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

Proceeding	91157206
Party	Plaintiff Toyota Jidosha Kabushiki Kaisha, t/a Toy ,
Correspondence Address	David J. Kera Oblon, Spivak, McClelland, Maier & Neust 1940 Duke Street Alexandria, VA 22314
Submission	Motion for Protective Order
Filer's Name	DJK/ASC/ojb
Filer's e-mail	tmducket@oblon.com, obarrett@oblon.com, acahill@oblon.com
Signature	/David J. Kera, Esq./
Date	03/01/2005
Attachments	Mot.pdf (19 pages)

the famous LEXUS mark, as well as other goods and services also offered under the trademark and service mark LEXUS. Opposers' LEXUS mark is the subject of multiple federal trademark registrations as set forth in Opposers' Notices of Opposition.

Discovery opened in this matter on August 18, 2003. Applicant, on August 12, 2003, six days prior to the opening of discovery, served Applicant's First Request for Production of Documents. *See* Applicant's First Request for Production of Documents attached as Exhibit A. Opposers properly objected to these requests as premature and sought an extension of time to respond to discovery responses served properly within the discovery period. On April 30, 2004, the Board granted Opposers' Motion for Extension of Time and granted Opposers until May 30, 2004 to respond to the discovery requests.

On May 28, 2004, Opposers served electronic copies of documents directly responsive to Applicant's discovery requests. Among these documents are over three thousand pages of representative correspondence, cease and desist letters, documents, memoranda (excluding all confidential client information), examples of third-party uses of LEXUS from the Internet, and other advertising venues including yellow pages advertising, and WIPO UDRP decisions obtained by Opposers regarding the LEXUS mark and use by third-parties. The index that accompanied this production, identifying each document with a brief description thereof, was 383 pages in length.

A supplemental production accompanied Opposers' Supplemental Responses to Applicant's First Request for Production of Documents on July 23, 2004. These documents included representative copies of a advertisements (print and video), brochures, and other promotional materials (T039435 - T040075); raw search data for LEXUS showing third-party uses (T040112 – T040274); copies of correspondence between Opposers and counsel regarding

the availability of the LEXUS mark that was made part of the trial record in *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A. Inc.*, 9 USPQ2d 1442 (DC SDNY 1988)(T040275 - T040309), and a copy of transcript of testimony of David J. Kera in *Mead Data Control, Inc. v. Toyota Motor Sales, U.S.A. Inc.*, 9 USPQ2D 1442 (DC NY 1988)(T040076 – T040111).

Opposers made a second supplemental production on January 21, 2005. The electronically produced documents accompanying Opposers' Second Supplemental Responses to Requests for Production of Documents included thousands of pages of documents generated in connection with the prosecution of *Toyota Motor Sales, U.S.A., Inc. v. Aliments Lexus, Inc.* 1:02-CV-00013.

Despite Opposers' significant production, Applicant's counsel continues to demand additional litigation documents. Opposers' counsel sent a letter to Applicant's counsel on February 24, 2005 asking that Applicant withdraw his requests and Opposer has not yet received a reply.

II. ARGUMENT

Opposers have produced thousands of responsive litigation-related documents. Additional documents would have been produced, but for the parties' inability to resolve their differences regarding the terms of a Stipulated Protective Order.¹ Among the documents produced to date are representative advertisements and thousands of pages of pleadings, deposition transcripts, and discovery documents generated in connection with Toyotas' enforcement efforts against third parties and the litigation in *Toyota Motor Sales, U.S.A., Inc. v. Aliments Lexus, Inc.* 1:02-CV-00013.

¹ Cross-motions for protective orders are pending before the Board.

Opposers have learned recently that thousands, if not tens of thousands, of additional documents that arguably are responsive to Applicant's discovery requests may exist. The production of thousands of additional pages of documents is not required by Board rules and would entail a burden and an expense that far exceeds the likely benefit to Applicant.

