

TAB

James A. Zellinger
Trademark Counsel

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April 7, 2005

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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 Sir or Madam:

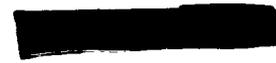
Please find enclosed APPLICANT'S MOTION FOR RECONSIDERATION pertaining to the above-referenced consolidated opposition. Please file in conjunction with the same.

Thank you for your assistance with this matter.

Very Truly Yours,

James A. Zellinger
Trademark Counsel

JAZ/sk
encl.



04-11-2005

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

TOYOTA JIDOSHA KABUSHIKI KAISHA)	Opposition No. 157, 206
d/b/a TOYOTA MOTOR CORPORATION,)	Serial No. 78/145,546
)	Mark: Lexus
and TOYOTA MOTOR SALES, U.S.A., INC.)	
)	
Opposers)	
)	CONSOLIDATED OPPOSITION
)	
)	
v.)	Serial No.: 78/185,538
)	Filed: Nov. 15, 2002
)	Mark: LEXXUS
)	
)	
SYNGENTA PARTICIPATIONS AG)	
)	
Applicant.)	

APPLICANT'S MOTION FOR RECONSIDERATION

Applicant, Syngenta Participations AG, requests the Board reconsider and modify its Order of March 11, 2005 (Ex. 1, attached hereto). Applicant was not afforded an opportunity to file its objection and opposition to Opposers' (Second) Motion For a Protective Order which sought a complete termination of discovery in this matter. Applicant objects to Opposer's request and would ask clarification and modification of the Board's Order.

I. The Board's Order

While the majority of the Board's Order (Ex.1) addressed an earlier request by Opposers regarding a dispute over the wording of a confidentiality agreement and

protective order, it briefly addressed Opposers second motion for a protective order. It is this portion of the Order that Applicant requests reconsideration and clarification as Applicant was not permitted the opportunity to timely respond when the Order was entered prior to expiration of the time provide for Applicant to respond.

In summary, the Order denied Opposers' request except it permitted Opposers to limit their response to 'third-party litigation documents' request by Applicant to merely "identify relevant [third-party] litigation. Thus, Opposers' request to "prevent Applicant from seeking further discovery in this matter" was denied. If this is an inaccurate interpretation, the Board is respectfully requested to clarify it.

II. Applicant's Request

The Order limited Opposers' duty to respond to discovery requests to having to only identify the parties thereto in the inquiries made by Applicant regarding third-party litigation. The Order expressly denied Opposers' request to terminate discovery and avoid responding to Applicant's other discovery requests. In light of that language, this request for reconsideration is limited to the following:

1. Settlement agreements, expert and survey reports, and court decisions relating to the third-party litigation identified in Applicant's discovery requests.
2. Materials listed but not available on the 'Pacer' court litigation system.

The basis for this request for these two requests, more fully discussed below, is their unavailability to Applicant, complete absence of any burden to Opposers, Opposers' false representations, and their certain relevance to this proceeding.

II Failure To Comply With 37 C.F.R. § 2.120(e)

Opposers have not made a good faith effort to comply with 37 C.F.R. § 2.120(e). While this requirement may not be applicable to a request for a protective order, Opposers have falsely claimed in their request that they have complied with this 37 C.F.R. § 2.120(e). Due to

the misrepresentation alone, Opposers' request should have been denied and Applicant's current and limited request granted.

Opposers failed to attempt a good faith effort to comply with 37 C.F.R. § 2.120(e)(1) by conference or correspondence (or any effort at all) to resolve the issues presented in Opposers' Motion For Protective Order. Counsel for Opposers' sent one letter to Applicant's counsel (referenced on page 3 of Opposers' motion as "letter of February 24, 2005"; not attached as an exhibit thereto but attached hereto as Ex.2). Said letter (Ex.2) demanded a response within ten (10) days but Opposers filed their motion less than 3 days after receipt by Applicant's and within five (5) days of the mailing of the letter. This letter (Ex.2) was a partial response to Applicant's letter of Dec. 3, 2004, mailed by Opposers' counsel some eighty-three (83) days later (Ex. B of Opposers' motion; yet Opposers' counsel apparently cannot wait the ten days that he unilaterally sets before filing this request).

