

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

157204  
Opposition

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. )



11-23-2005

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #01

**APPLICANT'S REPLY IN CONJUNCTION WITH ITS MOTION TO COMPEL**

Applicant, Syngenta Participations AG, submits this brief reply to address the inaccuracies in Opposers' response to Applicant's Motion To Compel.

**I. Applicant's Counsel Is Not 'In-House' Counsel**

Opposers have submitted a great deal of materials that are neither credible nor relevant and would not be admissible in any court proceeding. Opposers make reference to Applicant's counsel's attendance at INTA conferences as evidence that he is in-house counsel for Applicant. As stated in the attached Exhibits (Ex. 1-3) and the application for the mark filed herein, Applicant is a Swiss corporation.

Applicant's counsel is a domestic representative of Applicant but not its employee and functions as 'outside' counsel for Applicant. As submitted under oath in Ex 1- 3:

1. Applicant's counsel is not an employee of Applicant, nor Applicant's parent Syngenta A.G., which are both foreign companies of Switzerland.
2. Furthermore, Applicant's counsel is not an employee of Syngenta Crop Protection, Inc.(SCPI) which is a U.S. corporation and the intended licensee and planned user of the mark at issue in this matter.
3. Applicant has no corporate presence in the U.S.
4. Applicant's counsel has a mailing address at SCPI in Greensboro, NC. but is not an employee thereof.
5. Applicant's counsel has no stake or financial affiliation with Applicant and is not an officer thereof. Applicant's counsel is not 'in-house' counsel for Applicant, SCPI, or its parent.

The vague speculation by Opposers' counsel regarding Applicant's counsel's employment is weighed against the sworn statements of three (3) experienced attorneys. The INTA document (Ex. 4 of their response) submitted by Opposers reflects the attendance by two (2) Swiss attorneys and their Swiss address which is the same as Applicant's address. These 2 Swiss attorneys are not listed as counsel herein. A search of PTO and TTAB records (some of which are attached to Opposers' response reflect the representation of many other corporations than Applicant or a "Syngenta" company which clearly demonstrates Applicant's counsel's representation of many different corporations; see Ex.2).

Most importantly, the burden to prove a 'negative' condition is upon Opposers. They have failed to produce any reliable evidence and cannot since their allegations are false. Opposer improperly attacks Applicant claiming it has asserted 'bald' allegations concerning the role of its attorney but it is Opposers' duty to overcome this late and altered position (see Ex. 4) now claimed by Opposers.

Notwithstanding that Opposers have failed in their burden, representatives from Applicant and its U.S affiliate have stated that Applicant's current counsel is not an employee and is not 'in-house'(Ex.1-3). Opposer should have submitted evidence from state bars to have any merit in supporting their position. However, attached are state bar registration forms ( from Ga.; N.Y.; La.; & N.C.) and receipts showing the business and, separately, home address of Applicant's counsel (Ex. 5-8). These address are different than those supplied by Opposers to argue the location or employment of Applicant's Counsel.

Furthermore, Exhibit 10 Of Opposers' response demonstrates the representation of numerous unrelated companies by Applicant's counsel, in fact at least one currently before the Board and thus the complete inapplicability of labeling Applicant's counsel as 'in-house'. Exhibits 8 & 9 of Opposers' response also support Applicant's position demonstrating that Applicant's counsel is not 'in-house' as he is not identified as an employee or 'in-house' counsel of Applicant.

## II. Opposers' Prior Acceptance / Reliance

This 'new' issue of Applicant's counsel's status is one that Opposers were on notice and had previously accepted (See Exhibit 4; letter from Opposers' counsel, Kera, dated August 24, 2004). Said letter (Ex.4) granted confidential access to other attorneys including one, Brian Reeve, an attorney for Syngenta Crop Protection, Inc. (SCPI). The issue to which Opposers' now object was the subject of a consent by them well over a year ago.

This letter (Ex. 4) addressed the issue of the release of all levels of confidential information (which was defined in the negotiated draft protective order and would cover the materials now sought) permitting others than Applicant's lead counsel to view said materials,

More importantly, as a result of Opposers' long held consent, Applicant has justifiably relied on this position in its long preparation of its defense. Reversal of that position would prejudice Applicant, further disrupt these proceedings, and due to their conduct Opposers should be estopped from maneuvering away from their earlier position. It is a position long held and relied upon by Applicant.

