



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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

TTAB

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**

COMES NOW the Opposer, Big O Tires, Inc., through its undersigned counsel, and hereby moves for an Order from the Trademark Trial and Appeal Board (the "Board") compelling Applicant to serve amended and/or supplemental responses to Opposer's interrogatories, document requests, and requests for admissions. Additionally, Opposer asks that the Board suspend these proceedings and reset the discovery and trial dates upon lifting the suspension. In further support of this Motion, Opposer states as follows:

**I. Introduction and Background**

On April 19, 2005, Opposer served Opposer's written discovery, namely, interrogatories, document requests and request for admissions. *See* Opposer's First Set of Interrogatories, Opposer's First Request for Production of Documents, and Opposer's First Set of Request for Admissions, attached hereto as Exhibit A.

Applicant served its discovery responses on May 24, 2005. *See* Applicant's Responses to First Set of Interrogatories, Applicant's Responses to Request for Production of Documents, and Applicant's Responses to Request for Admissions, attached hereto as Exhibit B. However,



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Applicant did not produce any documents, although a number of interrogatory responses relied on such (withheld) documents, in lieu of an answer, pursuant to Rule 33 of the Federal Rules of Civil Procedure.

Accordingly, prior to the close of discovery, Opposer filed a motion to extend the discovery period for Opposer alone on the basis that Applicant had not produced documents, even after relying on Rule 33(d) of the Federal Rules of Civil Procedure, and that the discovery responses were deficient. On August 24, 2005, the Board (after holding a hearing) granted the Motion by extending the discovery deadline by sixty (60) days for both parties.

Meanwhile, on August 2, 2005, the day after the close of the discovery period, Opposer finally received Applicant's document production. The production, however, was quite limited and basically included: a third party catalog, a single advertisement, excerpts from Applicant's website(s), a couple of invoices, the prosecution history of the opposed application, and, ostensibly, some Internet printouts of third party references.

On September 26, 2005, counsel for Opposer sent a letter to Applicant's counsel, by mail and facsimile, setting forth Opposer's concerns with Applicant's discovery responses. *See* Opposer's counsel's September 26, 2005 letter attached hereto as Exhibit C. Additionally, the letter suggested that the Board's standard protective order be adopted by the parties. Finally, Opposer suggested an extension of time to allow the parties time to resolve the outstanding issues.

On September 28, 2005, Opposer's counsel called Applicant's counsel regarding the discovery issues; but Applicant's counsel was unavailable. Accordingly, Opposer's counsel sent an email message following up on the earlier letter. *See* Opposer's counsel's September 28, 2005 email, attached hereto as Exhibit D.

On September 29, 2005, counsel spoke but Applicant's counsel was not prepared to discuss the issues raised in Opposer's letter. However, Applicant's counsel consented to an extension to allow the parties time to address the issues. Accordingly, Opposer filed a sixty (60) day extension on September 30, 2005 since the parties were "currently engaged in discussions directed to the resolution of certain discovery disputes."

No response to the issues raised was provided by Applicant's counsel, however. Therefore, on November 29, 2005, Opposer's counsel filed another extension request on the same basis.

Once again, Opposer's counsel sent a letter on December 5, 2005 seeking Applicant's supplemental responses and/or a substantive reply to Opposer's September 26, 2005 letter. *See* Exhibit E. The letter also attached the Board's standard protective order. *Id.*

Approximately another month went by and Opposer's counsel still had not received Applicant's amended/supplemented discovery responses, a draft Protective Order, or any substantive response to the discovery letter. Accordingly, on January 3, 2006, Opposer's counsel sent a "reminder" letter, by facsimile and mail, to Applicant's counsel. *See* Opposer's counsel's January 3, 2006 letter attached hereto as Exhibit F. When Applicant did not respond; yet another "reminder" letter was sent on January 17, 2006. *See* Exhibit G.

Finally, on the next day, January 18, 2006, Opposer's counsel received a January 12, 2006 letter from Applicant's counsel enclosing an executed copy of the protective order.<sup>1</sup> Unfortunately, Applicant still did not supplement its discovery responses or substantively respond to the discovery

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<sup>1</sup> While Applicant has refused to answer numerous discovery requests on the ground that they call for confidential information, *see e.g.* Interrogatory Nos. 2(c), 2(d), 4(a), and document requests nos. 38-40, 70-87, Opposer anticipates that Applicant will supplement its responses upon entry of the Protective Order.

issues set forth in Opposer's September 26, 2005 letter. Rather, Applicant promised only to "get back to you shortly regarding the various discovery disputes that you raised with respect to applicant's discovery responses . . . ." Applicant did not set a time by which it would respond.<sup>2</sup>

The discovery period, as repeatedly extended, closes today.

Over the last five (5) months and several extension requests (filed to allow the parties time to address the discovery issues raised by Opposer), Applicant has failed to remedy its discovery defects or even substantively respond to Opposer's numerous efforts to resolve (or at least narrow) the defects. Despite Opposer's repeated and persistent attempts to engage Applicant regarding its discovery deficiencies, the parties are no closer than they were months ago, because Applicant will not engage in substantive discussions in this regard, nor give any commitment as to when he will do so. Accordingly, Opposer respectfully requests the Board to grant Opposer's Motion, as set forth more fully below.

A. Applicant's Answers to Opposer's Discovery Are Inadequate and Should Be Amended or Supplemented

**INTERROGATORIES**

No. 1: Interrogatory 1(a) (a description of the manner of use of Applicant's mark) is unanswered. Additionally, the "exemplary documents evidencing" use of Applicant's mark are not entirely legible. Applicant either should produce legible

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<sup>2</sup> Notably, although Applicant's counsel apparently was unable to "get back to Opposer" on the discovery issues raised four months previously, he was able to send a letter on January 19, 2006, raising, for the first time, alleged discovery deficiencies in Opposer's discovery responses. This letter did not substantively respond to the discovery deficiencies raised in Opposer's September 26, 2005 letter.

copies of the documents on which it seeks to rely under Rule 33, or simply answer the questions, which are responsive to Opposer's document requests.

No. 2(e): Applicant has not identified each state in which Applicant's products have been sold in connection with Applicant's mark.

No 3: This interrogatory sought an identification of surveys, searches or other investigations. However, Applicant has not responded as to "searches or other investigations" related to Applicant's mark or the term(s) BIGG/BIG.

No. 4(b): Opposer sought information concerning each medium employed by Applicant. The answer is insufficient, in light of Definition P of Opposer's interrogatories. See Exhibit A. (e.g., full identification of the automotive magazines, information concerning Applicant's catalog and the identification of persons knowledgeable about same). Additionally, Applicant should specify Applicant's customer's activities, to which it refers.

No. 8: Applicant has not "describe[d] in detail" the reasons for selecting Applicant's BIGG WHEELS mark.<sup>3</sup>

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<sup>3</sup> Additionally, the business address(es), occupation(s) and business position(s) held by Messrs. Lamb and Nicol also should be provided, pursuant to Definition H.

No. 10: Applicant should be required to provide more information concerning the claimed Big O–Custom Wheel transaction of August, 2002 (*e.g.*, brand of vehicle wheels, *etc.*), pursuant to Definition K. The single document Applicant produced does not suffice.

Additionally, Applicant has not responded as to the circumstances under which it first became aware of Opposer’s Mark, Opposer’s stores, the actual or possible use of Opposer’s Mark, and the goods and services bearing Opposer’s Mark. At a minimum, Applicant was aware of, and visited, Opposer’s stores before it selected Applicant’s mark. *See* response to admission request nos. 7-8.

No. 11: Applicant has not responded as to its consideration of Opposer. Applicant has admitted that it had actual knowledge of Opposer prior to Applicant’s selection of Applicant’s mark. *See* response to admission request no. 6.

No. 12: Use of the limiting phrase “at least” in describing the responsive registrations is unacceptable. Applicant should provide a complete identification of “each and every” such registration; or be prohibited from relying on any testimony or evidence which is based on information responsive to this interrogatory.

No. 15: In responding to this interrogatory, which sought an identification of certain third party marks, Applicant simply referred to documents to be produced. As discussed

during the oral hearing, this answer constitutes an improper use of Rule 33(d) of the Federal Rules of Civil Procedure. As an initial matter, the referenced documents are not Applicant's "business records." Moreover, the requested information is not found within the documents Applicant produced. Furthermore, the burden of deriving (some of) the requested information falls more heavily on Opposer. Thus, Applicant should provide a written response to the interrogatory where all of the requested information is provided for each responsive mark, or be prohibited from relying on any testimony or evidence which is based on information responsive to this interrogatory.

No. 22: This interrogatory sought an identification of each request for which Applicant a) has not produced or will not produce documents; and b) there are no responsive documents. Applicant merely referenced its responses to Opposer's document requests. However, this is not responsive. As an initial matter, Applicant's Objection No. 10 states that:

Applicant's statement that responsive documents will be produced or will be made available for inspection and copying is not and should not be taken as an affirmative indication that responsive documents exist. Rather, the statement only indicates that if discoverable responsive documents do exist, they will be made available.

Thus, this objection contradicts Applicant's apparent reliance on its responses to Opposer's document requests.

Moreover, use of the term “any” in many of Applicant’s document responses – “Applicant will produce any relevant non-privileged and/or non-confidential documents responsive to this request” – further demonstrates the need for a written response to the interrogatory.

#### Admissions<sup>4</sup>

Applicant denied several requests presumably because the term “Opposer’s Marks” was not defined. *See e.g.*, response nos. 51, 55, 56, 94, 100 - 107. However, this term was defined. *See* Exhibit A. (Definition D in Opposer’s First Set of Interrogatories, which was incorporated by reference into Opposer’s First Set of Requests for Admission). Accordingly, these responses should be deemed admitted.

Applicant admits that, prior to Applicant’s selection of Applicant’s mark, Applicant had actual knowledge of Opposer and Opposer’s stores; and had visited one or more of Opposer’s stores. *See* responses to nos. 6-8. Presumably then, Applicant also had actual knowledge of Opposer’s Mark, at least, “BIG O” and/or “BIG O TIRES” (no. 1) and use of the mark in connection with tires and automotive services (nos. 3-5, 12-14, and 21-23). Accordingly, these responses should be deemed admitted.

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<sup>4</sup> Applicant has mistyped the parenthetical of request no. 61 – it is not “(other than markets involved in this proceeding)” but rather “(other than marks involved in this proceeding).” To the extent this altered Applicant’s response, the response should be amended.

### Document Responses and Production

Many responses do not state whether responsive documents exist or will be produced. *See e.g.* response nos. 1-4, 14 - 28, 35 - 37, 45-46, 48, 52-54, and 60-61. This is improper. *See* TBMP §406.04(b); *see also, No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (a proper response requires stating as to each request either that there are responsive documents and they will be produced [or withheld on a claim of privilege] or stating party has no responsive documents). Accordingly, Applicant should be compelled to state as to each request whether it has responsive documents, whether it will produce them, and to then make the production.

Additionally, Applicant has failed to identify which documents are responsive to which document requests. The Trademark Rules require that a party producing documents by mail “organize and label them to correspond with the categories in the requests.” *See* TBMP § 406.04(b). However, Applicant did not produce its documents in this fashion, but should do so now.

Applicant admits that it possesses documents supporting Applicant’s affirmative defenses, namely, Applicant’s first, second, third, fourth, and sixth affirmative defenses (*see* response to admission request nos. 66, 69, 72, 75 and 81). Applicant intentionally has withheld such documents from production (*see* response to admission request nos. 68, 71, 74, 77, and 83). Similarly, Applicant admits that it possesses documents supporting various contentions made in papers filed with the Trademark Office (*see* response to admission request no. 84), but that such documents have not been produced (*see* response to admission request no. 86). All of these documents were requested, are responsive and should be produced.

Applicant has refused to produce documents in response to numerous requests on the basis that the requested documents are protected by an applicable privilege. However, Applicant has not

provided a privilege log or even general description which would enable Opposer to test the assertion of such privilege. Accordingly, Opposer requested that Applicant provide, for request nos. 3, 14, 17-28, 29-37, 45-47<sup>5</sup>, and 58 a sufficiently detailed privilege log to enable Opposer and/or the Board to determine whether such documents are being improperly withheld from production.

No. 6: Applicant promised to produce documents sufficient to show Applicant's BIGG WHEELS products and any materials that may be included with such products. The latter documents were not produced. Applicant should produce same. Additionally, the pictures are not legible enough to show "writings or marks thereon." Applicant should produce legible photographs.

No. 7: This request sought a sample of each of a number of different promotional items. In response, Applicant has only produced one magazine advertisement and one banner. This is insufficient; and Applicant should produce all of the requested documents.