The Board's rules provide that information concerning litigation and controversies between a responding party and third-parties regarding the involved mark is discoverable. However, the only information that must be provided with respect to such legal proceedings is the name of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision, if it is published. TBMP § 414(10); *see also Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127, 128 and *Johnson & Johnson Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975)(Applicant's interrogatories requesting identification of legal proceedings between opposer and third parties based on opposer's ownership of its pleaded mark "BAND-AID" were not objectionable, except that opposer need merely identify the legal proceedings by naming the parties involved, listing the jurisdiction and proceeding number, and stating the outcome. Opposer need not identify all documents pertaining to such litigation, such request being too broad and burdensome).

Applicant admittedly has access to PACER, the Federal courts' computerized database. *See* December 3, 2004 letter from counsel for Applicant attached as Exhibit B. Applicant can obtain directly from PACER that information and litigation documents which it believes it needs. Opposers will be saved the great expense of reviewing thousands of documents in its files to screen out those which are protected by the attorney-client privilege or the work product privilege and thereafter producing documents in the public record, which Applicant can locate, and obtain copies of, itself.

Opposers have, at very substantial expense, produced thousands of documents in a good faith effort to respond to Applicant's requests. The burden of further production exceeds any visible benefit to Applicant and is only indirectly related to the issues in the opposition. *See* Rule 26(b)(2), Fed. R. Civ. P.

The Board has acknowledged that, even where parties serve identical discovery requests on one another, a request may be proper when served upon one party, and unduly burdensome when served upon the other. *See Miss America Pageant v. Petite Productions Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990). In the *Miss America* case, the Board held that certain requests that were proper when served upon respondent were unduly burdensome when served upon petitioner because petitioner used its marks for over seventy years, while respondent used its mark for only two to three years.

Opposers have manufactured and sold LEXUS brand luxury automobiles in commerce for approximately fifteen years. The number of LEXUS vehicles sold since 1989, when the vehicles first appeared on the market, number in the hundreds of thousands. In contrast, the opposed applications were filed on July 19, 2003 (LEXUS) and November 15, 2002 (LEXXUS), and are based on Applicant's *bona fide* intent to use LEXUS and LEXXUS in commerce.² Consequently, Applicant's discovery requests seeking for example, "All documents that relate or refer to Opposers or Opposers' use of its mark" (Applicant's Request No. 13) or "All documents that relate or refer to each use, including each claim of use or possible use, past or present, by any third party of the mark" (Applicant's Request No. 3), are unduly burdensome when served upon Opposers. Accordingly, Opposers should be permitted to stand on their document production provided to date in response to these requests.

² Applicant claims to have used or planned to use the LEXUS and LEXXUS marks abroad, but such use is irrelevant to this proceeding.

By contrast to Opposers' production, Applicant has produced approximately 500 pages of documents comprised almost entirely of (1) Internet print-outs of foreign trademark database references to foreign LEXUS marks (including third-party LEXUS registrations/applications in Australia, Columbia, Denmark, Germany, Hungary, Ireland, Switzerland, and the UK), (2) Applicant's March 2004 Press Release from Syngenta announcing LEXAR as new brand name for corn herbicide, (3) USPTO TESS search results for marks that are registered for vehicles and other goods, (4) third-party uses of LEXUS, and (5) published court decisions.

The disparity in quality and quantity of production is a factor for consideration in Opposers' favor.

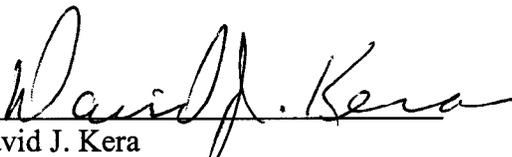
III. CONCLUSION

For the forgoing reasons, Opposers respectfully request that the Board enter an Order preventing Applicant from seeking further discovery in this matter.