Opposers' demand for a response within ten (10) days followed by their refusal to abide by their unilateral ten day deadline not only reflects Opposers' bad faith and dilatory tactics (discussed below and in Applicant's earlier motions or responses) but its failure to comply with the requirement of 37 C.F.R. § 2.120(e).

As held in Sentrol, Inc. v. Sentex Systems, Inc. 1986 TTAB LEXIS 94; 231 U.S.P.Q. (BNA) 666; May 9, 1986), good faith takes more than a last minute letter, holding that the a party's unwillingness to both discuss the confidentiality agreement/protective order and discovery responses by telephone (the party "has been unwilling to discuss by telephone the protective order and issues raised in discovery requests"), constituted lack of good faith and non-compliance with 37 C.F.R. § 2.120(e)(1).

While the Board may dismiss the importance of Opposers failure to comply with the good-faith requirement, the imposition of sanctions in the form of complete denial of Opposers request is a minimal and reasonable penalty for the (repeated) false representations to the Board.

III. Lack Of Burden

Not surprisingly, Opposers were less than honest with the Board concerning this issue. Previously and currently, Opposers have pursued dilution claims in various federal courts

producing identical or similar information as has been produced to date herein (See Ex.3, affidavit of J. A. Zellinger, ¶ 2&6; (See also Toyota Motor Sales v. Profile Cocktail Lounge; 2001 U.S. Dist. LEXIS 1393; Toyota Motor Sales, et al v. Aliments Lexus Foods, Inc., et al; Civil Index # CV020013(DGT, EDNY 2002); Lexus Development Company v. Toyota Motor Sales, et al. Civil Index # CV02-CV-0138(DND 2002). Said information herein and in some, if not all, of those matters above have been reduced to documents on a discovery computer disc (“CD”); See Ex.3, ¶ 6).

Opposers are again less than honest in failing to admit that there were tens of thousands of documents produced in the above proceedings and that few additional materials were specifically added to the partial production made to date herein from those documents previously and recently produced in the above matters (Ex.3, ¶ 2&6, and Ex.4).

Thus, there is little or no burden to Opposers as most of the materials sought would be easily found in these proceedings, the majority of which were instituted by Opposers.

IV. Unavailability of Materials

As stated above, Opposers’ basis for their oppositions herein is the alleged ‘dilution’ of their mark for automotive goods and services. Despite the agreement to enter into a protective order shielding various confidential materials which has yet to occur, Opposers are apparently concealing the various settlement agreements reached in at least two of the federal court proceedings identified above. These agreements are extremely relevant to the issue of dilution as they could limit or expand Opposers’ alleged trademark rights and could certainly lead to discoverable information not in the control or accessible to Applicant. They are not available to Applicant by other means (Ex.3).

The precedent cited by Opposers in their motion for a protective order is distinguishable and inapplicable hereto as it does not address unavailable and confidential documents. There is no other access to these materials by Applicant. They are certainly relevant to the ‘dilution’ issue.

In Johnson & Johnson v. Rexall Drug Company, 186 USPQ 167, 172 (TTAB 1975), discovery of identical information, as sought here, was permitted despite it being third-party

litigation materials, “as it might tend to show limitations on opposers’ rights or inconsistencies with opposers’ statements in this proceeding” at 172 (emphasis added). Furthermore, “where parties have actually entered into written agreements, including licensing agreements and other written contractual understandings, on the basis of which a dispute has been settled in avoidance of litigation or as a settlement thereof, such agreements are proper matters for discovery since they may tend to show limitations on a party's rights in its mark or reveal inconsistencies with statements subsequently made by a party thereto in the pending proceeding” at 197. Georgia-Pacific Corporation v. Great Plains Bag Co., 190 USPQ 193(1976); See: Johnson & Johnson v. Rexall Drug Company, (supra). It has also been “ adjudged that applicant's questions concerning licensing agreements and arrangements between opposer and third parties and its use thereof by opposer should be answered”. Johnston Pump/General Valve, Inc. v. Chromalloy American Corporation, 10 USPQ 2d 1671(1988).

Opposers also make reference to Applicant’s access to the “PACER system”. However, as typical with their less than honest approach, Opposers are aware that many of the documents identified on said system are not available. This is especially true in the matter of Toyota Motor Sales v. Profile Cocktail Lounge; 2001 U.S. Dist. LEXIS 1393, where the Court initially ruled against Opposers’ claim of dilution but the decision was vacated and a confidential settlement made between the parties which included Opposers (Ex. 3).