No. 9: This request sought a sample of each advertisement and promotional material. In response, Applicant has only produced one magazine advertisement, Internet print outs for two websites and one banner. This is insufficient; and Applicant should produce all of the requested documents.

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<sup>5</sup> However, it is well established that search results are not privileged, but are discoverable. Applicant should produce any such documents without awaiting the Board's resolution of this Motion.

- No. 10: Despite Applicant's promise to produce exemplary documents responsive to this request, it appears that Applicant has not produced any such documents.<sup>6</sup>
- No. 14: Applicant's response is limited to Applicant's knowledge of "Opposer's Mark." However, the request seeks information related to Applicant's knowledge of "Opposer." Such a unilateral limitation of Opposer's discovery request by Applicant is inappropriate, and all responsive documents should be produced.
- Nos. 36/7: Applicant has produced one document responsive to this request – an August 2002 invoice. Applicant was asked to advise whether there are other documents responsive to this request and to produce them. Applicant should respond, and, provide all responsive documents.
- Nos. 45/46: These requests sought documents relevant to searches, *etc.*, for specific marks. Despite Applicant's promise to "produce any non-privileged documents responsive to" the requests, it appears that no documents have been produced. Since Applicant has not produced a privilege log, Opposer does not know if search reports were withheld; however it is clear that search reports are not privileged.

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<sup>6</sup> The response to Request No. 12 refers to Applicant's responses to Request Nos. 6-11. However, the response is insufficient for the same reasons.

No. 58: Applicant has refused to produce any documents in response to this request, which seeks documents that support Applicant's denials of Opposer's admission requests. It is not clear whether documents were withheld on the basis of a privilege or if Applicant found that the request is so "vague, ambiguous, over-broad and[/or] unduly burdensome" that no response may be made or document produced. Applicant was asked to explain this response, but has not done so. Similarly, Applicant has not explained why no response is made, or document produced, in response to Request No. 59.

No. 61. Applicant has not produced any certificates of registration for the marks identified in response to Interrogatory No. 12. Applicant should produce such documents, and it should be prohibited from relying on any testimony or evidence related to such documents which are not produced.

No. 62. It appears that Applicant has not produced documents showing the price of Applicant's goods. This is not confidential information and the documents should be produced.

No. 69. This request seeks documents which show each state in which Applicant's products have been sold under Applicant's mark. Applicant's answer that it *intends* to sell its products "throughout the United States" is not responsive, and should be amended and responsive documents produced.

### **III. Rule 2.120(e) Statement**

Pursuant to Rule 2.120(e) of the Trademark Rules of Practice, Opposer states that it has made good faith efforts by correspondence and by telephone to resolve with the other party or the attorney therefor the issues presented in the motion, and has been unable to reach agreement due to Applicant's persistent failure to respond to same.

Opposer has sought to avoid filing this discovery motion. Indeed, it agreed to (in fact, proposed) and filed several extensions of time to allow Applicant time to adequately respond to Opposer's discovery requests and negotiate and submit a Protective Order. Notwithstanding Opposer's several attempts to frame, discuss and achieve a resolution to the various discovery disputes presented in this Motion, Applicant has remained inert; promising action but providing none. While many of these discovery disputes should be susceptible to resolution by the parties, this requires Applicant's participation, which has been wholly lacking. That is, Rule 2.120(e) requires the good faith efforts of *both* parties.

### **IV. Request for Suspension**

Opposer understands that this proceeding will be suspended based on the filing of this discovery Motion, pursuant to Trademark Rule 2.120(e) (*When a party files a motion for an order to compel discovery, the case will be suspended by the Trademark Trial and Appeal Board . . . .*") (Emphasis supplied). Nevertheless, Opposer requests that the proceeding be suspended to allow the Board to consider the present Motion (and any responsive filings), and to issue an Order as requested herein. Opposer further requests that, following a ruling on this Motion, the discovery and trial dates

be reset with at least a sixty (60) day discovery period to follow any supplementation and/or amendment the Board may order.

**V. Conclusion**

For all the foregoing reasons, Opposer respectfully requests that the Board GRANT Opposer's Motion to Compel and Test Sufficiency; and issue an Order to: 1) compel Applicant to immediately serve amended and/or supplemental answers to Opposer's interrogatories, requests for admission and document requests (and to produce responsive documents by mail); 2) suspend these proceedings; and 3) reset the discovery and trial dates upon lifting the suspension.

Respectfully Submitted,

BIG O TIRES, INC.,

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

  
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Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
(202) 638-6666

Dated: January 30, 2006

**CERTIFICATE OF SERVICE**

I hereby certify that on this 30<sup>th</sup> day of January, 2006, a true copy of the foregoing Opposer's Motion to Compel was served by first-class mail, postage prepaid, upon counsel for Applicant:

Donald L. Otto, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

  
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# EXHIBIT A

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

BIG O TIRES, INC.,

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**OPPOSER'S REQUESTS FOR ADMISSION TO APPLICANT**

Opposer, through its counsel, hereby requests Applicant, within thirty (30) days after service of these requests, to make the following admissions, pursuant to Rule 36, Fed.R.Civ.P. and 37 C.F.R. § 2.120(h), and subject to all pertinent objections to admissibility which may be interposed at trial:

**INSTRUCTIONS**

A. The Instructions and Definitions set forth in Opposer's First Set of Interrogatories, served concurrently herewith, are incorporated herein by reference and made a part hereof, as if fully stated herein.

B. These Requests are continuing and to the extent that the answers may be enlarged, diminished or otherwise modified by information acquired by Applicant subsequent to the service of answers hereto, Applicant is requested promptly thereafter to serve supplemental answers reflecting such changes, where required by the Federal Rules of Civil Procedure.

C. In answering these Requests, Applicant is required to admit or deny each request based on information as is available to Applicant and its agents, including information in the possession of Applicant's attorneys, investigators and other representatives.

D. For each of these Requests to which Applicant responds by asserting that it lacks sufficient information and/or knowledge, state in detail the information required to answer said admission, and the steps taken by Applicant to investigate and/or obtain information in order to answer said admission request.

### REQUESTS

1. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s).

2. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's pleaded registrations.

3. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with tires.

4. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the goods listed in the pleaded registrations.

5. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the services listed in the pleaded registrations.

6. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of Opposer.

7. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's stores.

8. Prior to Applicant's selection of Applicant's Mark, Applicant visited one ore more of Opposer's stores.

9. Prior to Applicant's selection of Applicant's Mark, Applicant visited Opposer's website.

10. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s).

11. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's pleaded registrations.

12. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with tires.

13. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the goods listed in the pleaded registrations.

14. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the services listed in the pleaded registration.

15. Prior to the filing of the opposed application, Applicant had actual knowledge of Opposer.

16. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's stores.

17. Prior to the filing of the opposed application, Applicant visited one ore more of Opposer's stores.

18. Prior to the filing of the opposed application, Applicant visited Opposer's website.

19. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s).

20. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's pleaded registrations.

21. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with tires.

22. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the goods listed in the pleaded registrations.

23. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the services listed in the pleaded registrations.

24. Prior to using Applicant's Mark, Applicant had actual knowledge of Opposer.

25. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's stores.

26. Prior to using Applicant's Mark, Applicant visited one ore more of Opposer's stores.

27. Prior to using Applicant's Mark, Applicant visited Opposer's website.
28. Applicant's BIGG WHEELS products are sold by third parties.
29. Applicant's BIGG WHEELS products are sold on a website located at www.wheelworld662.com.
30. Applicant's BIGG WHEELS products are sold on a website located at www.wheelworld662.com, with Applicant's consent.
31. Applicant's BIGG WHEELS products have been sold on a website located at www.wheelworld662.com.
32. Applicant's BIGG WHEELS products have been sold on a website located at www.wheelworld662.com, with Applicant's consent.
33. Attached hereto as Exhibit A is a true and correct copy of a partial printout from the website located at www.wheelworld662.com, as of or about April 18, 2005 concerning the BIGG WHEELS products.
34. Applicant's BIGG WHEELS products are sold on a website located at www.rimfinancing.com.
35. Applicant's BIGG WHEELS products are sold on a website located at www.rimfinancing.com, with Applicant's consent.
36. Applicant's BIGG WHEELS products have been sold on a website located at www.rimfinancing.com.
37. Applicant's BIGG WHEELS products have been sold on a website located at www.rimfinancing.com, with Applicant's consent.

38. Attached hereto as Exhibit B is a true and correct copy of a partial printout from the website located at [www.rimfinancing.com](http://www.rimfinancing.com), as of or about April 18, 2005.

39. The website located at [www.rimfinancing.com](http://www.rimfinancing.com) sells wheels.

40. The website located at [www.rimfinancing.com](http://www.rimfinancing.com) lists "BIGG" as hyperlinked text.

41. By clicking on the hyper-linked text of "BIGG", a visitor is transferred to a website locate at <http://aaron-katzman.com/wheels-rims-tires/2004BIGG.htm>.

42. Attached hereto as Exhibit C is a true and correct copy of a partial printout from the website located at <http://aaron-katzman.com/wheels-rims-tires/2004BIGG.htm>, as of or about April 18, 2005.

43. Applicant's has promoted its wheels under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

44. Applicant promotes its wheels under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

45. Applicant's wheels have been promoted under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

46. Applicant's wheels are promoted under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

47. Applicant has sold its wheels branded with the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

48. Applicant sells its wheels branded with the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

49. Applicant's wheels have been sold under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

50. Applicant's wheels are sold under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

51. Opposer sells tires in connection with Opposer's Mark.

52. Opposer sells wheels at its BIG O stores.

53. Opposer installs wheels at its BIG O stores.

54. Opposer promotes wheels at its Internet website.

55. Opposer sells the goods listed in its pleaded registrations in connection with Opposer's Mark.

56. Opposer sells tires in the automotive aftermarket in connection with Opposer's Mark.

57. Opposer's Mark is well-known in the United States.

58. Opposer's Mark is famous in the United States.

59. Opposer's Mark is well-known in the United States automotive market.

60. Opposer's Mark is famous in the United States automotive market.

61. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIG" in connection with tires (other than marks involved in this proceeding).

62. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIGG" in connection with tires.

63. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIG" in connection with wheels (other than marks involved in this proceeding).

64. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIGG" in connection with wheels (other than marks involved in this proceeding).

65. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIG" in connection with vehicular services (other than marks involved in this proceeding).

66. Applicant does not possess any documents which support Applicant's First Affirmative Defense as pleaded at paragraph 13 of Applicant's Answer to Notice of Opposition.

67. Applicant is not aware of any evidence which supports Applicant's First Affirmative Defense as pleaded at paragraph 13 of Applicant's Answer to Notice of Opposition.

68. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's First Affirmative Defense as pleaded at paragraph 13 of Applicant's Answer to Notice of Opposition.

69. Applicant does not possess any documents which support Applicant's Second Affirmative Defense as pleaded at paragraph 14 of Applicant's Answer to Notice of Opposition.

70. Applicant is not aware of any evidence which supports Applicant's Second Affirmative Defense as pleaded at paragraph 14 of Applicant's Answer to Notice of Opposition.

71. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Second Affirmative Defense as pleaded at paragraph 14 of Applicant's Answer to Notice of Opposition.

72. Applicant does not possess any documents which support Applicant's Third Affirmative Defense as pleaded at paragraph 15 of Applicant's Answer to Notice of Opposition.

73. Applicant is not aware of any evidence which supports Applicant's Third Affirmative Defense as pleaded at paragraph 15 of Applicant's Answer to Notice of Opposition.

74. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Third Affirmative Defense as pleaded at paragraph 15 of Applicant's Answer to Notice of Opposition.

75. Applicant does not possess any documents which support Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 of Applicant's Answer to Notice of Opposition.

76. Applicant is not aware of any evidence which supports Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 of Applicant's Answer to Notice of Opposition.

77. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 of Applicant's Answer to Notice of Opposition.

78. Applicant does not possess any documents which support Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 of Applicant's Answer to Notice of Opposition.

79. Applicant is not aware of any evidence which supports Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 of Applicant's Answer to Notice of Opposition.

80. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 of Applicant's Answer to Notice of Opposition.

81. Applicant does not possess any documents which support Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 of Applicant's Answer to Notice of Opposition.

82. Applicant is not aware of any evidence which supports Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 of Applicant's Answer to Notice of Opposition.

83. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 of Applicant's Answer to Notice of Opposition.

84. Applicant does not possess any documents which support Applicant's contention that "the term BIGG of applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG O of the cited registrations," as stated in Applicant's Reply to Office Action of December 4, 2003 filed in support of the opposed application.

85. Applicant is not aware of any evidence which supports Applicant's contention that "the term BIGG of applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG O of the cited registrations," as stated in Applicant's Reply to Office Action of December 4, 2003 filed in support of the opposed application.

86. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's contention that "the term BIGG of applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG O of the cited

registrations,” as stated in Applicant’s Reply to Office Action of December 4, 2003 filed in support of the opposed application.

87. All documents produced by Applicant in response to Opposer’s First Request for Production in this proceeding are genuine pursuant to the Federal Rules of Evidence.

88. All documents produced by Applicant in response to Opposer’s First Request for Production in this proceeding are part of the business records of Applicant kept in the normal course of Applicant’s business.

89. All documents produced by Applicant in response to Opposer’s First Request for Production in this proceeding are admissible as evidence in this proceeding under the Federal Rules of Evidence, subject to any objections of Applicant on the grounds of relevance.

90. The goods listed in the opposed application are marketed and sold in the automotive aftermarket.

91. The goods listed in the opposed application are marketed and sold in the automotive aftermarket under Applicant’s Mark.

92. Vehicle tires are marketed and sold in the automotive aftermarket.

93. Vehicle wheels are marketed and sold in the automotive aftermarket.

94. Opposer’s tires are marketed and sold in the automotive aftermarket under Opposer’s Mark.

95. Vehicle tires are related to the goods listed in the Opposed Application.

96. Vehicle tires are similar to the goods listed in the Opposed Application.

97. The services listed in the pleaded registrations are related to the goods listed in the Opposed Application.

98. Vehicle tires are sold through similar channels of trade as vehicle wheels.

99. After-market vehicle tires are sold through similar channels of trade as after-market vehicle wheels.

100. The goods listed in the Opposed Application are sold through similar channels of trade as Opposer sells its tires under Opposer's Mark.

101. The goods listed in the Opposed Application are sold through similar channels of trade as Opposer offers its services under Opposer's Mark.

102. The goods listed in the Opposed Application are sold under Applicant's Mark through similar channels of trade as Opposer sells its tires under Opposer's Mark.

103. The goods listed in the Opposed Application are sold under Applicant's Mark through similar channels of trade as Opposer sells its goods under Opposer's Mark.

104. The goods listed in the Opposed Application are sold under Applicant's Mark through similar channels of trade as Opposer offers its services under Opposer's Mark.

105. Applicant sells its goods under the opposed mark to the same general class of purchasers as Opposer sells its tires under Opposer's Mark.

106. Applicant sells its goods under the opposed mark to the same general class of purchasers as Opposer sells its goods under Opposer's Mark.

107. Applicant sells its goods under the opposed mark to the same general class of purchasers as Opposer offers its services under Opposer's Mark.

108. Purchasers of wheels for automobiles also purchase automobile tires.
109. The mark of the opposed application is identical to Opposer's Mark.
110. The mark of the opposed application is similar to Opposer's Mark.
111. Purchasers of wheels for automobiles purchase such wheels from retail stores featuring automotive parts and accessories.
112. Purchasers of wheels for automobiles also purchase tires under Opposer's Mark.
113. The United States Patent and Trademark Officer Examiner, who reviewed the opposed application, required Applicant to disclaim the word "WHEELS" in the opposed application.
114. Applicant disclaimed the word "WHEELS" in the opposed application.
115. The dominant portion of the BIGG WHEELS mark is the term "BIGG."
116. In Applicant's promotional materials, the term BIGG is in a larger size lettering than the word "WHEELS."
117. In the specimen Applicant submitted to the Trademark Examiner, the term BIGG is in a larger size lettering than the word "WHEELS."
118. The term "BIGG" of Applicant's BIGG WHEELS mark appears on Applicant's products in a larger size lettering than the term "WHEELS."
119. Retail outlets that sell Applicant's BIGG WHEELS products also sell tires.
120. At least some of the retail outlets that sell Applicant's BIGG WHEELS products also sell tires.

121. Some third parties who sell Applicant's BIGG WHEEL products also provide tire-related automotive services.

122. Some third parties who sell Applicant's BIGG WHEEL products also sell tires.

123. Some third parties who sell Applicant's BIGG WHEEL products also provide automotive maintenance services.

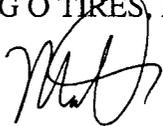
124. Some third parties who sell Applicant's BIGG WHEEL products also provide automotive repair services.

125. Some third parties who sell Applicant's BIGG WHEEL products also sell automotive parts.

126. Some third parties who sell Applicant's BIGG WHEEL products also sell automotive accessories.

BIG O TIRES, INC.

By:

  
\_\_\_\_\_  
Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
(202) 638-6666

Dated: April 19, 2005  
Attorney Docket No.: I-5156

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 19<sup>th</sup> day of April, 2005, a true copy of the foregoing Opposer's First Set of Requests for Admissions was served by first-class mail, postage prepaid, upon counsel for Applicant:

Donald L. Otto, Esquire  
Warren A. Sklar, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

A handwritten signature in cursive script, reading "Sheryl P. Harris", is written over a horizontal line.





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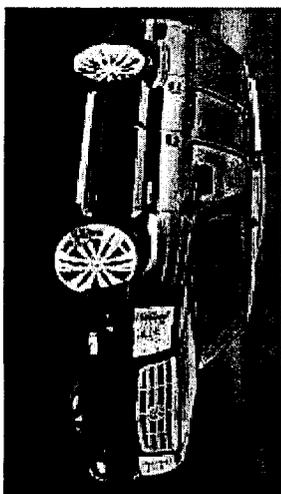
We feature customized auto parts and auto accessories at wholesale prices. From wheels and tires to grills, billet accessories, taillights, and spoilers, we've got it all under one roof.

<b>Wheels:</b> <ul style="list-style-type: none"> <li>• Classics, Vintage, Etc..</li> <li>• Custom Chrome Wheels</li> <li>• Custom Color Wheels with Chrome Lip</li> </ul>	<b>Tires:</b> <ul style="list-style-type: none"> <li>• Nitto™</li> <li>• Pirelli™</li> <li>• Hankook™</li> <li>• 13" to 26" tires</li> <li>• 28 Inch (Coming Soon)</li> </ul>	<b>Automotive Parts:</b> <ul style="list-style-type: none"> <li>• Grills</li> <li>• Taillights</li> <li>• Custom Hoods &amp; Scoops</li> <li>• Billet accessories</li> <li>• Spoilers</li> </ul>
--	---	--

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We are a locally owned and operated business and pride ourselves in always providing quality wheels, tires, and auto accessories, personalized customer service, and competitive prices you can afford. Feel free to contact us by e-mail (please name the year, type and style of your vehicle, also the name of specific wheels and tires), phone us (ask for JEREMY), or stop by the store to find out more about our

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# WHEEL WORLD WILL BE CHANGING IT'S NAME TO THE WHEEL SPECIALIST AS OF MAY 1ST

Wheel World LLC  
9991 Highway 178  
Olive Branch, MS 38654-3261

Phone: (662) 890-3354  
Fax: (662) 890-9943  
[wheelworld662@aol.com](mailto:wheelworld662@aol.com)





# Wheel World LLC

Wheels, Tires, and Auto Parts

Images & Text Layout 6

## BIGG WHEELS

Home

Wheel Gallery

AKUZA

AMERICAN EAGLE

AMERICAN RACING

ARELLI

ASA

ASANTI

\* BIGG

CENTER LINE

DAVIN

DEVINO

DOWNZ

DRIV

DUB

FERRETTI

HIPNOTIC

KAIZER

LIMITED

LIGHT

MIZATI

ROX

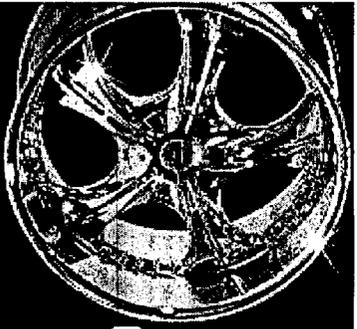
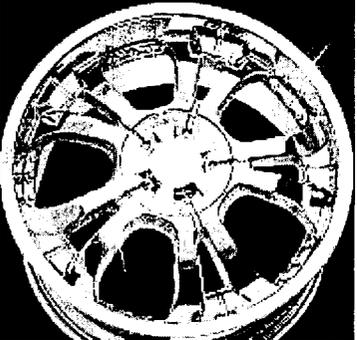
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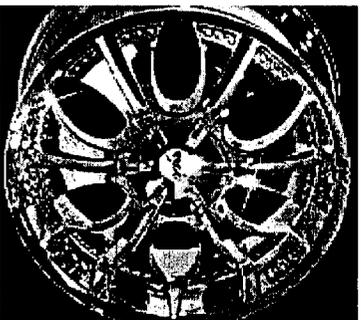
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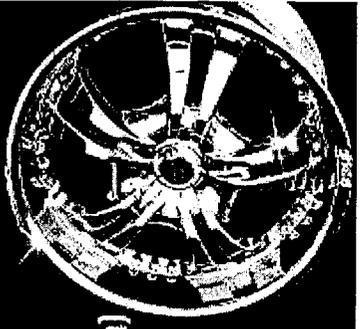
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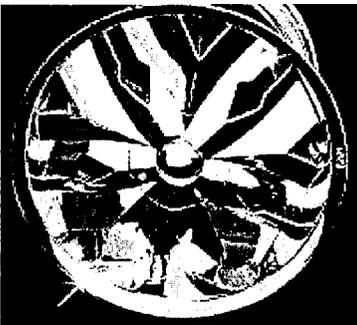
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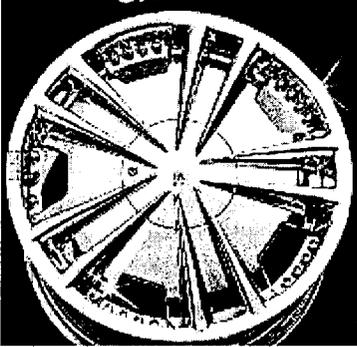
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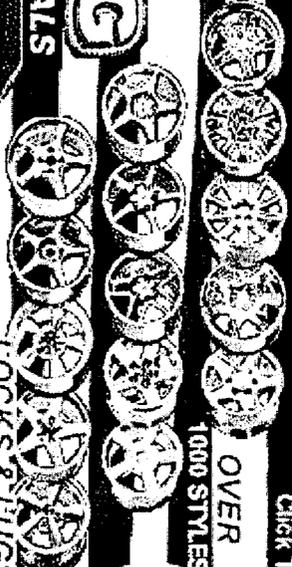
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EXHIBIT B

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Anthony  
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Löwenhart

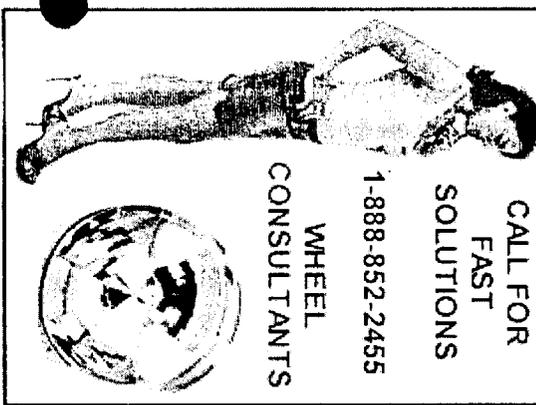
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CUSTOM WHEELS SLIDESHOWS