Respectfully submitted,

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

By:


David J. Kera
Amy Sullivan Cahill
Oblon, Spivak, McClelland,
Maier, & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax: (703) 413-2220
e-mail: tmocket@oblon.com

Date: March 1, 2005
DJK/ASC/ojb {I:\ATTY\DJ\0213-238096US-MOT.DOC}

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSERS' MOTION FOR PROTECTIVE ORDER** was served on counsel for Opposer, this 1st day of March, 2005, by sending via First Class mail, postage prepaid to,

James A. Zellinger, Esquire
SYNGENTA CROP PROTECTION INC.
410 Swing Road
Greensboro, North Carolina 27409

D. Jean Barrett

EXHIBIT A

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

In the Matter of Application Serial No. 78145546 "LEXUS" Filed July 19, 2002

TOYOTA JIDOSHA KABUSHIKI KAISHA)
d/b/a TOYOTA MOTOR CORPORATION,)
)
Opposer)
)
v.)
)
SYNGENTA PARTICIPATIONS AG)
)
Applicant.)

**APPLICANT'S FIRST REQUEST FOR PRODUCTION OF
DOCUMENTS**

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

Pursuant to 37 C.F.R. § 2.116; 2.120; et seq. and Rules 26 and 33 of the Federal Rules of Civil Procedure, Applicant, Syngenta Crop Protection, Inc., hereby requests that Opposer, produce for inspection and copying at the offices of James A. Zellinger, at Syngenta Corp., 410 Swing Rd., Greensboro, N.C. 27409, complete and legible copies of the following designated documents and things which are the subject matter of this action, which are in Opposer's possession, custody or control.

DEFINITIONS

1a. "Opposer" or "Plaintiff" means Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation, its predecessors in interest, if any, any and all corporations, firms or other persons owned or controlled by or owning or controlling defendant, present and former officials, executives, officers, employees, attorneys and agents of it, its predecessors in interest and/or such owned or controlled or owning or controlling persons; and all other persons acting or purporting to act on behalf of defendant, its predecessor(s) in interest and/or such owned or controlled or owning or controlling persons.

1b. "Applicant" or "Defendant" means Syngenta Crop Protection, Inc.,

2. "Mark" or "Trademark" means the marks 'Lexus', 'Lexus', any similarity thereto, and any use including use with other marks or terms, or in conjunction with other words or term.

3. "Document" means any medium to which plaintiff has or has had access, custody, control or possession, and upon which intelligence or information is recorded or from which intelligence or information can be recorded, including but without limiting the generality of the foregoing, punch cards, magnetic tape or wire, print-out sheets, movie film, slides, phonograph records, photographs, microfilm patents and applications therefor, notes, letters, memoranda, ledgers, work sheets, books, magazines, reprints, summaries, reports, studies, projections, notebooks, diaries, calendars, appointment books, registers, graphs, charts, sketches, drawings, plans, blueprints; tables, calculations, specifications, analysis, papers, agreements, contracts, purchase orders, acknowledgments, invoices, authorizations budgets, schedules, transcripts, advertisements, correspondence, telegrams, telexes, teletypes, drafts, minutes of meetings of board of directors and executive committee, and each copy or draft of any of the foregoing which is non-identical because of marginal notations or otherwise.

4. "Person" includes any firm, corporation, partnership, joint venture, organization, association, entity, trust, labor union, government, governmental agency or court, unless the context clearly indicates that reference is made to only a natural person.

5. "Identify" means, with respect to a document (or a draft thereof), to state all of the following information:

(a) The date appearing on such document, and if no date appears thereon, the answer shall so state and shall give the date or approximate date such document was prepared;

(b) The identifying or descriptive code number, file number, title or label of such document;

(c) The general nature of description of such document (i.e., whether it is a letter, memorandum, drawing, etc.) and the number of pages of which it consists;

(d) The name of the person who signed such document, and if it was not signed, the answer shall so state and shall give the name of the person or persons who prepared it;

(e) The name of the person to whom such document was addressed and the name of each person other than such addressee to whom such document, or copies thereof, were given or sent;

(f) The general subject matter of such document;

(g) The location(s) where the document has been stored and identify the person having possession, custody or control of such document;

(h) Whether or not any draft, copy or reproduction of such document contains any postscript, notation, change, revision, addition, deletion or addendum not appearing on said document itself, and if so, the answer shall give the description as herein defined of each such draft, copy or reproduction; and

(i) Whether or not it is claimed that such document is privileged, and if so, the type of privileges claimed, whether the information contained or referred to in such document is in the possession of any other person(s), and if so, identify such person(s) and state how the information came into their possession, and a statement of all of the circumstances which defendant will rely on the support such claim or privilege.

