

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

TOYOTA JIDOSHA KABUSHIKI KAISHA)
d/b/a TOYOTA MOTOR CORPORATION,)

Opposer)

v.)

SYNGENTA PARTICIPATIONS AG)

Applicant.)

Serial No.: 78/145,546

Filed: July 19, 2002

Mark: LEXUS



TOYOTA JIDOSHA KABUSHIKI KAISHA)
d/b/a TOYOTA MOTOR CORPORATION,)

and TOYOTA MOTOR SALES, U.S.A., INC.)

Opposers)

v.)

SYNGENTA PARTICIPATIONS AG)

Applicant.)

06-03-2004

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #22

Serial No.: 78/185,538

Filed: Nov. 15, 2002

Mark: LEXXUS

APPLICANT'S MOTION FOR RECONSIDERATION

Applicant would move for reconsideration of this Board's Order of April 30, 2004 upon the grounds listed below.

I. Preliminary Statement

Applicant deeply truly desires to move these proceedings forward and submits that all the prior delays such as motions to compel and the motion to consolidate can be attributed to Opposers. These delaying tactics are typified by Opposers' recent position (Exhibit 1) that production of non-confidential

materials requires the execution of a protective order as a precondition to any production, including non-confidential materials. The unique interpretation of the Board's recent order indicates continuation of these delaying tactics. However, Applicant moves for reconsideration of the Board's Order of April 30, 2004 regarding both portions of said Order relating to consolidation and to compel production.

Applicant further views the Board's Order with a jaundiced eye due to the statement submitted prior to entry of the Order by Opposers' counsel, a former Board member and attorney. The statement, made without legal support and as an apparent statement of fact, that "If the oppositions are consolidated, as appears likely, ..." is troublesome to Applicant in light of both the statement being made accurate quickly thereafter but also by the Board's failure to address the appropriateness of such an improper statement.

II. Motion to Consolidate

In its Order, the Board relies on various inaccurate statements of fact. The first is that "the marks are the same" (pg. 2). They are not. While admittedly similar, there is vast difference, in light of the legal burdens, between LEXUS and LEXXUS. Secondly, the statement that "the proceedings involve substantial questions of fact and law" is also inaccurate. If the Board is making a comparison only to Opposers' mark and Applicant's initial application (LEXUS), then the statements may be accurate. If the Board is comparing Opposers' mark to both of Applicant's pending applications (LEXUS and LEXXUS), the statement is inaccurate.

As previously submitted, the grounds for Opposers' oppositions can be summarized as one based on dilution (and not infringement due to the differences in the mark(s) and the goods and services related thereto) and, further, Opposers' mark is famous and should be afforded extended trademark rights. The differences in Applicant's marks in its pending applications are substantial in any legal analysis of the grounds claimed by Opposers.

The third inaccuracy is based on the confusion already commencing as reflected by the statement referring to Opposers' request for an extension based on "an identity of the discovery requests". It is given that nearly all oppositions and cancellations contain identical initial discovery requests. Here, as admitted by Opposers' counsel, there is not any additional information to produce, while Applicant must supply separate materials and responses concerning its mark(s). It is Applicant who faces the burden here and the Board, in all due respect, should not be concerned about Applicant's burden when Applicant has strongly opposed consolidation.

The conclusion made by the Board on behalf of Applicant that "consolidation would be equally advantageous to both parties" is not supported by the facts nor shared by Applicant. Applicant strongly disagrees and takes exception to this conclusion made on behalf of Applicant. Furthermore, Applicant is certain that it will not avoid "a duplication of effort or expense" and is equally certain there will be a great increase in effort and expense in attempting to keep the legal and factual analysis separate, as required by the basis upon which Opposers have instituted their challenge of Applicant's marks.

Applicant would submit that as the non-moving party, its request to deny consolidation should be given much greater weight. Opposers were well aware of the many potential costs in time and expense when they commenced these oppositions. It is submitted that Applicant, in the position of defendant in both proceedings, is better able to gauge the inconvenience and effort visited upon it by Opposers' initiation of these two proceedings. There will be substantial differences in the facts (such as with surveys or other fact evidence where the difference between LEXUS and LEXXUS would be great) and the subsequent legal analysis and related legal precedent. Applicant and its counsel has experienced great confusion and duplication of effort as well as the great potential for same when matters requiring different factual and legal analysis are required.