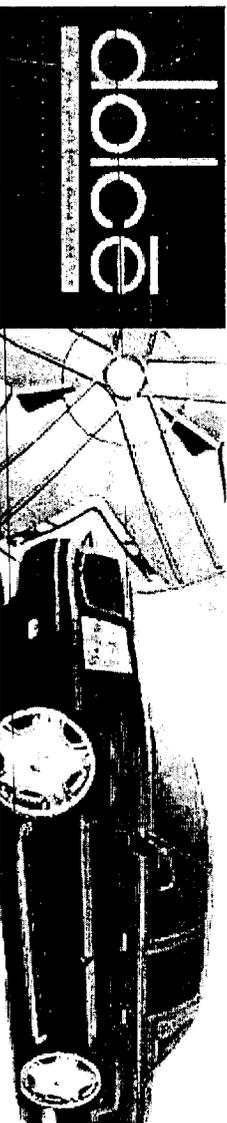
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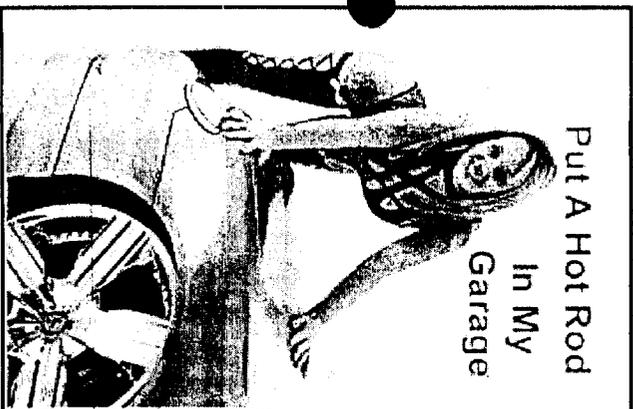
AKITA	DK ALLOYS	LOWENHART	SPORT METAL
ALBA	DOLCE	MAAS	TEAM DYNAMICS
AMERICAN RACING	DRIFZ	MAYA	TIS
AMG		MAZZI	
ASANTI	DRIV	MKW	ULTRA
AVENUE		MOGUL	
BACARAT	DUB	MOSSA	VELOCHE
BAZO	EQUUS	MOTEGI RACING	VERDE
BBS	EXCESS SPIN	NICHE	WHEEL REPLICA
BIGG	FALKEN	OE PERFORMANCE	ZINIK
BOYD CODDINGTON	FOOSE	PACER	ZORA
CENTERLINE	GEAR ALLOY	PANTHER	
CHROME EXPRESSIONS	ICW	PLATINUM	
CRAGAR	ION	RADD	
CRUISER ALLOY	JESSE JAMES	ROH	
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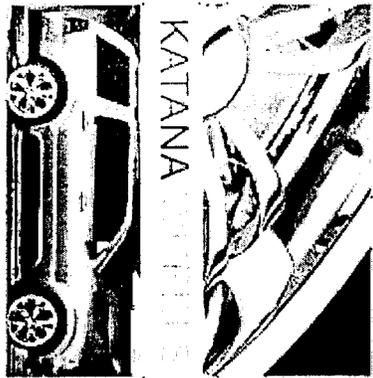
ALBA SLIDESHOW

BAZO SLIDESHOW

BOYD CODDINGTON

ALBA

AMERICAN RACING



CUSTOM SLIDESHOW 1

MOTEGI RACING

CUSTOM SLIDESHOW 2

SOFT WHEELS

FALKEN SLIDESHOW

GFG SLIDESHOW

GIOVANNA SLIDESHOW

MKW SLIDESHOW

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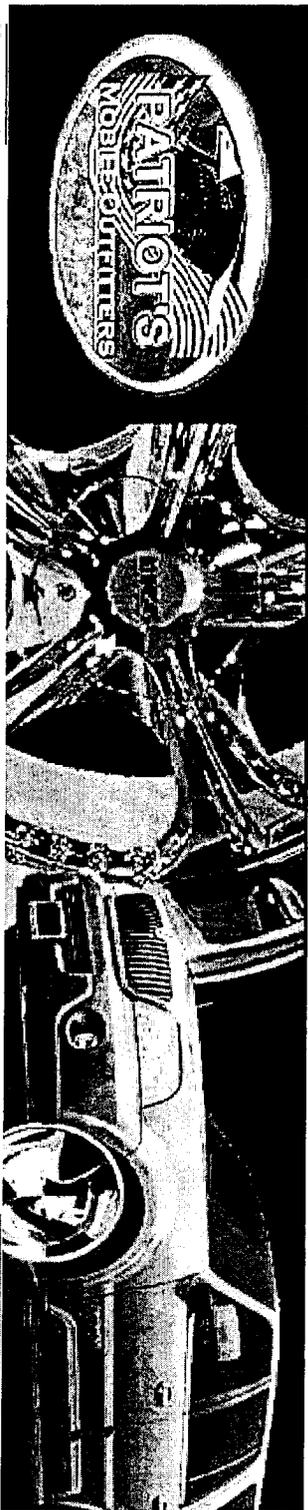
PATRIOTS MOBILE OUTFITTERS ROANOKE, VIRGINIA 2005

PURCHASE AGREEMENT

CUSTOM WHEELS







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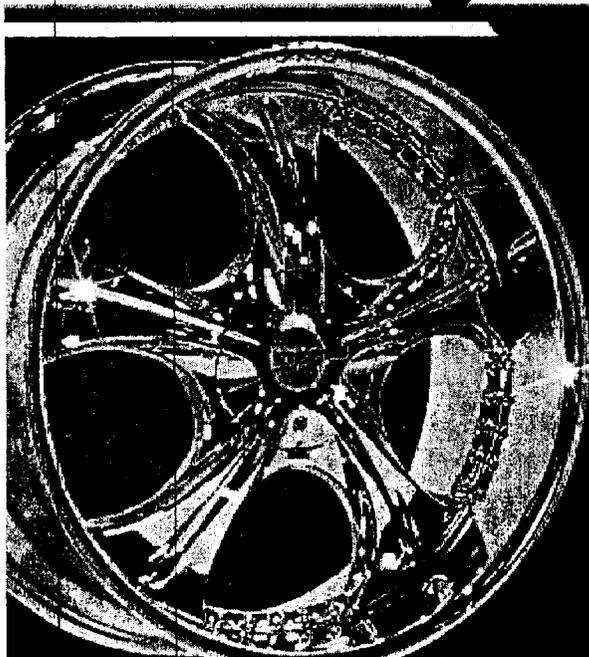
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**22X9.5**

**FWD**  
**17X7.5**  
**18X7.5**  
**20X8.5**

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**BIGG**

**BILL**

**BLACK  
w/ Machined Lip**

**TRUCK/SUV**  
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**22X9.5**

**FWD**  
**17X7.5**  
**18X7.5**  
**20X8.5**

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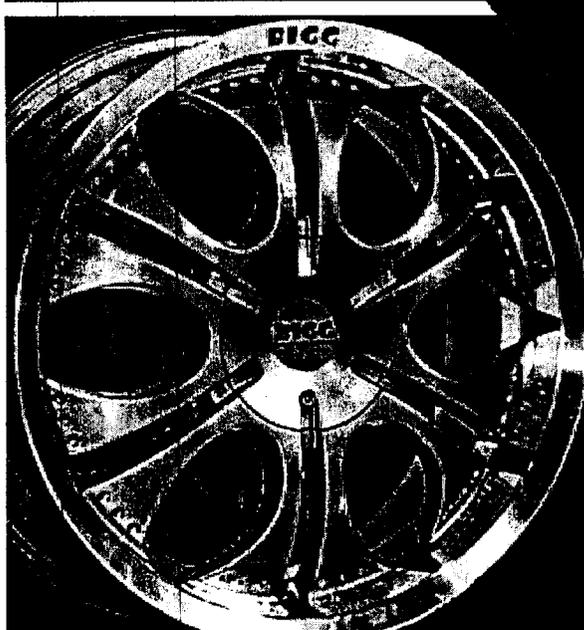
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**FWD**

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18X7.5  
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**BIGG**

**JOE**

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**GUNMETAL  
w/ Machined Lip**

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w/ Machined Lip**

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20X8.5

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## CHROME

TRUCK/SUV

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22X9.5

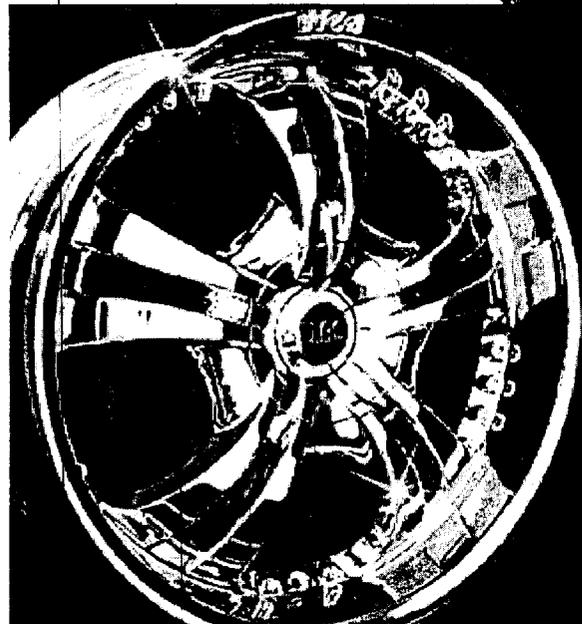
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FWD

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

BIG O TIRES, INC.,

Opposer,

vs.

WHEEL SPECIALTIES. LTD.,

Applicant.

Opposition No. 91163791

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

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, Opposer hereby requests that Applicant produce for inspection and copying the documents listed below at the place where such documents usually are kept, or at such other time and place as agreed upon by the parties.

**INSTRUCTIONS AND DEFINITIONS**

A. The Instructions and Definitions set forth in Opposer's First Set of Interrogatories, served concurrently herewith, are incorporated herein by reference and made a part hereof, as if fully stated herein.

B. Applicant shall designate in its responses with respect to each document requested, whether any documents responsive to the request exist; whether such documents will be produced by Applicant, when and where the documents will be produced, and where such documents usually are kept.

## DOCUMENT REQUESTS

1. The documents requested to be identified in Opposer's First Set of Interrogatories, served on Applicant concurrently herewith.

2. The documents referenced or identified by Applicant in response to Opposer's First Set of Interrogatories.

3. All documents that constitute, contain, comment on, refer to, relate to, reflect, describe, and/or disclose, any consideration, proposal or decision to adopt and/or use Applicant's Mark.

4. All documents which do, or may, support any claims or defenses of Applicant herein, and/or which Applicant believes would be admissible evidence on its behalf at the trial of this proceeding.

5. All documents which list, show, explain or describe each of the products sold and/or services offered by Applicant under Applicant's Mark and/or planned to be offered and/or sold under Applicant's Mark, including without limitation, each catalogue, brochure, or other printed materials or video/audio tapes.

6. A sample (or if due to the physical size of same, in lieu thereof a photograph sufficiently legible to show the product and any writing or marks thereon) of each product sold and/or intended to be sold under Applicant's Mark, and each display, tag, label, warranty, insert, and any other material included and/or intended to be included with such product when offered for sale, sold, and/or shipped in interstate commerce.

7. A sample of each sign, brochure, handbill, stationery, advertisement, business card, identification card, display, pre-printed contract or form, decal, badge, label, and other advertising, promotional, and/or printed materials on which Applicant's Mark has been displayed or has appeared.

8. All materials which have been produced, drafted, or proposed for use, including mock-ups for same, which display, refer or relate, in any way, to Applicant's Mark, whether or not such have ever been used, displayed, and/or disseminated.

9. A sample of each advertisement (including, but not limited to, television and/or radio commercials or spots) and promotional material (including, but not limited to audio and video tapes and CD's, Internet web site(s) and other material intended for viewing and/or listening by computer or other machine), bearing, mentioning or displaying Applicant's Mark and/or the products sold and/or offered for sale under Applicant's Mark.

10. A specimen of each label, tag, nameplate, packaging and other material (including, but not limited to, packaging, warranty cards, instruction sheets, promotional items, etc.) bearing, displaying and/or containing Applicant's Mark.

11. A sample of each and every document and thing bearing Applicant's Mark, or to which Applicant's Mark is affixed, whether or not such material ever has been used, distributed, disseminated, or displayed.

12. Documents sufficient to show and/or identify each catalog, sales outlet, Internet web site or other electronic means, retail outlet, and wholesale outlet in which Applicant's services or goods are advertised, promoted, sold, offered for sale, and/or distributed under Applicant's Mark.

13. All mailing lists and other lists of actual or potential customers, clients, sales representatives, brokers, dealers, and/or distributors of Applicant with respect to the products sold and/or to be sold in connection with Applicant's Mark.

14. All documents which evidence, support, refer, or relate to Applicant's knowledge of Opposer's Mark, and/or to the circumstances under which such knowledge was obtained, including but not limited to all documents referring or relating to Opposer or Opposer's Mark.

15. All documents which evidence, support, or show the denials in Applicant's Answer related to the Notice of Opposition.

16. All documents which were reviewed, consulted and/or relied upon by Applicant in making the denials in Applicant's Answer related to the Notice of Opposition.

17. All documents which evidence, support, or show Applicant's First Affirmative Defense as pleaded at paragraph 13 in Applicant's Answer.

18. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's First Affirmative Defense in Applicant's Answer.

19. All documents which evidence, support, or show Applicant's Second Affirmative Defense as pleaded at paragraph 14 in Applicant's Answer.

20. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Second Affirmative Defense in Applicant's Answer.

21. All documents which evidence, support, or show Applicant's Third Affirmative Defense as pleaded at paragraph 15 in Applicant's Answer.

22. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Third Affirmative Defense in Applicant's Answer.

23. All documents which evidence, support, or show Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 in Applicant's Answer.

24. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Fourth Affirmative Defense in Applicant's Answer.

25. All documents which evidence, support, or show Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 in Applicant's Answer.

26. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Fifth Affirmative Defense in Applicant's Answer.

27. All documents which evidence, support, or show Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 in Applicant's Answer.

28. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Sixth Affirmative Defense in Applicant's Answer.