Opposers' complaint is also irrelevant. As stated in Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.(Opposition No. 91116355 to application Serial No. 75455343) 2005 TTAB LEXIS 406:

"Although we share applicant's concern that the "confidential" designation makes it "unduly cumbersome" in referring to this evidence, applicant's objections are untimely. A protective order (the Board's Standardized Protective Agreement) has been in place since March 2001, and the brand studies were marked "confidential" pursuant to the agreement, yet applicant did not raise any issue with respect thereto until the briefing stage. We view applicant's delay as a waiver as to the "confidential" designation of this evidence". [\*5]

Certainly, Opposers have delayed in raising this issue.

## III. More Dilatory Conduct By Opposers

There can be no question that this refusal to provide discovery information is another attempt to delay and disrupt these proceedings for which Applicant has repeatedly requested that the Board take action to terminate this dilatory conduct. Besides the fact that Opposers have already consented to recognizing Applicant's counsel as eligible to view confidential materials with the prior knowledge of the factors listed by them as grounds to now object, those grounds are irrelevant.

One irrelevant point raised by Opposers was a quote from a report (not a judicial decision) of a

non-judicial and biased administrator occurring in a bitter and violent labor dispute in which Applicant's counsel was criminally victimized by union representatives whose criminal acts were adjudicated by an actual court (and not administrative officer; See Ex. 2). Nothing in the NLRB order indicated any improper or sanctionable conduct but rather recognized a clash between the attorneys appearing in that labor dispute (Ex.2). This inaccurate information is irrelevant to the issue whether Applicant's counsel is in-house and should not be considered.

Furthermore, Applicant's counsel has been admitted to six (6) separate state bars, admitted to numerous federal bars, remains in good standing with said bars, has represented many Fortune 500 hundred corporations, and has been a practicing attorney for over 28 years for many Fortune 500 hundred corporations without any questioning of his integrity (Ex.2; 5-8). He has been entrusted with far more competitively sensitive information from other parties (see Ex. 1, ¶ 4) without any concern.

While it is clear that Applicant is not 'in-house' and Applicant's motion to compel should be granted, the Board should note this continued dilatory tactic and impose appropriate sanctions.

#### IV. The Board's Standard Order

Much has been misinterpreted by both the Board and the Opposers regarding the revisions to the Board's Standard Order. Applicant regrets the Board's interpretation as said revisions were made in the context of extensive negotiations between the parties and this issue regarding counsel other than Applicant's current lead counsel (See Ex. 5). There was never any intent to deceive by Applicant and merely an attempt to restore language that had already been approved by the parties' attorneys and insure the one 'in-house counsel' (Reeve) would be included in the protective order as previously agreed to by Opposers' counsel (Ex. 5).

The misinterpretation of this revision is unfortunate and regretted but again is an issue not raised by Opposers at the time or in any responsive brief until now.

#### V. Materials Should be provided to Applicant's Counsel

Regardless of Applicant's Counsel's status, which clearly is not as in-house counsel, these materials consisting of allegedly sensitive materials should not be withheld on the basis of the status of Applicant's Counsel. In Warner-Lambert Company v. The Gillette Company, Opposition No. 113,473, Trademark Trial and Appeal Board, 2001 TTAB LEXIS 33, (January 11, 2001), the court stated;

"citing U.S. Steel Corp. v. United States, 730 F.2d 1465, 1469 (Fed. Cir. 1984) [\*3] our

reviewing court held "that status as in-house counsel cannot alone create that probability of serious risk to confidentiality and cannot therefore serve as the sole basis for denial of access." The court provided further guidance stating that "access should be denied or granted on the basis of each individual counsel's actual activity and relationship with the party represented, without regard to whether a particular counsel is in-house or retained." n1 In Matsushita Elect. Industrial Co., Ltd. v. United States, 929 F.2d 1577, 1580 (Fed. Cir. 1991), the court went further to state "that a denial of access sought by in-house counsel on the sole ground of status as a corporate officer is error." [at 1469].

In this precedent one of the parties argued that the other seeking production of "highly confidential marketing information" and that providing access of this information to applicant's in-house counsel could result in "inadvertent or subliminal use by him which would cause "incalculably harm"

However, in this matter there cannot be any 'subliminal use' or inadvertent release by Applicant's counsel as the parties are involved in drastically different businesses without any overlap whatsoever (Automobiles and seeds).