As indicated previously, there are existing trademark registration(s) such as U.S. Registration No. 1596874 for goods (lighting) much more closely related to Opposers' goods (generally automotive products) than Applicant's goods (seeds, plants, flowers). While this registration prevents Opposers from legally establishing dilution of their trademarks, it is relevant hereto by demonstrating Opposers' inability to meet this requirement and then need to keep these oppositions separate.

III. Motion to Compel

The Board has also ordered the parties to produce documents and responses to discovery requests simultaneously. The Board set this deadline despite the service on four (4) separate occasions of discovery requests upon Opposers by Applicant and the resulting lack of any response or production.

Opposers' counsel has admitted to the proper prior service of at least one of Applicant's discovery requests, and thus making Opposers' responses due before the due date of any of Applicant's responses to Opposers' requests.

Therefore, Applicant is entitled to additional time in which to respond to Opposers' discovery requests beyond that provided to Opposers.

WHEREFORE, it is respectfully requested that the Board withdraw its Order of April 30, 2004 and deny Opposers' request for consolidation.

APPLICANT

SYNGENTA PARTICIPATIONS AG

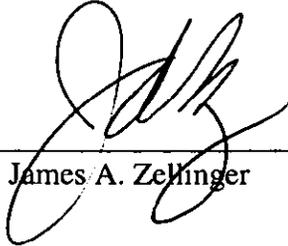
By: 
James A. Zellinger
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Greensboro, North Carolina 27409
Tele. 336-632-7835
Fax. 336-632-2012

CERTIFICATE OF SERVICE

I, JAMES A. ZELLINGER, do hereby certify that I have mailed a copy of the above and foregoing MOTION FOR RECONSIDERATION to Opposer's attorney of record as listed below by placing a copy of same in the U. S. Mail, properly addressed and postage prepaid, to:

David J. Kera
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

on this the 31 day of May, 2004.



James A. Zellinger

EXHIBIT 1



May 20, 2004

James A. Zellinger, Esquire
410 Swing Road
Greensboro, NC 27409

ATTORNEYS AT LAW

DAVID J. KERA
(703) 412-6456
DKERA@OBLON.COM

Re: Toyota Jidosha Kabushiki Kaisha
t/a Toyota Motor Corporation, and Toyota
Motor Sales, U.S.A, Inc., v. Syngenta Participations AG
Consolidated Opposition No.(s): 157,206 & 159,578
Our Ref(s): 238096US-213-21 & 246415US-2006-21

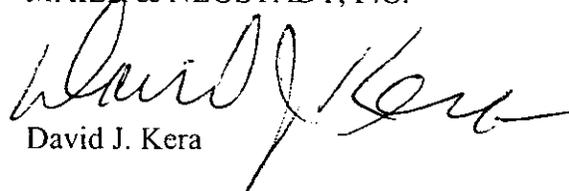
Dear Mr. Zellinger:

In light of the Board's April 30, 2004 Order, I am enclosing a draft of a suggested Stipulated Protective Order.

As you know, the Board has directed the parties to negotiate for a protective order to permit discovery to proceed by May 30, 2004. Please contact me with your comments.

Sincerely yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



David J. Kera

DJK/ASC/kae/ojb {E:\atty\DJK\0213-238096US-ltr.doc}

Enclosure(s): Stipulated Protective Order (proposed)

cc: Karen Rigberg, Esq.
Martin L. Smith, Esq.

EXHIBIT 2

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

MAY

Mailed: 4/30/04

Opposition Nos. 91157206
91159478

Toyota Jidosha Kabushiki Kaisha,
t/a Toyota Motor Corporation and
Toyota Motor Sales, U.S.A., Inc.

v.

Syngenta Participations AG

Linda Skoro, Interlocutory Attorney

This case now comes up on several motions: (1) opposer's motion, filed December 8, 2003, to consolidate the proceedings; (2) applicant's motion, filed October 22, 2003, to compel discovery; (3) opposer's motion to compel and (4) opposer's motion for extension of time to respond to discovery in opposition 91159478. Both parties have opposed the other party's motions. The objections range from failure to make a good faith effort to resolve the discovery dispute, to misplaced requests and timeliness. Applicant also opposes the motion to consolidate. We turn to that motion first.