29. All documents which refer or relate to Opposer.

30. All documents which refer or relate to Opposer's Mark.

31. All documents which refer or relate to Opposer's products.

32. All documents which refer or relate to Opposer's services.

33. All documents which refer or relate to Opposer's stores.

34. All documents which refer or relate to any of the registrations and application pleaded by Opposer in the Notice of Opposition.

35. All documents which refer or relate to the circumstances under which Applicant first became aware of the actual or possible use of Opposer's Mark.

36. All documents which evidence, relate or refer to the time Applicant first learned of Opposer.

37. All documents which evidence, relate or refer to the time Applicant first learned of Opposer's BIG O stores.

38. Documents sufficient to show Applicant's annual sales in numbers of units and in gross revenues, for products sold under Applicant's Mark, from the date of alleged first use of Applicant's Mark to the present.

39. Documents sufficient to show Applicant's annual sales in numbers of units and in gross revenues, for services offered under Applicant's Mark, from the date of alleged first use of Applicant's Mark to the present.

40. Documents sufficient to show or evidence Applicant's advertising expenditures in connection with Applicant's Mark and/or the products sold and/or services offered under Applicant's Mark, for each year from the date of alleged first use of Applicant's Mark through the present.

41. All documents relating and/or referring to the channels of trade through which services offered under, or products bearing, Applicant's Mark have been sold or are intended to be sold, including but not limited to documents describing the types of customers to whom Applicant advertises, promotes, and/or sells Applicant's products, and/or the retail and wholesale outlets in which Applicant's products in connection with Applicant's Mark are or have been used and/or sold.

42. All documents referring or relating to Applicant's Mark that have been filed with or received from any federal, state or local governmental office or regulatory agency, including without limitation all documents filed in connection with efforts to obtain approval to offer any services or sell any products under Applicant's Mark, or to obtain registration of Applicant's Mark.

43. All documents relied upon, either in whole or in part, as a basis for each opinion to be rendered by:

- (a) each expert witness that Applicant will or may call; and
- (b) each person from whom Applicant has obtained, or will obtain, statements or affidavits, or who is expected to give testimony in this case.

44. All documents constituting and/or comprising any opinion(s) and/or report(s) furnished by:

- (a) each expert witness that Applicant will or may call; and
- (b) each person from whom Applicant has obtained, or will obtain, statements or affidavits, or who is expected to give testimony in this case.

45. All documents which constitute, evidence, support, refer, or relate to any search (including but not limited to any trademark search reports), survey, poll, and/or investigation concerning, referring or relating to Opposer's Mark or any trademark comprised in whole or in part of the term "BIG", and/or to the products sold and/or offered under Opposer's Mark.

46. All documents which constitute, evidence, support, refer, or relate to any search (including but not limited to any trademark search reports), survey, poll, and/or investigation concerning, referring or relating to Applicant's Mark or any trademark comprised in whole or in part of the term "BIGG", and/or to the products sold and/or offered (or intended to be sold and/or offered) under Applicant's Mark.

47. All documents referring or relating to any United States service mark and trademark registrations, or applications, issued to, or filed by, Applicant, for any mark incorporating "BIG" or "BIGG" alone or in combination with other words, letters, or symbols.

48. All documents which evidence, refer, or relate to the strength (as that term is used in determining likelihood of confusion) of Opposer's Mark.

49. All documents which evidence, support, refer, or relate to any license, assignment, agreement, understanding, or other grant or transfer of rights referring or relating to Applicant's Mark.

50. Each document reviewed, consulted, or on which Applicant relied, to draft its answers to Opposer's First Set of Interrogatories, served concurrently herewith.

51. Each document reviewed, consulted, or on which Applicant relied, to draft its answers to Opposer's First Set of Requests for Admissions, served concurrently herewith.

52. Each document which shows, evidences, or supports Applicant's responses to Opposer's First Requests for Admissions, served concurrently herewith.

53. Each document which shows, evidences, or supports Applicant's responses to Opposer's First Set of Interrogatories, served concurrently herewith.

54. Each document which shows, evidences, or supports that Applicant's Mark, as used in connection with Applicant's goods, is not likely to be confused with Opposer's Mark.

55. All marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by or for Applicant relating to its sale or proposed sale of products bearing, and/or in connection with which Applicant uses, Applicant's Mark.

56. All marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by or for Applicant relating to its offer or proposed offer of services under and/or in connection with Applicant's Mark.

57. All marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by or for Applicant relating to the offer or proposed offer of goods under and/or in connection with Applicant's Mark.

58. If Applicant's response to any of the requests in Opposer's First Request for Admissions, served concurrently herewith, is anything other than an unqualified admission, for each such request, all documents which evidence, show and/or support the denial of such Request for admission, and/or Applicant's basis for Applicant's response to the Request for admission.

59. A complete copy of each version of any web site linked to a domain name registered to Applicant, including but not limited to the HTML code for same, from the creation of the web site through the present.

60. For each mark identified in response to Interrogatory Number 15, all documents which demonstrate, refer or relate to:

- a) the dates of usage(s) of such mark,
- b) the goods/services sold in connection with the mark,
- c) the identity of the party so using the mark, and
- d) where (name and address) these goods/services can be found in the

marketplace.

61. Produce a copy of the certificate of registration for each trademark or service mark registration identified in response to Interrogatory Number 12.

62. All documents relating to the price of each of the goods sold or to be sold under Applicant's Mark.

63. All documents relating to the price of the services offered or to be offered under Applicant's Mark.

64. All documents relating to any objection, lawsuit, opposition proceeding, cancellation proceeding or other proceeding involving or relating to Applicant's Mark.

65. With respect to each product and/or service with which Applicant's Mark has been used, documents sufficient to show whether or not Applicant's use of the mark in connection with such product/service has been continuous.

66. With respect to each product and/or service in connection with which Applicant's Mark has been used, all documents which evidence, refer, or relate to Applicant's first use in interstate commerce of Applicant's Mark in connection with each such product and/or service.

67. With respect to the earliest date on which Applicant will rely in this proceeding to establish Applicant's rights in Applicant's Mark, all documents which evidence, support, refer, or relate to such claim or rights in Applicant's Mark by Applicant as of that date.

68. All documents that reflect, relate to or refer to any confusion as to origin, endorsement, approval or sponsorship of goods or services sold, distributed or offered by Applicant under Applicant's Mark and/or by Opposer under Opposer's Mark.

69. For each year in which products have been sold under Applicant's Mark, documents sufficient to identify each state where such product was sold.

70. Documents sufficient to identify all automotive-related entities that purchased goods under Applicant's Mark.

71. Documents sufficient to identify all entities that sell tires and also purchased goods under Applicant's Mark.

72. Documents sufficient to identify all entities that have sold tires and also purchased goods under Applicant's Mark.

73. Documents sufficient to identify all entities that sell automotive parts and accessories and also purchased goods under Applicant's Mark.

74. Documents sufficient to identify all entities that have sold automotive parts and accessories and also have purchased goods under Applicant's Mark.

75. Documents sufficient to identify all entities that offer automotive repair and maintenance services and have purchased goods under Applicant's Mark.

76. Documents sufficient to identify all entities that have offered automotive repair and maintenance services and have purchased goods under Applicant's Mark.

77. Documents sufficient to identify all entities that offer tire-related automotive services and that have purchased goods under Applicant's Mark.

78. Documents sufficient to identify all entities that have offered tire-related automotive services and that have purchased goods under Applicant's Mark.

79. Documents sufficient to identify all automotive-related entities that sell Applicant's goods bearing Applicant's Mark.

80. Documents sufficient to identify all entities that sell tires and also sell Applicant's goods bearing Applicant's Mark.

81. Documents sufficient to identify all entities that have sold tires and also sold goods bearing Applicant's Mark.

82. Documents sufficient to identify all entities that sell automotive parts and accessories and also sold goods bearing Applicant's Mark.

83. Documents sufficient to identify all entities that have sold automotive parts and accessories and also have sold goods bearing Applicant's Mark.

84. Documents sufficient to identify all entities that offer automotive repair and maintenance services and have sold goods bearing Applicant's Mark.

85. Documents sufficient to identify all entities that have offered automotive repair and maintenance services and have sold goods bearing Applicant's Mark.

86. Documents sufficient to identify all entities that offer tire-related automotive services and that have sold goods bearing Applicant's Mark.

87. Documents sufficient to identify all entities that have offered tire-related automotive services and that have sold goods bearing Applicant's Mark.

88. Documents sufficient to identify all goods sold by Applicant in the automotive industry.

BIG O TIRES, INC.

By:



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Marsha G. Gentner  
Matthew J. Cuccias  
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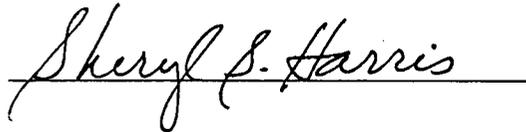
April 19, 2005  
Attorney Docket No. I-5156

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 19<sup>th</sup> day of April, 2005, a true copy of the foregoing Opposer's First Set of Document Requests was served by first-class mail, postage prepaid, upon counsel for Applicant:

Donald L. Otto, Esquire  
Warren A. Sklar, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

A handwritten signature in cursive script, reading "Sheryl S. Harris", is written over a horizontal line.

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

BIG O TIRES, INC.,

Opposer,

vs.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S FIRST SET OF INTERROGATORIES**

Pursuant to Fed. R. Civ. P. 33, and Rule 2.120 of the Trademark Rules of Practice, Opposer requests that Applicant answer, in writing and under oath, the interrogatories propounded below. Such responses must be made within thirty (30) days of service of these interrogatories, in accordance with the Federal Rules of Civil Procedure and the Trademark Rules of Practice.

**INTRODUCTION AND DEFINITIONS**

A. As used herein, the term "person(s)" includes not only natural persons, officers, managing agents, supervisory personnel, and employees, but also includes, without limitation, firms, partnerships, associations, corporations and other legal entities, divisions, departments or other units thereof.

B. "Opposer" shall mean the nominal Opposer, Big O Tires, Inc. [hereinafter "Big O" or "Opposer"], and any predecessor(s) or successor(s) in interest, subsidiaries, divisions, franchisees and related companies, directors, officers and employees thereof.

C. "Applicant" shall mean the nominal Applicant, Wheel Specialties, Ltd., as well as any predecessor(s) or successor(s) in interest, and any partnership and/or corporation in which Wheel

Specialties, Ltd., has an ownership interest and/or controls and which uses the opposed mark in any way, as well as all divisions, licensees, parent, subsidiary, affiliated or related companies thereof, and the partners, principals, directors, officers, agents and employees thereof. When an answer is supplied with respect to any predecessor or successor in interest, division, licensee, parent, subsidiary, affiliated or related company, this fact should be stated and such predecessor in interest, division, licensee, parent, subsidiary, affiliated or related company should be fully identified by name and principal place of business.

D. As used herein, the term "Opposer's Mark" shall refer individually and/or collectively to the marks/application/registrations pleaded in the Notice of Opposition, including, or in addition to, BIG O, BIG O TIRES, BIG FOOT, BIGFOOT COUNTRY, BIG HAUL, BIG LIFT, and any term incorporating "BIG" in any and all formats, used alone or in combination with any other word(s) or design(s), or symbol(s) and/or any other term or designation comprised in whole or in part of "BIG" as used by or on behalf of Opposer.

E. As used herein, the term "Applicant's Mark" refers to the mark of the opposed application and/or any other mark, name, or designation containing the term "BIGG", in any and all forms and formats, used alone or in combination with any other word(s), design(s) or symbol(s).

F. As used herein, the term "document" is used in its broadest sense, to include, without limitation, the following items, whether printed, or recorded, or filmed, or reproduced by any process, or written or produced by hand, and whether or not claimed to be privileged against discovery on any ground, and whether an original, master or copy; including but not limited to, communications, including intra-company communications and correspondence; cablegrams,

radio-grams and telegrams; facsimiles; notes and memoranda; summaries, minutes and records of telephone conversations, meetings and conferences, including lists of persons attending meetings or conferences; summaries and records of personal conversations or interviews; e-mails; reports; customer lists; books, manuals, publications and diaries; laboratory engineering reports; reports of test results; notebooks; charts; plans; sketches and drawings; photographs; reports and/or summaries of investigations and/or surveys; customer surveys; opinions and reports of consultants; opinions of counsel; reports and summaries of negotiations; brochures; instruction manuals; user manuals; computer software; web pages; Internet data and downloads; computer diskettes; computer hard drive; compact discs; computer tapes; graphics, and other data fixed or recorded by electronic means; databases; audio tapes; audio cassettes; video tapes; video cassettes; video discs; films; operation manuals; pamphlets, catalogs and catalog sheets; advertisements, including storyboard and/or scripts for television commercials; circulars; trade letters; press publicity and trade and product releases; product descriptions; drafts of original or preliminary notes on, and marginal comments appearing on, any document; applications for approval by a governmental agency; other reports and records; and any other information-containing paper, writing or physical thing.

