

# TTAB

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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-	)	Opposition No.: 157,206
	)	U.S. Appln. Serial No.: 78/145,546
	)	Mark: v. LEXUS
Toyota Motor Sales, U.S.A., Inc.,	)	
	)	
Opposers	)	
	)	
v.	)	Opposition No. 159,578
	)	U.S. Appln. Serial No.: 78/185,538
Syngenta Participations AG,	)	Mark: v. LEXXUS
	)	
Applicant	)	

**OPPOSERS' REPLY BRIEF IN SUPPORT OF THEIR MOTION TO SUSPEND PROCEEDINGS**

Opposers hereby reply to "Applicant's Objection To Opposers' Request To Suspend Proceedings" pursuant to Trademark Rule 2.127(a)<sup>1</sup>. Opposers request that the Trademark Trial and Appeal Board ("Board") grant Opposers' motion to suspend this consolidated opposition proceeding pending the Board's decision on Applicant's combined "Motion To Reopen Discovery And To Compel" and to reset trial dates, with Opposers' testimony period to commence sixty days after the final determination by the Board of Applicant's combined motion.

<sup>1</sup> Applicant's Exhibit 1 to its Objection is a self-serving affidavit by its attorney devoid of any supporting exhibit. Applicant's Exhibit 2 does not say what Paragraph 5 states it said; Applicant attached the wrong exhibit.

08-25-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

Applicant's argument (Applicant's Responsive Brief, p. 1) that it "has relied on the Boards' [sic] Order of June 27, 2006 in preparation of the Testimony periods and availability of its sole counsel" is preposterous. Applicant gives no details of any preparations or plans made or any other action taken by Applicant's attorney in reliance on the June 27, 2006 Board order. In any event, Applicant's attorney plans to attend Opposers' testimony depositions by telephone and is awaiting the date and time (Exhibit 1). The lack of specifics in Applicant's brief and the letter (Ex. 1) to Opposers' attorney belie Applicant's attorney's statement that he has made preparations relying on the latest testimony schedule from the Board.

Applicant's attorney should be well versed regarding the rules governing practice before the Board, and therefore he knew or should have known that by filing Applicant's combined motion to reopen discovery and to compel, the testimony periods would, of necessity, be delayed until a decision was rendered by the Board on Applicant's combined motion and that trial dates would be reset by the Board at the appropriate time.

Applicant's argument that Opposers' counsel failed to comply with Trademark Rule 2.120(e) by failing to contact Applicant's attorney before filing Opposers' Motion to Suspend is uninformed and irrelevant. The rule Applicant cites does not relate to motions to suspend.

Applicant complains that it only recently received supplemental discovery materials relating to a case in U.S. District Court for the Southern District of New York. The "Final Judgment" in that case was not entered until June 2006; and once entered, all properly requested materials (other than those highly confidential), including the Final Judgment, were provided to Applicant. These materials were not provided in response to

Applicant's motion to reopen and compel, as asserted by Applicant, particularly as Applicant's motion to compel was filed after the opening of Opposers' testimony period as set by the Order of June 27, 2006 and was untimely under Trademark Rule 2.120(e)(1).

Applicant's argument that Opposers' Motion to Suspend is a "delaying tactic" is baseless . It is Applicant's filing of a combined motion to reopen discovery and to compel which caused the current delay in this consolidated case. See footnote 2 in the Board's September 20, 2005 order regarding previous delays in this case (Exhibit 2).

Applicant's argument that Opposers' request for suspension of testimony periods is irrelevant to Opposers' testimony periods does not deserve comment.

Because Applicant filed a motion relating to reopening discovery, Opposers request that their Motion to Suspend be granted; that the consolidated proceeding be suspended until a final decision by the Board on all pending motions herein; and that trial periods be reset with Opposers' testimony period to commence sixty days after the final

determination by the Board of Applicant's combined motion.

Respectfully submitted,

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

By:



David J. Kera  
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Maier, & Neustadt, P.C.  
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Date:



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# **EXHIBIT 1**

**syngenta**

Syngenta Crop Protection, Inc. <sup>Kera</sup> Tel 336 632 6000  
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Trademarks Counsel  
www.syngenta.com  
Syngenta Crop Protection, Inc.  
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Greensboro, NC 27409

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August 7, 2006

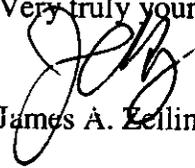
David J. Kera  
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, VA 22314

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

Dear Mr. Kera:

Please note that I will be attending the testimony of any of Opposer's witnesses by telephone. Please supply me with location, date, time and telephone information.

