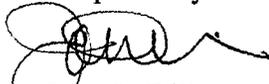
Assistant Commissioner for Trademarks  
Attention: BOX TTAB NO FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

RE: RaceTrac Petroleum Inc. v. ETW Corporation  
Opposition No. 117,623

Gentlemen:

Enclosed please find Opposer's Reply to Applicant's Opposition to Motion to Compel, and Opposition to Applicant's Motion to Extend the Testimony Period. Copies of these have been served upon Applicant's counsel, Ms. Barbara Murphy.

Respectfully submitted,



Joan L. Dillon  
Attorney for Opposer

cc: RaceTrac Petroleum, Inc.