Finally, in Helene Curtis, Inc. v. Derma-Cure, Inc., (Cancellation No. 23,306)

TTAB LEXIS 457 (July 9, 1996), the Board held:

"Regarding the question of access of in-house counsel to confidential information, our appellate-level reviewing court (the Court of Appeals for the Federal Circuit) held in a case involving the Court of International Trade that access to confidential information cannot be denied to in-house counsel solely because of their "general position". See U.S. Steel Corp. v. U.S., 730 F.2d 1465 (Fed. Cir. 1984). The Court explained that the factual circumstances as to each individual [\*5] attorney's activities must govern any concern for inadvertent or accidental disclosure; that in-house counsel are members of the bar, and officers of the court, and are bound by the same code of Professional Responsibility, and are subject to the same sanctions as retained counsel, and that each case depends on the individual counsel's actual activities"[at 6].

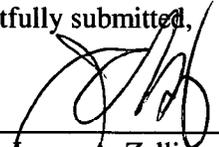
Opposers' alleged concerns are completely misplaced in this dispute between parties in vastly different businesses. Zellinger has been entrusted with far more competitively sensitive information from other parties (see Ex. 1, ¶ 4) without any concern or complaints arising therefrom.

## VII. Conclusion

Wherefore, Opposer's failure to respond constitutes sufficient grounds for this Board to issue an order compelling Opposer to fully and completely respond to Applicant's discovery requests. (Exhibits 1 and 2).

Respectfully submitted,

By: \_\_\_\_\_

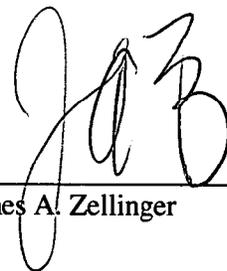
  
James A. Zellinger  
410 Swing Road  
Greensboro, North Carolina 27409  
(336) 632-7835  
fax (336) 632-2012  
ATTORNEY FOR APPLICANT

Date: Nov.21, 2005

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S REPLY MOTION TO COMPEL was served on counsel for Opposer this the 21 day of Nov. 2005, via first class mail, postage prepaid to:

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

A handwritten signature in black ink, appearing to read 'JAZ', is written over a horizontal line.

James A. Zellinger

EXHIBIT 1

**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**

Vincent Alventosa, being duly sworn, deposes and states as follows:

1. I am Vice President and General Counsel for Syngenta Crop Protection, Inc. ("SCPI"), a U.S. corporation, incorporated under the laws of the State of Delaware.
2. James A. Zellinger is not an employee nor officer of SCPI which is a U.S. corporation and the intended licensee and planned user of the trademarks at issue in this matter.
3. Zellinger has a mailing address at SCPI in Greensboro, NC.
4. Zellinger has represented SCPI in matters involving SCPI's major competitors such

as Monsanto Technology, Inc. in Cancellation # 92043653 and BASF Corporation in Opposition # 91166033 before this Board in which he acted as sole counsel and was provided confidential information by the opposing parties. These other parties are major rivals and direct competitors who provided confidential industry materials to Zellinger that were held in confidence pursuant to the protective orders and/or confidentiality agreements entered into in those proceedings. The release of these materials to SCPI might well have been very beneficial to SCPI. However, all materials were kept in the strictest confidence by Zellinger.

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



Vincent Alventosa  
Vice President & General Counsel  
SCPI  
410 Swing Rd.  
Greensboro, N.C. 27410

SWORN to before me this 21<sup>st</sup> day of Nov., 2005

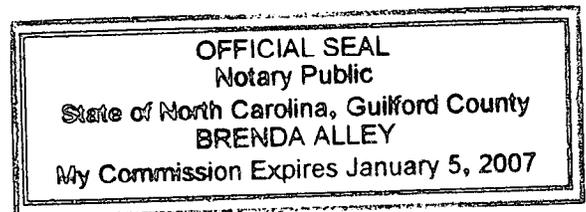
  
Notary

EXHIBIT 2

**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.                       | ) |                        |

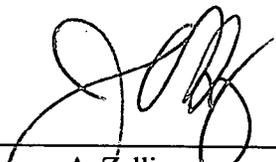
**AFFIDAVIT**

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

1. I am counsel for Applicant and represent Applicant in the above captioned matter.
2. I am not an employee of Applicant, nor Applicant's parent Syngenta AG, which are both foreign companies incorporated under the laws of Switzerland.
3. Furthermore, I am not an employee of Syngenta Crop Protection, Inc.(SCPI) which is a U.S. corporation and the intended licensee and planned user of the mark at issue in this matter.
4. I maintain has a mailing address at SCPI in Greensboro, NC. and receive mail and information for numerous matters involving my clients other than Applicant.