Very truly yours,

  
James A. Zellinger

JAZ/sk

**RECEIVED**

AUG 09 2006

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

# **EXHIBIT 2**

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

Mailed: September 20, 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 AG

**Linda Skoro, Interlocutory Attorney**

This case comes up on an amazing number of motions all centered on the Board's March 11, 2005 order allowing the parties twenty days to enter into a protective agreement to enable the disclosure of confidential information in discovery.

The March 11, 2005 order dealt primarily with a sentence that applicant insisted upon and opposer objected to, with applicant being concerned that without the sentence the admissibility of confidential material would be affected. The Board found the language unnecessary because the Federal Rules of Civil Procedure would govern applicant's concerns, and the parties were allowed twenty days, or until March 31, 2005, to put in place a protective

agreement or the Board would impose its own standardized agreement. On March 31, 2005 opposer informed the Board that it had contacted applicant's counsel inquiring as to whether counsel would agree to entry of its proposed protective order without the unnecessary language. Applicant's counsel indicated that would not agree, forcing opposer to file its request for entry of its protective order.<sup>1</sup> This then resulted in applicant filing three separate motions: (1) its own motion for a protective order, filed April 4, 2005; (2) applicant's objection<sup>2</sup> to opposer's March 31, 2005 filing, filed April 7, 2005; and (3) applicant's motion for reconsideration of the Board's March 11, 2005 order.<sup>3</sup> Both parties filed responses and replies.

The next filing occurred on June 9, 2005, when opposer requested a thirty day extension to serve discovery responses, to which applicant objected, once again forcing opposer to renew its request for entry of a protective

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<sup>1</sup> It is not clear to the Board the nature of applicant's refusal, in that it appeared that the parties had reached agreement on all terms of the protective agreement, other than the language that was before the Board and discussed in the March 11, 2005 order. To now raise new issues does not appear to be in the nature of cooperation.

<sup>2</sup> It is noted that applicant accuses opposer of failing to provide good faith efforts to negotiate to work out the parties' differences as well as dilatory tactics, however, it appears to the Board that it is applicant who delays proceedings through the very same devices, as illustrated by applicant's filing of numerous motions.

<sup>3</sup> Applicant's request for reconsideration actually appears to be a motion to compel opposer to provide "settlement agreements, expert and survey reports, and court decisions relating to... third-party litigation..." as well as "materials list but not available on the [electronic] court litigation system." In that these matters are not properly before the Board as a motion to compel, they will not be considered.

order and to reschedule the testimony periods. Applicant once again objected and stated that it had signed the Board's standard protective agreement and opposer has refused to. Opposer's reply, filed July 25, 2005, states that applicant executed an edited version<sup>4</sup> of the Board's agreement that substantially changed the order<sup>5</sup>, yet "in the interest of moving these proceedings forward, counsel for opposers has signed and dated the applicant's altered order..."

Then on July 13, 2005, applicant files a motion to dismiss the opposition as a sanction for opposer's unwillingness to sign the applicant's version of the Board's standard protective agreement. Opposer has objected and applicant has replied.

In that it appears that the parties are finally where they should have been on March 31, 2005, the Board hereby orders the following: Opposer's motion to enter its protective order is hereby DENIED; applicant's motion to enter its protective order is hereby DENIED; applicant's motion for reconsideration is hereby DENIED; opposer's

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<sup>4</sup> Applicant changed the language in paragraph number 3, eighth provision, from "outside counsel, but not in-house counsel" to "counsel" which clearly affects the disclosure of trade secret/commercially sensitive materials.

<sup>5</sup> The Board is dismayed that applicant would change the terms of the Board's standard agreement, without consulting opposer's counsel and then state that it had executed the Board's agreement. This duplicity is not looked upon favorably.

request for an extension of time to serve discovery responses is hereby GRANTED; opposer's request to reschedule testimony periods is hereby GRANTED; applicant's motion to dismiss is hereby DENIED, having failed to set forth grounds upon which to base a dismissal.<sup>6</sup>

Further, it is adjudged appropriate for the standard Board protective order to be imposed herein, and accordingly, an executed order is attached. Trial dates are hereby reset as indicated below:

Discovery period to close:	<b>CLOSED</b>
30-day testimony period for party in position of plaintiff to close:	<b>3/10/2006</b>
30-day testimony period for party in position of defendant to close:	<b>5/9/2006</b>
15-day rebuttal testimony period to close:	<b>6/23/2006</b>

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.

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<sup>6</sup> There is no evidence that opposer failed to obey any Board order.

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSERS' REPLY BRIEF**  
**IN SUPPORT OF THEIR MOTION TO SUSPEND PROCEEDINGS**  
was served on counsel for Applicant, this 25<sup>th</sup> day of August, 2006, by sending  
same via U. S. mail and postage prepaid, to:

James A. Zellinger, Esquire  
Trademark Counsel  
Syngenta Crop Protection Inc.  
410 Swing Road  
Greensboro, North Carolina 27409

D. Jean Barrett