The foregoing information shall be given in sufficient detail to enable a party or person to whom a request or subpoena is directed to identify fully the document for production and to enable counsel for plaintiff to determine that such document when produced is in fact the document is described. If any such document was, but is no longer, in defendant's possession or custody, or subject to its control, or in existence, state whether it is (1) missing or lost, (2) has been destroyed, (3) has been transferred, voluntarily or involuntarily, to others, or (4) otherwise disposed of, and in each instance, explain the circumstances surrounding and authorization for such disposition thereof and state the date or approximate date thereof.

In lieu of the foregoing identification, production of such document may be made (each document to be designated as responsive to the particular interrogatory calling for its identification); except that (1) each document to which a claim of privilege is asserted must be identified in the manner described above, and (2) each document which is no longer in defendant's possession or custody or subject to its control, or in existence must be identified in the manner described above.

6. "Identify" means, with respect to any natural person, to state to the extent known the following information about the person:

- (a) His full name;
- (b) His present address and if that is not known, his last known address and the last known date he resided there; and
- (c) If such person is or was ever employed by defendant, the individual's employment history with applicant by date, job description and title.

7. "Identify" means, with respect to any entity other than a natural person, to state:

- (a) The full name of title thereof and its state of incorporation where applicable;
- (b) The principal place of business thereof;
- (c) The nature or type of entity, if known, and
- (d) The principal business thereof.

8. "Communication" means and includes any form of communication from one person to another, whether written or oral.

9. "Identify" means, with respect to communication, to state all of the following information:

(a) Whether it is written or oral;

(b) If oral, state (i) the substance of the oral utterance, (ii) the date and place thereof, (iii) identify the persons making the oral utterances, and (iv) identify each person who was present at the time the oral utterance were made; and

(c) If written, identify all documents which reflect the communication and all documents which pertain, refer or relate in any manner whatsoever to the communication.

10. Where the context herein makes it appropriate, each singular work shall include its plural and each plural word shall include its singular.

DUTY TO SUPPLEMENT

These requests for production of documents shall be deemed continuing, and Toyota shall be obligated to change, supplement and amend its answers as prescribed by Rule 26 (e) of the Federal Rules of Civil Procedure.

PRIVILEGE

If any information called for by the requests is withheld on the basis of a claim of privilege, the nature of the information in respect of which it is claimed shall be set forth, together with the type of privilege claimed and a statement of all of the circumstances which Opposer will rely on to support such claim of privilege.

REQUESTS FOR PRODUCTION

1. Representative samples of all product and advertising representing the use or intended use of the mark 'LEXUS' thereto by Opposer.

2. All trademark searches, applications, surveys, copies thereof, regarding the mark ordered by, conducted by, filed by, or maintained by Opposer.

3. All correspondence, cease and desist letters, documents, memoranda (excluding all confidential client information) possessed by Opposer or its counsel regarding the mark and use by third parties and/or licensees.

4. All documents including invoices, receipts, shipping invoices, bills of lading, order forms, reflecting the sale of any products by Opposer bearing the mark since January 1, 1998.

5. All documents relating to or identifying any alleged confusion, or claim or report of confusion, by any customer of Opposer or third party(ies).

6. All documents showing the development, nature and use of each product and service Opposer has marketed or plans to market in connection with any 'Lexus' mark.

7. All documents sufficient to identify Opposer's annual dollar and unit volumes of sales in the United States for each product and service sold in connection with each of its 'Lexus' marks since Oppser's first sale of each such product and service or Jan.1, 1998, whichever is later.

8. All documents that reveal the prices charged to customers for each product and service marketed or sold by Opposer in connection with the mark.

9. All documents that reveal Opposer's annual marketing expenses in the United States for each product and service marketed in connection with the mark, including but not limited to, expenses for advertising and promotion.