5. I am not an officer of Applicant. I am not 'in-house' counsel for Applicant or its parent.
6. I maintain my primary legal office as indicated in state bar records at 3704 Moss Creek Dr., Greensboro, N.C.(Ex. 5-8).
7. I have been admitted to six (6) different state bars, over 14 federal jurisdictions, and have never had a grievance or complaint made against me or my credibility questioned.
8. Opposers make reference to a report issued by a biased NLRB investigator concerned a violent and heated union organizing campaign where I, along with other management employees, was the victim of criminal activity directed against us. The matter does not have any relevance to this matter and, most informatively, had no bearing upon the issue of my admission to the state bar shortly thereafter this alleged incident occurred, although the issue was well known to the bar (Ex.8).

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

  
James A. Zellinger  
410 Swing Rd.  
Greensboro, N.C. 27410

SWORN to before me this 21<sup>st</sup> day of Nov., 2005

Brenda Alley  
Notary

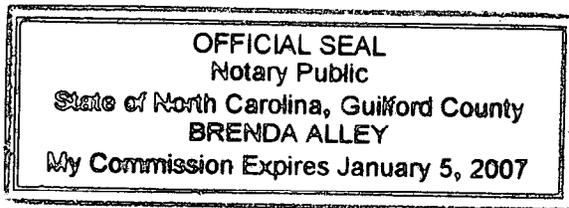


EXHIBIT 3

**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 )

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. )

Serial No.: 78/185,538

Filed: Nov. 15, 2002

Mark: LEXXUS

**AFFIDAVIT**

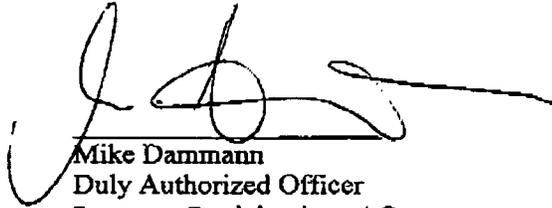
Mike Dammann, being duly sworn, deposes and states as follows:

1. I am a duly authorized officer for Applicant and my business office is in Basel, Switzerland. I am trademark counsel for Applicant.
2. I am fully aware of the employment of Applicant's lead counsel, James A. Zellinger, who is currently representing Applicant in the above captioned matter.
3. Zellinger is not an employee of Applicant, nor Applicant's parent Syngenta AG, which are both foreign companies of Switzerland.
4. Furthermore, Zellinger is not an employee of Syngenta Crop Protection, Inc. (SCPI) which is

a U.S. corporation and the intended licensee and planned user of the mark at issue in this matter. Applicant has no corporate presence in the U.S. Zellinger has a mailing address at SCPI in Greensboro, NC. but is not an employee thereof.

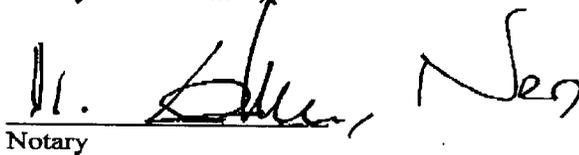
- 5. Zellinger has no stake or financial affiliation with Applicant and is not an officer thereof. Zellinger is not 'in-house' counsel for Applicant or its parent.

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



Mike Dammann  
 Duly Authorized Officer  
 Syngenta Participations AG  
 Basel, Switzerland

SWORN to before me this 18<sup>th</sup> day of November, 2005

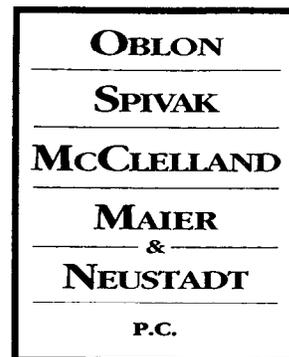


Notary

Not Prot. Nr. 423/2005

1 Fr.  
**Dr. Conrad Haab**

EXHIBIT 4



August 24, 2004

ATTORNEYS AT LAW

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

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

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  
Our Ref: 238096US-213-21

Dear Mr. Zellinger:

I refer to your letter of July 30, 2004.

