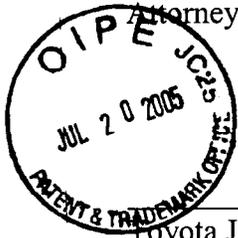


Attorney Docket No.: 238096US-21



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

\_\_\_\_\_  
 Toyota Jidosha Kabushiki Kaisha, )  
 t/a Toyota Motor Corporation, )  
 and )  
 Toyota Motor Sales, U.S.A., Inc., )  
 )  
 Opposers )  
 )  
 v. )  
 )  
 Syngenta Participations AG, )  
 )  
 Applicant )  
 \_\_\_\_\_)

**CONSOLIDATED**

Opposition No.: 157,206  
 Mark: LEXUS  
 U. S. Appln. Serial No.: 78/145,546  
  
 Opposition No.: 159,578  
 Mark: LEXXUS  
 U. S. Appln. Serial No.: 78/185,538

**OPPOSERS' RESPONSE TO APPLICANT'S MOTION TO DISMISS OPPOSITION**

Opposers, Toyota Kabushiki Kaisha t/a Toyota Motor Corporation and Toyota Motor Sales, U.S.A., Inc., submit this Response to Applicant's Motion to Dismiss Opposition.

In its Motion, Applicant argues that the Opposition should be dismissed because (1) Opposers failed to comply with the Board's Order of March 11, 2005, and (2) Opposers have failed to respond to various discovery requests propounded by Applicant. Neither ground is supported by the record.

**Board's March 11, 2005 Order**

In its Order, the Board wrote:

Opposers' position is that 'if a party offers in evidence only a 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.**

...  
**Accordingly, applicant's controversial sentence is unnecessary.**



Board's March 11, 2005 Order (emphasis added). The Board went on to direct the parties to put in place a protective agreement, within twenty days of mailing of the Order, **or the Board would impose its own protective agreement set out in the appendix to the Board's manual of procedure.**

On March 22, 2005, Opposers' counsel wrote to counsel for Applicant asking that in light of the Board's Order, Applicant agree to the entry of a protective order without the inclusion of the disputed and unnecessary language<sup>1</sup>. See copy of letter to Applicant's counsel attached as Exhibit A.

When on March 31, 2005, counsel for Opposers had not received a response from counsel for Applicant, Opposers' counsel contacted Applicant's counsel by telephone. At that time she was informed that Applicant was unwilling to agree to enter Opposer's proposed protective order, given the late timing of the phone call.

Given the Board's finding that the language proposed by Applicant was unnecessary to the protective order and given Applicant's counsel's inability to agree to remove the controversial language, Opposers requested that the Board enter Opposers' tendered protective order. In the event that the Board sees fit to enter its own form protective order, this is for the Board, not for Opposers. Opposers have not violated the terms of the Board's Order.

#### **Opposers' Compliance with Applicant's Discovery Requests**

Opposers have produced thousands of pages of documents and a privilege log numbering in the hundreds of pages. There has been exactly one motion to compel filed by Applicant during the course of this proceeding. In its only motion to compel, filed October 22, 2003, Applicant argued that Opposers had failed to respond to discovery requests first served before

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<sup>1</sup> Opposers' counsel specifically requested that Applicant's counsel correspond with Amy Sullivan Cahill, Esq., a colleague in his office, during his absence. The dateline in Opposers' letter incorrectly shows February 24, 2005, but the attached facsimile confirmation page reflects the correct transmission date of March 22, 2005.

the opening day of the discovery period. Opposers countered with a cross-motion to compel citing Applicant's refusal to respond to properly served discovery requests based on Applicant's argument that Opposers had failed to act in a reciprocal manner. The Board resolved both motions by ordering the parties to respond to outstanding discovery requests within thirty days of its April 30, 2005 Order. Opposers complied, serving discovery responses and documents on May 28, 2005. Supplemental discovery responses have followed.