V. Opposers’ Dilatory Conduct And Obstructionistic Tactics

It has been previously established that Opposers are actively delaying and obstructing the current oppositions as discussed in more detail in Applicant’s response to Opposers’ earlier requests for a protective order and Opposers’ request for consolidation. Opposers are clearly continuing to employ those tactics.

By their conduct herein, such as failing to discuss with Applicant’s counsel, the unilateral demand for a response within ten (10) days but only waiting a few days before filing their motion, and the motion to terminate Applicant’s discovery rights, it is obvious that Opposers main goal is to delay and obstruct these proceedings (See Ex.2&4).

It is obvious by examination of lack of response to Applicant's many letters, the failure to undertake any good faith discussions to address earlier filed request of Opposers that they have adopted a course of delay and obstruction.

VI. Conclusion

Applicant would move this Board to modify its Order and deny Opposers' motion in its entirety, as a sanction, on the grounds of Opposer's failure to comply with 37 C.F.R. § 2.120(e)(1) and false statements that they had so complied.

In the alternative, Applicant would request that the Board's Order be modified to permit discovery of the limited materials sought by Applicant such as the settlement agreements, expert and survey reports, court decisions relating to the third-party litigation above, and materials listed, but not available, on the 'Pacer' court litigation system. This request due to the complete lack of burden to Opposers coupled with the unavailability to Applicant is reasonable and necessary, especially as Applicant did not have the opportunity to respond to Opposers' request prior to the Board issuing its Order.

WHEREFORE, upon the good cause shown, the Board's Order of March 11, 2005 should be modified to permit Applicant discovery of the limited items sought herein.

Respectfully submitted,

SYNGENTA PARTICIPATIONS AG

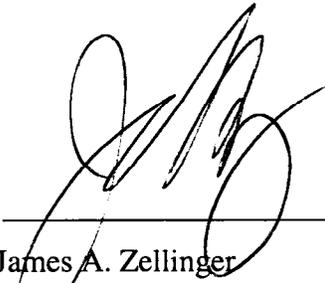
By: 
James A. Zellinger
Syngenta Crop Protection, Inc.
410 Swing Road
Greensboro, North Carolina 27409
Tele. 336-632-7835
Fax. 336-632-2012

CERTIFICATE OF SERVICE

I, JAMES A. ZELLINGER, do hereby certify that I have mailed a copy of the above and foregoing APPLICANT'S MOTION FOR RECONSIDERATION to the 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 7th day of April, 2005.



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

EXHIBIT 1

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MAR 17 2005

Mailed: March 11, 2005

Opposition Nos. 91157206
91159578

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

v.

Syngenta Participations AG¹

Linda Skoro, Interlocutory Attorney

This case now comes up on the parties' motion for entry of a protective order, filed October 1, 2004, by opposer and filed November 19, 2004, by applicant². As the dispute continues, opposer filed another motion on March 1, 2005.

The parties are unable to agree to one specific provision in an otherwise complete protective agreement. The controversial sentence appears to be: "Material in evidence in this proceeding only upon consent of the other party or party not creating said deletions." Applicant

¹ Applicant is advised that it needs to include the opposition proceeding numbers in its caption to avoid delay in having its papers associated with the file.

² Opposers' motion to strike applicant's surreply, filed December 17, 2004, is hereby granted and applicant's motion to add exhibits to its surreply, filed December 17, 2004, is hereby denied as moot.

wants this language added to the sentence that reads:
"Deletions made from any material in accordance with the terms of this protective order shall not affect the admissibility of any such material in evidence in this proceeding." Applicant is concerned that without this controversial sentence, admissibility of confidential material will be affected, in that applicant may be forced to waive its rights to object to the admissibility of materials produced by opposers. Applicant requests either complete deletion of the entire paragraph or inclusion of its controversial sentence.

Opposers' position is that "if a party offers in evidence only part of a confidential document produced by an adverse party, the remedy is not to object to admissibility, but to offer the entire document." The Board agrees.