Although I believe it unnecessary, I have no objection to altering the language of Page 2, Line 4 of the Stipulated Protective Order. I agree to the following amendment:

Any copies of such Material, abstracts, summaries, or information derived therefrom, and any notes or other records **recording, summarizing, or referring to confidential information**, shall also be deemed Confidential . . .”

If Thomas Hamilton is an attorney who will be working in his capacity as counsel to Syngenta in this matter, I have no objection to including him as a person with access to confidential materials (Page 2, Par. 3(a)(ii)).

Please advise me of Brian Reeve's title and role in the case. If he is also an attorney, I do not object to his inclusion.

I do not understand your explanation of the proposed change to paragraph 8. The deletion of confidential information from documents, and the documents' admissibility, are separate questions. This is the intent of paragraph 8, as originally drafted. Your letter of June 28, 2004 did not clarify your comment. Therefore, I do not agree with the proposed change in paragraph 8 unless you can explain its intent in an understandable way. Is there a case or treatise you can cite?

James A. Zellinger, Esquire  
238096US-213-21  
Page 2



I agree that entry of the Stipulated Protective Order is long overdue in this matter. Please indicate whether you and your client will consent to the Stipulated Protective Order with the changes described herein. If not, I believe we will have to ask the Board for an appropriate Order.

With best wishes,

Sincerely yours,

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

A handwritten signature in cursive script that reads "David J. Kera".

David J. Kera

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

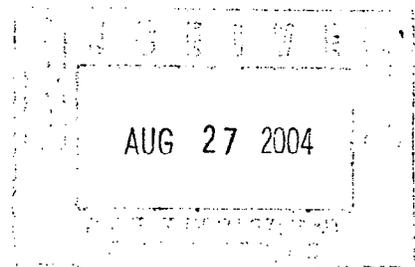


EXHIBIT 5



STATE OF NEW YORK  
 OFFICE OF COURT ADMINISTRATION  
 P.O. BOX 2806 CHURCH STREET STATION  
 NEW YORK, NY 10008  
 Email: attyreg@courts.state.ny.us  
 (212) 428-2800

March 22, 2004

Attorney Registration #: 1027176  
 Transaction #: 815283953  
 Transaction Date: 02/18/2004  
 Batch #: N270  
 Correspondence #: 820227227  
 Address Type: Home

JAMES ANDREW ZELLINGER  
 23 BROOKGLEN LANE  
 GREENSBORO, NC 27410

**RECEIPT**

This will acknowledge receipt of your 2004-2005 registration as an attorney and receipt of the \$350.00 fee.

OUR RECORDS CONTAIN THE FOLLOWING INFORMATION:

CURRENT NAME:

JAMES ANDREW ZELLINGER

NAME WHEN ADMITTED TO NYS BAR (IF DIFFERENT):

BUSINESS ADDRESS:

JAMES A ZELLINGER  
 3704 MOSS CREEK DR.  
 GREENSBORO, NC 27410

HOME ADDRESS:

23 BROOKGLEN LANE  
 GREENSBORO, NC 27410

BUSINESS COUNTY:

Out of State

HOME COUNTY:

Out of State

BUSINESS PHONE:

(336) 664-0600

SOCIAL SECURITY NUMBER:

089-44-9323

DATE OF BIRTH: 03/04/1952

LAW SCHOOL:

FORDHAM

YEAR ADMITTED TO NYS BAR: 1977

NYS JUDICIAL DEPT OF ADMISSION: 2

Please review the information on this receipt for accuracy. Return only if any changes are required and retain a copy for your records. The Rules of the Chief Administrator require that this office be notified of any changes in the above information within 30 days of any such change. To correct any information, 1) Circle the item, 2) Enter the correct information directly on the form, 3) Sign and date the form, and 4) Return to the address at the top of the receipt. A corrected receipt will be mailed to acknowledge that the changes have been made.

Signature \_\_\_\_\_ Date \_\_\_\_\_

This office will send a notice concerning future biennial registrations at the appropriate time to each attorney.

EXHIBIT 6



EXHIBIT 7