Motion to Consolidate

A review of the pleadings in the above-identified opposition proceedings indicates that the parties are the same, the marks are the same, and the proceedings involve substantially identical questions of fact and law.

Since the marks being opposed are substantially the same, and inasmuch as the respective plaintiffs have in each instance challenged the right of the other party to registration, it is believed that these proceedings may be presented on the same record without appreciable inconvenience or confusion. Moreover, the consolidation would be equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings individually, as noted by opposer's motion for an extension of time filed in 91159578 alleging an identity of the discovery requests. See Rule 42(a) of the Federal Rules of Civil Procedure.

The consolidated cases may be presented on the same record and briefs. See, *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). As a general rule, from this point on only a single copy of any paper or motion should be filed herein, but that copy should bear all proceeding numbers in its caption. Exceptions to the general rule of one copy involve stipulated extensions of

Opposition Nos. 91157206 & 91159578

the discovery and trial dates and briefs on the case, which require additional copies. See Trademark Rules 2.121(d) and 2.128.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the decision shall be placed in each proceeding file.

The parties are further advised that they are to periodically inform the Board if any subsequent oppositions or cancellations are instituted which involve the same parties and the same issues.

Cross Motions to Compel

A review of the filings in this proceeding reveals that applicant's motion to compel was indeed filed prior to making a good faith effort to resolve the matters. However, the same is true of opposer's motion. As the filings in the proceeding are read, it is clear that the parties had actually agreed that both needed an extension of time to respond to the other's requests, but then were unable to agree as to how much time that would be. This fact, combined with the fact that these motions have been pending for a considerable period of time, gives the Board hope that

Opposition Nos. 91157206 & 91159578

the parties have finally reached agreement on how they would like to proceed to be able to bring this matter to a close.

In the event that the parties have not had ample time to search their records and properly produce all responsive documents, the parties are reminded that discovery in proceedings before the Board is not governed by any concept of priority of discovery or disposition as may exist under the rules of practice of some state or local courts. Rather, a party is under an obligation to respond to an adversary's requests for discovery during the time allowed therefore under the applicable rules, irrespective of the sequence of discovery, or of an adversary's failure to provide discovery. See, *Miss American Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990). The Board expects parties and their attorneys to cooperate with one another in the discovery process, and looks with extreme disfavor upon those who do not. Further, a party has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed, not to unilaterally state it is providing representative samples. Both parties are further reminded of their duty to supplement discovery responses in proceedings before the Board. See Fed. R. Civ. P. 26(e)(2).

It is clear from the fact that neither party has produced anything, that the parties have failed to properly cooperate with one another in the discovery process, and, more specifically, have failed to make a substantive effort to resolve by agreement the issues raised by the motions before coming to the Board. See Trademark Rule 2.120(e). While generally such a failure would result in the denial of a motion to compel, because, in this case, both parties here are responsible, and given the delay occasioned by the Board's inability to timely address these matters, all motions to compel are hereby granted.

The parties have **THIRTY DAYS** from the mailing date of this order to work out their differences, including executing any protective agreement which needs to be put in place; and updating and producing all requested discovery, without any further objections. In order to accomplish these goals, opposer's motion to extend time is granted.

Proceedings are resumed and trial dates are reset as indicated below.

IN EACH INSTANCE, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. Rule 2.125.

Proceedings Resume

5/1/2004

DISCOVERY PERIOD TO OPEN:

5/21/2004

TTAB

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syngenta



06-03-2004

U.S. Patent & TMO/c/TM Mail Popt Ct. #22

May 31, 2004

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Re: *Toyota Jidosha Kabushiki Kaisha t/a Toyota Motor Corporation, and Toyota Motor Sales, U.S.A., Inc., v. Syngenta Participations AG.*
Consolidated Opposition Nos: 157,206 & 159,578

Dear Sirs:

Please find enclosed Applicant's Motion for Reconsideration pertaining to the above-referenced opposition. Please file in conjunction with same.

Thank you for your assistance with this matter.

Very truly yours,

James A. Zellinger

JAZ/sk
Encl.