In the same Order, the Board granted Opposers' request for a protective order regarding Applicant's repeated requests for third-party litigation documents ruling that Opposers do not have to produce copies of the requested documents, but need only identify relevant litigation.

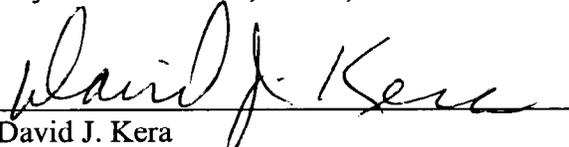
Applicant's vague reference to "dozens" of "extension requests, prior motion to compel and other disputes attributed solely to Opposers' actions" does not assist Opposers or the Board. If Applicant has specific grievances about Opposers' actions or failure to act in accordance with the Trademark Rules of Practice or the Board's Orders in this matter, the proper recourse is through a specifically drawn motion directed to the Board, not through a vaguely worded and wholly unsupported Motion to Dismiss Opposition. The Trademark Rules of Practice provide that an entry of judgment may be an appropriate sanction only where a party fails to comply with an order of the Board. Trademark Rule 2.120(g); *see e.g. MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477, 1478 (TTAB 2000)(repeated failure to comply with Board orders and unpersuasive reasons for delay resulted in entry of judgment).

Accordingly, Opposers request that Applicant's Motion to Dismiss Opposition be denied.

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

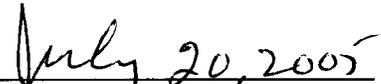
Alexandria, Virginia 22314

(703) 413-3000

Fax: (703) 413-2220

Attorneys for Opposers

Date:

  
DJK/ASC/ojb {I:\ATTY\DJ\K213-238096US-RES.DOC}

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSERS' RESPONSE TO MOTION TO DISMISS OPPOSITION** was served on counsel for Applicant, this 20<sup>th</sup> day of July, 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

  
\_\_\_\_\_

# **EXHIBIT A**

February 24, 2005

VIA FACSIMILE

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



ATTORNEYS AT LAW

DAVID J. KERA  
(703) 412-8456  
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 refer to the Order of March 11, 2005 from the Trademark Trial and Appeal Board.

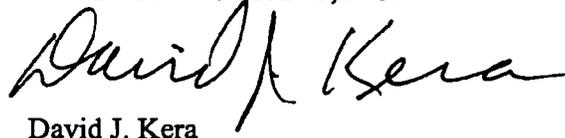
In view of the Board's Order, I request that you agree to the entry of a protective order without the inclusion of the language:

"material in evidence in this proceeding only upon consent of the other party or party not creating said dilutions."

Since the deadline for agreeing on a protective order is March 31, 2005, when I shall be out of the country, I request that you correspond on this point prior to March 31 with our associate, Ms. Amy Cahill.

Sincerely yours,

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



David J. Kera

DJK/ojb {I:\atty\DJK\213-238096US-It3.doc}

\* \* \* COMMUNICATION RESULT REPORT ( MAR. 22. 2005 7:38PM ) \* \* \*

FAX HEADER: OBLON SPIVAK

TRANSMITTED/STORED : FILE MODE	MAR. 22. 2005 7:37PM OPTION	ADDRESS	RESULT	PAGE
184 MEMORY TX		913366322012	OK	2/2

REASON FOR ERROR  
E-1) HANG UP OR LINE FAIL  
E-3) NO ANSWER

E-2) BUSY  
E-4) NO FACSIMILE CONNECTION

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

1940 Duke Street  
Alexandria, Virginia 22314

Telephone: (703) 413-3000  
Facsimile: (703) 413-2220

**FACSIMILE TRANSMISSION****PLEASE DELIVER TO:**

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

**FACSIMILE NO.:** 336-632-2012  
**FROM:** David J. Kera  
**DATE:** March 22, 2005  
**OUR REF.:** 238096US-213-21

**NUMBER OF PAGES INCLUDING COVER LETTER: 2**

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