G. As used herein, "communication" is used in its broadest sense, to include, without limitation, the following:

- (1) any document, as defined hereinabove; and
- (2) any conversation, discussion, dialogue, conference, report, message, account, interview, exchange, and/or consultation, whether oral, written, or electronic.

H. "Identify" or "identification" with respect to a person, means provide the person's:

- (1) name;
- (2) last known residential address;
- (3) last known business address;
- (4) last known employer or business affiliation; and
- (5) occupation and business position held.

I. "Identify" or "identification" with respect to a company, partnership, firm, corporation or other non-juristic person, shall mean provide:

- (1) the name;
- (2) if incorporated, the place of incorporation;
- (3) if unincorporated, the name of the partners and/or principals; and
- (4) the address of such entity's principal place of business.

J. "Identify" or "identification" with respect to a document, shall mean provide:

- (1) the identity of the person or persons who prepared it, the sender, and all recipient(s), if any;
- (2) the title of the document;
- (3) a description of the general nature of its subject matter(s);
- (4) the date of preparation;
- (5) the date and manner of distribution and publication, if any;
- (6) the location of each copy, and the identity of the present custodian; and
- (7) the identity of the person or persons who can identify and/or authenticate it.

K. "Identify" or "identification" with respect to an act, occurrence, circumstance, or event (collectively "act"), shall mean providing:

- (1) a description of the act;
- (2) the date(s) the act occurred;
- (3) where the act occurred;
- (4) the identity of the person or persons performing said act (or, in the case of an omission, the identity of the person or persons failing to act);
- (5) the identity of all persons who have any knowledge or information, about or regarding the act, including the identity of each witness to the act;
- (6) when the act, or omission, first became known to Applicant; and
- (7) the circumstances and manner in which knowledge of the act was first obtained by Applicant.

L. "Identify" or "identification" with respect to goods, products, or services shall mean:

- (1) state the common descriptive name of said good, product or service;
- (2) state the model number, identify the manufacturer and location of manufacture thereof;
- (3) provide a detailed description of the purpose, function, and/or application of said good, product or service; and
- (4) describe in detail the channels of trade in which such product or service is sold and/or rendered.

M. "Identify" or "identification" with respect to a search (including but not limited to trademark searches), survey, poll, or other investigation (collectively "search") shall mean:

- (1) state the date and location of the search;
- (2) identify and describe all documents examined or investigated in connection with the search;
- (3) if applicable, state the size of the sample surveyed, how that sample was selected, and the questions asked;
- (4) identify each person(s) who conducted the search;
- (5) state all results and conclusions of the search, including, if applicable, each answer to each question posed;
- (6) with respect to a search or similar investigation, identify each reference disclosed by providing the mark or name which is the subject of such reference, the owner of the mark or name, the registrant or applicant, the registration or serial number, and the goods and services listed in, or in connection with, such reference;
- (7) identify each person who rendered any conclusions or opinion relating to such search;
- (8) identify each person to whom the results, in whole or in part, of such search and/or any conclusion or opinion relating to such search, were communicated, and the date(s) of such communication;
- (9) identify each person who has knowledge or information with respect to the search; and

(10) identify all documents which contain any results of, and/or refer or relate in any way to, such search.

N. "Advertising" and/or "promotional materials" shall mean, without limitation, advertisements, including advertising copy, advertising slicks, and line art; product packaging, labels, brochures, photographs, product sheets, point of sale displays, audio or video tapes; catalogues or other product guide books; signage, price lists, warranty information, Internet sites, web sites and/or pages, and/or any other document or material used and/or distributed to promote and/or solicit business, shipments, sales, and/or orders of products or services of Applicant.

O. "Identify" or "identification" with respect to "channels of trade" with respect to a product or service shall mean, without limitation:

(1) describe the circumstances surrounding the sale, distribution and/or rendition of such product/service; and

(2) state whether sales are through any one, or more, of the following means:

- (a) retail,
- (b) wholesale,
- (c) direct mail,
- (d) electronic commerce,
- (e) visits by salespersons,
- (f) direct contact with customers,
- (g) provision of sample goods or services,
- (h) trade shows,

- (i) other means, and if so, describe the nature of the sale,
- (j) any combination of the above sub-sections (a) through (I) inclusive,

of this definition, and if so, identify the applicable channels.

P. As used herein, "media" or "medium" shall be construed to comprise newspapers, consumer magazines, trade publications, trade shows, catalogues, and any means of audio, video, and/or electronic transmission, and "identify" or "identification" with respect to "media" or "medium" shall mean, without limitation:

(1) provide, for each print medium: the name of the publication or print media; the date; volume number; geographical area and size of circulation; and if directed to a particular trade, industry, or type of reader/customer, describe such trade/ industry/reader;

(2) provide, for each audio and video transmission (including radio and television): the station and/or network on which such transmission was broadcast; the geographical area of broadcast; and the date of each broadcast.

(3) provide, for each direct mailing or other direct distribution (including electronic mailings): the geographic area and dates of such distribution; the number of such mailings/direct distributions sent or disseminated; a general description of the persons to whom distributed; and if a mailing list was used, the source and identification of each such mailing list.

(4) identify, for each medium referring or relating in any way to Applicant's products or services, the specifically referenced product(s) or service(s) and mark(s) therefor; and

(5) identify the persons employed or associated with Applicant who have most knowledge of same.

Q. “Identify” or “identification” with respect to any advertisement or promotional materials shall mean:

(1) identify the medium in which such advertisement/promotional material was published, broadcast or otherwise disseminated;

(2) identify each person who created, ordered, distributed and/or placed such advertisement;

(3) state where, when, and to whom said advertisement or promotional material, and/or copies of same, were distributed, and the number of copies distributed at each such place and time; and

(4) identify documents which would show when and where the advertisement was placed/broadcast/distributed and the costs thereof, including an identification of the advertisement itself.

R. “Identify” or “identification” with respect to any objection or complaint regarding the use of a name or mark, lawsuit, opposition, cancellation, or other *inter partes* proceeding, shall mean identify:

(1) the person making the objection or complaint and/or on whose behalf the objection or complaint was made and/or who brought such lawsuit, opposition, cancellation or other *inter partes* proceeding;

(2) the date when such objections, complaint, lawsuit, opposition, cancellation or other proceeding was made and/or instituted;

(3) with respect to any lawsuit or proceeding, the parties thereto;

- (4) the civil action or docket number and/or other identifying indicator used by the tribunal before whom such was brought;
- (5) the court or other tribunal before whom the proceeding was brought;
- (6) the trademark(s) and/or service mark(s) at issue; and
- (7) the disposition and/or resolution of such objection, complaint or proceeding.

S. "Identify" or "identification" with respect to a retail outlet or store shall mean:

- (1) the retail outlet or store name;
- (2) the address of the retail outlet or store;
- (3) the owner(s) of the retail outlet or store;
- (4) the date on which the retail outlet or store was first opened to the public; and
- (5) to identify the products, services, and business offered or rendered by or from

such retail outlet or store.

T. "Identify" or "identification" with respect to an agreement, an assignment, license, understanding, or other contract or grant or transfer of rights, (collectively "agreement") shall mean:

- (1) identify the type of agreement — i.e. "assignment," "license," "consent to use," "distributorship agreement," etc.;
- (2) state the date and term of duration of the agreement, and whether such still is in effect;
- (3) identify the geographic scope of the agreement;
- (4) identify the parties to the agreement;
- (5) state whether the agreement is oral or in writing;

(6) describe in detail any rights and/or property transferred by the agreement, including whether the goodwill in any business, in whole or in part, was transferred as part of, or in connection with, the agreement and, if so, describe in detail the nature and extent of any goodwill assigned, licensed, granted, or transferred;

(7) if the agreement is a trademark or service mark license, identify the manner of control which is, or was, to be exercised with respect to the quality and character of the goods or services, on or in connection with which any affected mark was to be, or has been, used under such agreement;

(8) state whether the assignor, licensor, grantor, transferor still was doing business at the time of the assignment, license, understanding, grant, transfer;

(9) state whether the assignment/grant/transfer was one in bankruptcy;

(10) state whether the agreement was recorded in the Patent and Trademark Office or any other public record and, if so, state the date and place of such recordation(s);

(11) state in detail the conditions and terms of such agreement;

(12) identify all documents which evidence or refer or relate in any way to such agreement, including the agreement itself, if in writing;

(13) identify each person who drafted and/or participated in any way in the negotiations and/or drafting of the agreement, and/or who approved the same; and

(14) identify each person involved in or who has participated in the enforcement and/or execution of the agreement.

U. "Identify" or "identification" with respect to "expert witness," shall mean, without limitation:

- (1) identify such person;
- (2) describe the qualifications for such expert;
- (3) identify all articles, books or other publications authored in whole or in part by such expert;
- (4) identify all documents which such expert has reviewed and/or upon which such expert may rely in connection with his or her testimony; and
- (5) provide all of the information set forth in Rule 26(a)(2)(B) of the Federal Rules of Civil Procedure.

V. "Identify" or "identification" with respect to a trademark or service mark registration or application shall mean:

- (1) the identification of the agency or office where filed, when filed, and/or who issued such registration;
- (2) the names of the applicant and registrant;
- (3) the serial and registration number;
- (4) the filing and issue date(s);
- (5) the present status thereof;
- (6) if registration was refused, the reason(s) for such refusal;
- (7) identify all documents referring to such registration/application filed in connection with such registration or application including the registration/application itself.

(8) identify whether any assignment or other documents have been received, and if so, what and when in connection with such registration application.

W. "Identify" or "identification" with respect to an instance of confusion or mistake and/or an instance where a person thought, arrived or otherwise indicated a belief there may be an association between the parties herein and/or other products or businesses means state:

- (1) the identity of the person(s) confused or mistaken;
  - (2) the details of such event, including the "mistake" made and the substance of the "confusion;"
  - (3) the date and place of such event and/or instance of mistake or confusion;
  - (4) a description of the details of the manner in which such confusion, mistake, belief, assumption or indication was communicated or came to the attention of Applicant;
  - (5) the details of the response or communication, if any, made by or on behalf of Applicant, directly or indirectly, to the person so confused or mistaken or who communicated such confusion or mistake to Applicant;
  - (6) the identity of each person having knowledge of such confusion or mistake;
- and
- (7) the identity of all documents and communications which refer or relate in any way to such confusion or mistake.

X. As used herein, "and" or "or" shall be construed conjunctively or disjunctively as necessary to make the request inclusive rather than exclusive.

Y. As used herein, "referring or relating to" means comprising, relating to, referring to or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

Z. If Applicant is aware that a document or a group of documents once existed, but has been destroyed, in addition to the identification of the document as described herein, Applicant also is requested to state when the document or group of documents was destroyed, who destroyed it, why it was destroyed, and the circumstances under which it was destroyed.

AA. With respect to each document withheld on the ground of a claim of attorney privilege, identify such document in accordance with these definitions and instructions, and state in detail the basis and nature of such claim of privilege.

BB. These interrogatories shall be deemed to be continuing, requiring Applicant to serve upon Opposer amended or supplemental answers promptly after Applicant has acquired additional knowledge or information relating in any way to such interrogatories.

CC. With respect to any interrogatory which is asserted to be overbroad, or unduly burdensome, state all information requested which can be provided without undue burden, and/or which is relevant or might lead to the discovery of admissible evidence.

DD. Unless otherwise indicated, all discovery requests should be interpreted as referring to activities within the United States and/or interstate commerce and/or commerce which is regulatable by the Congress.

## INTERROGATORIES

1. State the earliest date on which Applicant will rely in this proceeding to establish any rights in Applicant's mark *vis-a-vis* Opposer, and state in detail the basis for Applicant's claim of rights in Applicant's mark as of that date, including:

(a) a description of the manner of use of Applicant's mark as of that date (i.e., imprinted on the goods, on labels or tags for the goods, on packaging for the goods, in store displays, etc.);

(b) the identity of each person involved in any way in such use, including, but not limited to the identity of each witness who can testify on personal knowledge as to such use;

(c) the identification of each product and/or service in connection with which the mark was used on that date; and

(d) the identification of each document which evidences or supports such claim of use as of that date.