The Federal Rules of Civil Procedure and Trademark Rule 2.122 govern admissibility of evidence. In similar matters, namely non-confidential evidence, the rules allow a party to enter any other portion of an admitted document if it believes that the partial admission, by its opponent, has been unfairly redacted. See 37 CFR § 2.120(j)(4) & (5). In such a circumstance, the appropriate response is submission of additional material, in this case as confidential, and not an objection to its admissibility, or its designation as

confidential. Any objection to admissibility is decided at final hearing. See TBMP § 702.02(c) (2d ed. rev. 2004).

Accordingly, applicant's controversial sentence is unnecessary. The parties have TWENTY days to put in place a protective agreement, or the Board will impose its own protective agreement that is set out in the appendix to the Board's manual of procedure and on the Board's website.

The Board now turns to opposers' most recent filing involving the continued request by applicant for opposers to produce copies of third-party litigation documents. Such information is discoverable. However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). See *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975) and *Johnson & Johnson v. Rexall Dug Co.*, 186 USPQ 167, 172 (TTAB 1975). Accordingly, opposers' motion is granted to the extent it does not have to produce copies of documents, but need only identify relevant litigation.

The trial dates are reset, including discovery, to accommodate the parties' supplementing of their responses

after the protective agreement is in place³. The trial dates are reset as follows:

Discovery period to close:	5/15/2005
30-day testimony period for party in position of plaintiff to close:	8/13/2005
30-day testimony period for party in position of defendant to close:	10/12/2005
15-day rebuttal testimony period to close:	11/26/2005

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. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

.oOo.

³ While applicant objected to the extension of the discovery period, claiming it was a dilatory tactic on the part of opposer, it states that there are still many outstanding discovery responses.

EXHIBIT 2



February 24, 2005

VIA FACSIMILE

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*
Oppositions No.: 157,206
Our Ref: 238096US-213-21

Dear Mr. Zellinger:

I received your letter of January 24, 2005 demanding that Toyota produce "all litigation documents regarding the above-reference marks during the applicable period."

After reviewing and considering all past and present requests for production of documents and things propounded by Applicant we believe that your demand is unreasonable and unduly burdensome for the following reasons.

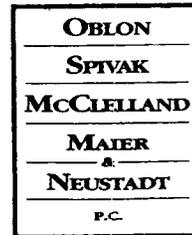
(1) With respect to litigation involving the LEXUS mark, Toyota is only required to provide the names of the parties thereto, the jurisdiction, the proceeding number, the outcome and the citation of any published decision. TBMP § 414(10), citing *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127, 128 and *Johnson & Johnson Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975).

(2) Toyota previously has produced thousands of pages of litigation-related documents.

(3) Syngenta produced approximately five hundred pages of mostly irrelevant materials. The great disparity in the quality and quantity production weighs in favor of Toyota's position. *See Miss America Pageant v. Petite Productions Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990).

Mr. James A. Zellinger, Esquire
238096US-213-21

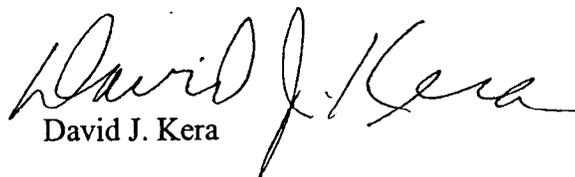
Page 2



In view of the forgoing, I ask that you withdraw the requests. I would appreciate receiving your response within ten days.

Sincerely yours,

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


David J. Kera

DJK/ASC/ojb {I:\atty\Djk\213-238096US-ltr.doc}

EXHIBIT 3

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)	Serial No.: 78/145,546
)	
v.)	Filed: July 19, 2002
)	
SYNGENTA PARTICIPATIONS AG)	Mark: LEXUS
)	
Applicant.)	

TOYOTA JIDOSHA KABUSHIKI KAISHA)	
d/b/a TOYOTA MOTOR CORPORATION,)	
)	
and)	
)	
TOYOTA MOTOR SALES, U.S.A., INC.)	
)	
Opposers)	Serial No.: 78/185,538
)	
v.)	Filed: Nov. 15, 2002
)	
SYNGENTA PARTICIPATIONS AG)	Mark: LEXXUS
)	
Applicant.)	