10. All documents that reveal representative outlets through which Opposer's products and services have been sold or offered for sale to customers in connection with the mark.

11. All documents that reveal the channels of trade through which Opposer has promoted or advertised, or currently promotes or advertises, products and services in connection with the mark.

12. All documents that relate or refer to Opposer's marketing or future marketing of products and services in connection with the mark, including but not limited to representative specimens of all advertisements, promotional materials, and other documents Opposer uses or plans to use in the advertising or promotion, or planned advertising or promotion, of Opposer's products and services marketed in connection with the mark.

13. All documents that relate or refer to Opposer or Opposer's use of its mark.

14. All documents that relate or refer to any instances or possible instances of confusion, mistake, or deception which have or may have occurred between Opposer or Opposer's use of the mark, and Applicant's or Third Party(ies)'s use of the mark or any similarity to said mark.

15. All documents that relate or refer to each use, including each claim of use or possible use, past or present, by any third party of the mark.

16. All documents that constitute, relate to, or refer to any formal or informal investigation, including, but not limited to research, searches, surveys, tests, or studies of any kind, that Opposer has conducted or has knowledge of pertaining to Applicant's, Opposer's, or any third party's use of the mark, or pertaining to any of the products or services or the markets for the products or services identified by any of the aforesaid marks.

By:



James A. Zellinger
Trademark Counsel
Syngenta Crop Protection, Corp.
410 Swing Rd.
Greensboro, N.C.27409

CERTIFICATE OF SERVICE

I, JAMES A. ZELLINGER, do hereby certify that I have mailed a copy of the above and foregoing Applicant's First Request for Production of Documents 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 12 day of August, 2003.



James A. Zellinger

EXHIBIT B



James A. Zellinger
Trademark Counsel

Syngenta Crop Protection, Inc.
410 Swing Road
Greensboro, NC 27409
Tel: (336) 632-7835
Fax: (336) 632-2012

December 3, 2004

RECEIVED

DEC 06 2004

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

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

Re: *Toyota Jidosha Kabushiki Kaisha t/a Toyota Motor Corporation, and Toyota Motor Sales, U.S.A., Inc., v. Syngenta Participations AG*
Opposition No.: 157,206
Your Ref. 238096US-213-21

Dear Mr. Kera,

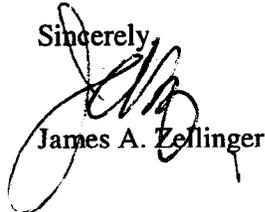
I am in receipt of your letter of November 23, 2004, which I received on November 29, 2004, some seven (7) weeks after my initial request of October 8, 2004.

It is obvious that your letter of November 23 is in error. The docket number was not incorrect and is the same as appears on the attachment to your letter. Secondly, the case name was not incorrect but an abbreviation of the extremely long case caption. (Unless you are claiming that the mis-spelling of Aliments [not Alements, as mis-spelled in my letter] has caused confusion, in which case, please identify any other legal action involving Toyota and Alements Lexus or Aliments Lexus).

Applicant was not previously supplied with the documents requested earlier, other than the Pacer summary which I had already obtained from other sources. The CD you reference does not have many of the documents and pleadings identified in said Pacer summary. Those documents, along with the many other legal proceedings involving Toyota and the Lexus mark should have been provided well before this date and are long overdue. None of the pleadings have been produced to date, only cease and desist letters.

Finally, your letter absurdly references the lack of a protective order. I am well aware that there is not a protective order in place due to your dilatory and obstructionistic tactics delaying such an order. Obviously, you need assistance in understanding my letter, which merely demands the many documents that are outstanding as referenced above, and would not be covered by any protective order. In other words, as stated in my letter of October 8, your client must produce these documents, currently outstanding, that should not and cannot be withheld, (as they have been to date, for whatever reason) on the claim of privilege or the lack of an existing protective order (as they would not be covered by any protective order). I expect a prompt response and production of said overdue documents.

Sincerely,



James A. Zellinger

JAZ/sk