2. Identify each product and/or service with which Applicant's mark has been used, and with respect to each such product and/or service identify:

(a) the period of time during which Applicant's mark has been used with said product and/or service (*i.e.*, the date of Applicant's first sale of the product bearing Applicant's mark to the date of Applicant's last sale);

(b) if the use was by a person other than Applicant, identify that person, and state in detail the basis upon which Applicant claims such use inures, or will inure, to its benefit;

(c) the sales, on an annual basis, in terms of dollar volume and units, of such product and/or service from the date of first use of Applicant's mark in connection with such product and/or service, through the present;

(d) each price charged and/or to be charged by and/or paid to Applicant for such products and/or service; and

(e) each state in which such product and/or service has been or is intended to be sold under or in connection with Applicant's mark.

3. Identify each survey, search or other investigation conducted and/or obtained with respect to Opposer's Mark, Applicant's mark, the term "BIGG" or "BIG" as used as a trademark or part of a trademark, and/or the actual, potential, or intended market, and/or the actual, potential, or intended customers of, or consumers for, the goods to be offered for sale and/or sold under or in connection with any of Opposer's Mark and/or Applicant's mark.

4. (a) State the annual volume of advertising under and/or in connection with Applicant's mark in connection with the goods set forth in the opposed application for each year since such advertising commenced.

(b) Identify each medium in which Applicant's mark has been or is intended to be listed, advertised, promoted, offered for sale and/or sold, and/or in which the products sold under Applicant's mark have been listed, advertised, promoted, offered for sale and/or sold.

5. Identify each broker, sales representative, licensee, franchisee, dealer, distributor, wholesaler, each retail outlet, trade show, catalog, and Internet web site and/or other electronic means, to and/or through which Applicant's goods have been or are intended to be advertised, promoted, offered for sale, distributed and/or sold, under or in connection with Applicant's mark.

6. For each product and service in connection with which Applicant is using or intends to use Applicant's mark, identify, in detail, the channels of trade through which such products and/or services have been or are intended to be sold and/or rendered, including but not limited to a general description of the type of customers to whom Applicant does or intends to advertise, promote, and/or sell Applicant's products and/or services in connection with Applicant's mark.

7. Identify each agreement, assignment, license, contract, consent grant, or transfer of rights which concerns, refers or relates to Applicant's mark and/or any rights in connection with such mark.

8. Identify each person who participated in the selection, creation, and/or decision to adopt and/or to use Applicant's mark; and describe in detail the reasons for and/or relating to the selection and adoption of Applicant's mark.

9. (a) Identify all persons employed by Applicant, and/or persons affiliated with, or contracted by, Applicant, responsible for advertising Applicant's mark and/or the goods/services sold or are intended to be sold under Applicant's mark (including but not limited to the designer of Applicant's Internet website(s)); and

(b) Identify the person(s) responsible for, or if there is no such person, with the most knowledge of, the marketing of goods and/or services offered for sale under or in connection

with Applicant's mark. (As used in this interrogatory, the term "marketing" includes but is not limited to, the customers, channels of trade, and type(s) of outlets where such goods are or will be offered for sale and/or sold.)

10. (a) Identify the circumstances under which (including, but not limited to, the date) Applicant first became aware of Opposer's Mark, Opposer's stores, and/or Opposer; the actual or possible use in any manner by Opposer of Opposer's Mark; and/or any products sold or distributed, and/or services rendered, bearing any of Opposer's Mark.

11. (a) Prior to the institution of the instant proceeding, did Applicant ever consider Opposer and/or Opposer's Mark with respect to and/or in connection with Applicant's mark and/or the products sold or to be sold under Applicant's mark or otherwise in connection with Applicant's business?

(b) If the response to sub-paragraph (a) of this interrogatory is other than an unqualified negative, state the date of such consideration, the action considered, and identify each person involved in, and communication related to, such consideration.

12. Identify each and every trademark and service mark registration you believe relevant to this Opposition proceeding, including for each, the reason(s) why you believe such to be relevant.

13. (a) Is Applicant aware of any instance of confusion or mistake regarding it and Opposer, their respective goods, services, or businesses, and/or Applicant's mark and Opposer's Mark?

(b) Has Applicant received any communication addressed or directed to, or which mentions, refers or relates in any way to, Opposer, Opposer's Mark and/or Opposer's products/services?

(c) Is Applicant aware of any instance where any person thought, assumed or otherwise indicated a belief that there is or may be an association between Applicant and Opposer, Applicant's mark and Opposer's Mark, and/or the respective products or services or businesses of Applicant and Opposer?

14. (a) If the answer to Interrogatory No. 13(a), above, is other than an unqualified negative, identify each instance of confusion or mistake.

(b) If the answer to Interrogatory No. 13(b), above, is other than an unqualified negative, identify each such communication to which that interrogatory refers.

(c) If the answer to Interrogatory No. 13(c), above, is other than an unqualified negative, identify each such instance where any person thought, assumed or otherwise indicated a belief that there is or may be an association between Applicant and Opposer and/or their respective products, services or businesses.

15. Identify each and every actual, present use of a trademark consisting of or containing the terms "BIG" or "BIGG" of which Applicant is aware and which Applicant contends is relevant to any of the claims and/or defenses in this proceeding, including for each such mark, the dates of usage(s) of such mark, the goods/services sold in connection with the mark, the identity of the party so using the mark, where (name and address) these goods/services can be found in the marketplace,

the identity of each individual having knowledge of such use and whether that knowledge is personal knowledge or information and belief.

16. Identify each objection, complaint, lawsuit, opposition, cancellation and other *inter partes* proceeding involving and/or with respect to, and/or in which Applicant asserted any rights in, Applicant's Mark.

17. State in detail each fact and all information (including, but not limited to, each witness with personal knowledge of same) and identify all documents which evidence(s) or support(s) Applicant's denials to the Notice of Opposition as stated in Applicant's Answer to Opposer's Notice of Opposition filed in this proceeding.

18. State in detail each fact and all information (including, but not limited to, each witness with personal knowledge of same) and identify all documents which evidence(s) or support(s) each of Applicant's Affirmative Defenses to the Notice of Opposition as stated in Applicant's Answer to Opposer's Notice of Opposition filed in this proceeding.

19. Identify each person who furnished any information on which any part of an answer to these interrogatories is based, indicating the parts based on information so furnished by such person, and whether such information is within the personal knowledge of such person, and if not within such personal knowledge, identify the source of the information so furnished.

20. Identify each expert witness who has been consulted and/or who may be called by Applicant to testify in this proceeding.

21. Identify each person whom Applicant has consulted with respect to the Answer to Notice of Opposition herein and/or with respect to the possibility of testifying herein, and for each, summarize the information such person has regarding the Applicant's claims and/or this Opposition.

22. Identify, by request number, each request in Opposer's First Request for Production of Documents served in this opposition for which (a) Applicant has not or will not produce any documents; and/or (b) there are no responsive documents in Applicant's possession, custody or control.

23. Identify all third parties who sell Applicant's products bearing Applicant's Mark and also sell tires; offer automotive repair and maintenance services; and/or sell automotive parts and accessories.

BIG O TIRES, INC.

By:



Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
(202) 638-6666

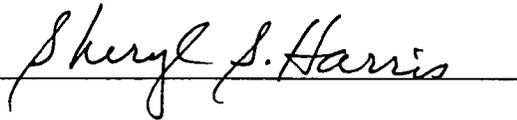
Dated: April 19, 2005  
Attorney Docket No.: I-5156

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 19<sup>th</sup> day of April, 2005, a true copy of the foregoing Opposer's First Set of Interrogatories was served by first-class mail, postage prepaid, upon counsel for Applicant:

Donald L. Otto, Esquire  
Warren A. Sklar, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

  
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# EXHIBIT B

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**

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

BIG O TIRES, INC.,	)	OPPOSITION No:	91163791
	)		
Opposer,	)	SERIAL No:	78/264,260
	)		
v.	)		
	)		
WHEEL SPECIALTIES, LTD.	)		
	)		
Applicant.	)		

**APPLICANT'S RESPONSE TO OPPOSER'S  
REQUESTS FOR ADMISSION**

Applicant hereby responds to Opposer's Requests for Admission as follows:

**REQUESTS FOR ADMISSION**

1. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s).

**RESPONSE**

Denied.

2. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's pleaded registrations.

**RESPONSE**

Denied.

3. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with tires.

**RESPONSE**

Denied.

4. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the goods listed in the pleaded registrations.

**RESPONSE**

Denied.

5. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the services listed in the pleaded registrations.

**RESPONSE**

Denied.

6. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of Opposer.

**RESPONSE**

Admitted.

7. Prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's stores.

**RESPONSE**

Admitted.

8. Prior to Applicant's selection of Applicant's Mark, Applicant visited one ore [sic] more of Opposer's stores.

**RESPONSE**

Admitted.

9. Prior to Applicant's selection of Applicant's Mark, Applicant visited Opposer's website.

**RESPONSE**

Denied.

10. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s).

**RESPONSE**

Admitted.

11. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's pleaded registrations.

**RESPONSE**

Admitted.

12. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with tires.

**RESPONSE**

Denied.

13. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the goods listed in the pleaded registrations.

**RESPONSE**

Denied.

14. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the services listed in the pleaded registration.

**RESPONSE**

Denied.

15. Prior to the filing of the opposed application, Applicant had actual knowledge of Opposer.

**RESPONSE**

Admitted.

16. Prior to the filing of the opposed application, Applicant had actual knowledge of one or more of Opposer's stores.

**RESPONSE**

Admitted.

17. Prior to the filing of the opposed application, Applicant visited one ore [sic] more of Opposer's stores.

**RESPONSE**

Admitted.

18. Prior to the filing of the opposed application, Applicant visited Opposer's website.

**RESPONSE**

Denied.

19. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s).

**RESPONSE**

Admitted.

20. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's pleaded registrations.

**RESPONSE**

Admitted.

21. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with tires.

**RESPONSE**

Denied.

22. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the goods listed in the pleaded registrations.

**RESPONSE**

Denied.

23. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's Mark(s) as used in connection with the services listed in the pleaded registrations.

**RESPONSE**

Denied.

24. Prior to using Applicant's Mark, Applicant had actual knowledge of Opposer.

**RESPONSE**

Admitted.

25. Prior to using Applicant's Mark, Applicant had actual knowledge of one or more of Opposer's stores.

**RESPONSE**

Admitted.

26. Prior to using Applicant's Mark, Applicant visited one ore [sic] more of Opposer's stores.

**RESPONSE**

Admitted.

27. Prior to using Applicant's Mark, Applicant visited Opposer's website.

**RESPONSE**

Denied.

28. Applicant's BIGG WHEELS products are sold by third parties.

**RESPONSE**

Admitted.

29. Applicant's BIGG WHEELS products are sold on a website located at www.wheelworld662.com.

**RESPONSE**

Admitted.

30. Applicant's BIGG WHEELS products are sold on a website located at www.wheelworld662.com, with Applicant's consent.

**RESPONSE**

Admitted.

31. Applicant's BIGG WHEELS products have been sold on a website located at www.wheelworld662.com.

**RESPONSE**

Admitted.

32. Applicant's BIGG WHEELS products have been sold on a website located at www.wheelworld662.com, with Applicant's consent.

**RESPONSE**

Admitted.

33. Attached hereto as Exhibit A is a true and correct copy of a partial printout from the website located at www.wheelworld662.com, as of or about April 18, 2005 concerning the BIGG WHEELS products.

**RESPONSE**

Denied. Applicant does not know whether Exhibit A is a true and correct copy of what appeared on that website as of the date specified in this request.

34. Applicant's BIGG WHEELS products are sold on a website located at [www.rimfinancing.com](http://www.rimfinancing.com).

**RESPONSE**

Admitted.

35. Applicant's BIGG WHEELS products are sold on a website located at [www.rimfinancing.com](http://www.rimfinancing.com), with Applicant's consent.

**RESPONSE**

Admitted.

36. Applicant's BIGG WHEELS products have been sold on a website located at [www.rimfinancing.com](http://www.rimfinancing.com).

**RESPONSE**

Admitted.

37. Applicant's BIGG WHEELS products have been sold on a website located at [www.rimfinancing.com](http://www.rimfinancing.com), with Applicant's consent.

**RESPONSE**

Admitted.

38. Attached hereto as Exhibit B is a true and correct copy of a partial printout from the website located at [www.rimfinancing.com](http://www.rimfinancing.com), as of or about April 18, 2005.

**RESPONSE**

Denied. Applicant does not know whether Exhibit B is a true and correct copy of what appeared on that website as of the date specified in this request.

39. The website located at [www.rimfinancing.com](http://www.rimfinancing.com) sells wheels.

**RESPONSE**

Admitted.

40. The website located at [www.rimfinancing.com](http://www.rimfinancing.com) lists "BIGG" as hyperlinked text.

**RESPONSE**

Admitted.