AFFIDAVIT

James A. Zellinger, being duly sworn, deposes and states as follows:

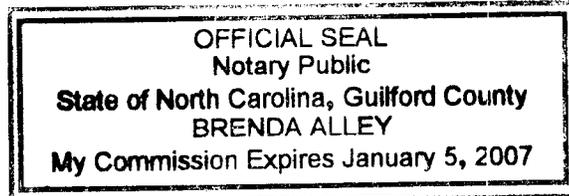
1. I am counsel for Applicant in the above captioned matter.
2. I have spoken to counsel for Aliment, Lexus Foods, Inc., the defendant in the current federal court action, Toyota Motor Sales, et al v. Aliments Lexus Foods, Inc., et al ; Civil Index # CV020013(DGT; EDNY;2002).
3. While materials that were covered by the protective order in that matter were not discussed, some of the materials produced were identical to those produced herein.
4. I was advised that much of the materials supplied to defendant's counsel in that matter,

- including both discovery information and pleadings, was supplied on CD disc.
5. Counsel for defendant was unable to provide any of this information due to concerns about the confidentiality agreement in effect between Opposers and that defendant.
 6. I was further advised that the information such as pleadings, exhibits, and agreements were easily accessible as they had been copied onto a CD.
 7. In Toyota Motor Sales v. Profile Cocktail Lounge; 2001 U.S. Dist. LEXIS 1393, a federal action heard in Illinois was the subject of a court decision which was subsequently vacated and a confidential settlement agreement was eventually entered into between Opposers and the defendant.
 8. Upon information and belief, the settlement agreement and initial court decision affected the trademark rights of Opposers and permitted the use of a variation of the Lexus mark.
 9. I participate in and have access to the U.S. Federal Court "PACER" System. However, on many occasions, including an attempt to obtain documents from the above referenced federal court actions, documents identified on Pacer are not available or accessible from the court or the system.

This statement is made freely and voluntarily and under the penalty of perjury.


James A. Zellinger
Syngenta Crop Protection, Inc.
410 Swing Rd.
Greensboro, N.C. 27410

SWORN to before me this 5th day of April, 2005




Notary

EXHIBIT 4



James A. Zellinger
Trademark Counsel

Syngenta Crop Protection, Inc.
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e-mail: jim.zellinger@syngenta.com

March 3, 2005

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

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 February 24, 2005. I note that this response was made some 31 days after my letter of January 24, 2005. I also note the request for a response within ten (10) days. This request is laughable and quite contrary to your practice of lengthy delays in responding to my correspondence.

Under North Carolina rules, which are typical of many other state's ethical requirements, your late or absent responses would be sanctionable. I also note that the refusal to produce relevant requested documents is part of Opposers' obstructionistic and delay tactics.

Addressing your numbered points, I would submit:

1. The cases cited by you are quite distinguishable from this opposition. The major claim submitted herein by Opposer is the claim of dilution of its trademark. Any agreement and proceedings which impact on that issue, such as permitting some use of the mark or variations of it, are certainly relevant. These materials must be produced.
2. The "thousands" of documents are a mere portion of what is relevant and what needs to be produced. I do not have to remind you that your client instituted this opposition and should have been prepared for substantial document production.

Applicant's production request is far from burdensome or prejudicial since the documents sought have already been requested or produced in recent or current litigation. The effort required to copy and produce these documents is minimal. This is especially true when compared with an initial investigation to locate and examine documents in Opposer's possession when production in other litigation has not occurred.

James A. Zellinger
Trademark Counsel

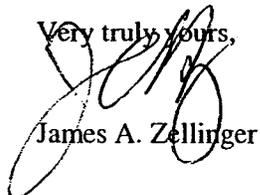
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Tel 336-632-7835
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e-mail: jim.zellinger@syngenta.com

3. The lack of a voluminous production by Applicant is irrelevant. Applicant will not manufacture documents or produce records that are irrelevant to the opposition. Applicant's mark was sought through an Intent-to-Use trademark application and the lack of use, or records related to any use, can be attributed, in part, to the improper and baseless threats of Opposer. Again, Opposer was aware of this likelihood when it initiated these proceedings.

Please note that I will consider my earlier letters, your response of February 24, and this correspondence to be Applicant's compliance with 37 C.F.R. § 2.210(e) should further production not be forthcoming.

Very truly yours,

A handwritten signature in black ink, appearing to read 'JAZ', is written over the typed name 'James A. Zellinger'.

James A. Zellinger

JAZ/sk