41. By clicking on the hyper-linked text of "BIGG", a visitor is transferred to a website locate *[sic]* at <http://aaron-katzman.com/wheels-rims-tires/2004BIGG.htm>.

**RESPONSE**

Admitted.

42. Attached hereto as Exhibit C is a true and correct copy of a partial printout from the website located at <http://aaron-katzman.com/wheels-rims-tires/2004BIGG.htm>, as of or about April 18, 2005.

**RESPONSE**

Denied. Applicant does not know whether Exhibit C is a true and correct copy of what appeared on that website as of the date specified in this request.

43. Applicant's *[sic]* has promoted its wheels under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Admitted.

44. Applicant promotes its wheels under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Denied.

45. Applicant's wheels have been promoted under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Admitted.

46. Applicant's wheels are promoted under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Denied.

47. Applicant has sold its wheels branded with the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Admitted.

48. Applicant sells its wheels branded with the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Denied.

49. Applicant's wheels have been sold under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Admitted.

50. Applicant's wheels are sold under the single word mark "BIGG" (*i.e.*, without the word "WHEELS").

**RESPONSE**

Denied.

51. Opposer sells tires in connection with Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is vague and ambiguous. Opposer has not identified which of Opposer's Marks in connection with which Opposer sells tires.

52. Opposer sells wheels at its BIG O stores.

**RESPONSE**

Admitted.

53. Opposer installs wheels at its BIG O stores.

**RESPONSE**

Admitted.

54. Opposer promotes wheels at its Internet website.

**RESPONSE**

Admitted.

55. Opposer sells the goods listed in its pleaded registrations in connection with Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is vague and ambiguous. Opposer has not identified which of Opposer's Marks in connection with which Opposer sells the goods listed in its pleaded registrations.

56. Opposer sells tires in the automotive aftermarket in connection with Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is vague and ambiguous. Opposer has not identified which of Opposer's Marks in connection with which Opposer sells tires in the automotive market.

57. Opposer's Mark is well-known in the United States.

**RESPONSE**

Denied.

58. Opposer's Mark is famous in the United States.

**RESPONSE**

Denied.

59. Opposer's Mark is well-known in the United States automotive market.

**RESPONSE**

Denied.

60. Opposer's Mark is famous in the United States automotive market.

**RESPONSE**

Denied.

61. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIG" in connection with tires (other than markets involved in this proceeding).

**RESPONSE**

Denied.

62. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIGG" in connection with tires.

**RESPONSE**

Admitted.

63. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIG" in connection with wheels (other than marks involved in this proceeding).

**RESPONSE**

Admitted.

64. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIGG" in connection with wheels (other than marks involved in this proceeding).

**RESPONSE**

Admitted.

65. Applicant has no personal knowledge of the present, actual use of any trademark comprised in whole or in part of the term "BIG" in connection with vehicular services (other than marks involved in this proceeding).

**RESPONSE**

Denied.

66. Applicant does not possess any documents which support Applicant's First Affirmative Defense as pleaded at paragraph 13 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

67. Applicant is not aware of any evidence which supports Applicant's First Affirmative Defense as pleaded at paragraph 13 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

68. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's First Affirmative Defense as pleaded at paragraph 13 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted that Applicant has not as yet produced any such documents.

69. Applicant does not possess any documents which support Applicant's Second Affirmative Defense as pleaded at paragraph 14 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

70. Applicant is not aware of any evidence which supports Applicant's Second Affirmative Defense as pleaded at paragraph 14 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

71. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Second Affirmative Defense as pleaded at paragraph 14 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted that Applicant has not as yet produced any such documents.

72. Applicant does not possess any documents which support Applicant's Third Affirmative Defense as pleaded at paragraph 15 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

73. Applicant is not aware of any evidence which supports Applicant's Third Affirmative Defense as pleaded at paragraph 15 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

74. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Third Affirmative Defense as pleaded at paragraph 15 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted that Applicant has not as yet produced any such documents.

75. Applicant does not possess any documents which support Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

76. Applicant is not aware of any evidence which support's Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

77. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted that Applicant has not as yet produced any such documents.

78. Applicant does not possess any documents which support Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted.

79. Applicant is not aware of any evidence which supports Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted.

80. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted.

81. Applicant does not possess any documents which support Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

82. Applicant is not aware of any evidence which supports Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Denied.

83. Applicant has not produced any documents in response to Opposer's document requests which Support Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 of Applicant's Answer to Notice of Opposition.

**RESPONSE**

Admitted that Applicant has not as yet produced any such documents.

84. Applicant does not possess any documents which support Applicant's contention that "the term BIGG of applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG/O of the cited

registrations," as stated in Applicant's Reply to Office Action of December 4, 2003 filed in support of the opposed application.

**RESPONSE**

Denied.

85. Applicant is not aware of any evidence which supports Applicant's contention that "the term BIGG of applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG O of the cited registrations," as stated in Applicant's Reply to Office action of December 4, 2003 filed in support of the opposed application.

**RESPONSE**

Denied.

86. Applicant has not produced any documents in response to Opposer's document requests which support Applicant's contention that "the term BIGG of applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG/O of the cited registrations," as stated in Applicant's Reply to Office Action of December 4, 2003 filed in support of the opposed application.

**RESPONSE**

Admitted that Applicant has not as yet produced any such documents.

87. All documents produced by Applicant in response to Opposer's First Request for Production in this proceeding are genuine pursuant to the Federal Rules of Evidence.

**RESPONSE**

Admitted.

88. All documents produced by Applicant in response to Opposer's First Request for Production in this proceeding are part of the business records of Applicant kept in the normal course of Applicant's business.

**RESPONSE**

Denied.

89. All documents produced by Applicant in response to Opposer's First Request for Production in this proceeding are admissible as evidence in this proceeding under the Federal Rules of Evidence, subject to any objections of Applicant on the grounds of relevance.

**RESPONSE**

Admitted.

90. The goods listed in the opposed application are marketed and sold in the automotive aftermarket.

**RESPONSE**

Admitted.

91. The goods listed in the opposed application are marketed and sold in the automotive aftermarket under Applicant's Mark.

**RESPONSE**

Admitted.

92. Vehicle tires are marketed and sold in the automotive aftermarket.

**RESPONSE**

Admitted.

93. Vehicle wheels are marketed and sold in the automotive aftermarket.

**RESPONSE**

Admitted.

94. Opposer's tires are marketed and sold in the automotive aftermarket under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it markets and sells its tires under in the automotive aftermarket.

95. Vehicle tires are related to the goods listed in the Opposed Application.

**RESPONSE**

Denied.

96. Vehicle tires are similar to the goods listed in the Opposed Application.

**RESPONSE**

Denied.

97. The services listed in the pleaded registrations are related to the goods listed in the Opposed Application.

**RESPONSE**

Denied.

98. Vehicle tires are sold through similar channels of trade as vehicle wheels.

**RESPONSE**

Admitted.

99. After-market vehicle tires are sold through similar channels of trade as after-market vehicle wheels.

**RESPONSE**

Admitted.

100. The goods listed in the opposed Application are sold through similar channels of trade as Opposer sells its tires under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it sells its tires under.

101. The goods listed in the Opposed Application are sold through similar channels of trade as Opposer offers its services under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it offers its services under.

102. The goods listed in the Opposed Application are sold under Applicant's Mark through similar channels of trade as Opposer sells its tires under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it sells its tires under.

103. The goods listed in the Opposed Application are sold under Applicant's Mark through similar channels of trade as Opposer sells its goods under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it sells its goods under.

104. The goods listed in the Opposed Application are sold under Applicant's Mark through similar channels of trade as Opposer offers its services under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it offers its services under.

105. Applicant sells its goods under the opposed mark to the same general class of purchasers as Opposer sells its tires under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it sells its tires under.

106. Applicant sells its goods under the opposed mark to the same general class of purchasers as Opposer sells its goods under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it sells its goods under.

107. Applicant sells its goods under the opposed mark to the same general class of purchasers as Opposer offers its services under Opposer's Mark.

**RESPONSE**

Denied. Applicant objects to this request on the grounds that it is unduly vague and ambiguous. Opposer has not identified which of Opposer's Marks it offers its services under.

108. Purchasers of wheels for automobiles also purchase automobile tires.

**RESPONSE**

Admitted.

109. The mark of the opposed application is identical to Opposer's Mark.

**RESPONSE**

Denied.

110. The mark of the opposed application is similar to Opposer's Mark.

**RESPONSE**

Denied.

111. Purchasers of wheels for automobiles purchase such wheels from retail stores featuring automotive parts and accessories.

**RESPONSE**

Denied.

112. Purchasers of wheels for automobiles also purchase tires under Opposer's Mark.

**RESPONSE**

Denied.

113. The United States Patent and Trademark Office Examiner, who reviewed the opposed application, required Applicant to disclaim the word "WHEELS" in the opposed application.

**RESPONSE**

Admitted.

114. Applicant disclaimed the word "WHEELS" in the opposed application.

**RESPONSE**

Admitted.

115. The dominant portion of the BIGG WHEELS mark is the term "BIGG".

**RESPONSE**

Admitted.

116. In Applicant's promotional materials, the term BIGG is in a larger size lettering than the word "WHEELS".

**RESPONSE**

Admitted.

117. In the specimen Applicant submitted to the Trademark Examiner, the term BIGG is in a larger size lettering than the word "WHEELS".

**RESPONSE**

Admitted.

118. The term "BIGG" of Applicant's BIGG WHEELS mark appears on Applicant's products in a larger size lettering than the term "WHEELS".

**RESPONSE**

Admitted.

119. Retail outlets that sell Applicant's BIGG WHEELS products also sell tires.

**RESPONSE**

Denied.

120. At least some of the retail outlets that sell Applicant's BIGG WHEELS products also sell tires.

**RESPONSE**

Admitted.

121. Some third parties who sell Applicant's BIGG WHEEL products also provide tire-related automotive services.

**RESPONSE**

Admitted.

122. Some third parties who sell Applicant's BIGG WHEEL products also sell tires.

**RESPONSE**

Admitted.

123. Some third parties who sell Applicant's BIGG WHEEL products also provide automotive maintenance services.

**RESPONSE**

Admitted.

124. Some third parties who sell Applicant's BIGG WHEEL products also provide automotive repair services.

**RESPONSE**

Admitted.

125. Some third parties who sell Applicants BIGG WHEEL products also sell automotive parts.

**RESPONSE**

Admitted.

126. Some third parties who sell Applicant's BIGG WHEEL products also sell automotive accessories.

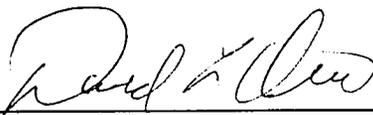
**RESPONSE**

Admitted.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.  
By Its Attorneys

Date: 5/24/05

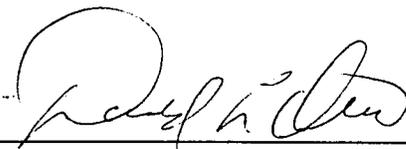
  
\_\_\_\_\_  
Donald L. Otto  
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1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191  
Phone: 216-621-1113  
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Attorneys for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S REQUESTS FOR ADMISSION was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 24<sup>th</sup> day of May, 2005.

Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004

  
\_\_\_\_\_  
Donald L. Otto

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

BIG O TIRES, INC.,	)	OPPOSITION No: 91163791
	)	
Opposer,	)	SERIAL No: 78/264,260
	)	
v.	)	
	)	
WHEEL SPECIALTIES, LTD.	)	
	)	
Applicant.	)	

**APPLICANT'S RESPONSE TO OPPOSER'S  
FIRST REQUEST FOR PRODUCTION OF DOCUMENTS**

Applicant hereby responds to Opposer's First Request for Production of Documents as follows:

**GENERAL OBJECTIONS/DEFINITIONS**

1. Applicant has not concluded its investigation into the facts relating to this proceeding, its formal discovery, or its preparation for the trial of this proceeding. These responses represent Applicant's reasonable effort to provide the information requested based upon information in its possession, custody or control, and based upon its current knowledge. Applicant reserves the right to produce information regarding subsequently discovered facts, to alter or amend its responses as set forth herein and otherwise to assert factual and legal contentions as additional facts are ascertained, analyses are made and legal research completed.

2. Applicant objects to these document requests insofar as they may be construed as limiting or restricting its right to rely upon any document or

information for any purpose whatsoever, including but not limited to the use of responsive documents or information as evidence in this proceeding.

3. Applicant also objects to these document requests to the extent that they do not contain any limitation on time or scope, making them overly broad.

4. Applicant also objects to producing each and every document responsive to these requests. Producing all documents responsive to these requests would be unduly burdensome.

5. To the extent that these document requests call for information which is protected by the attorney-client privilege, the work product doctrine, or is otherwise immune from discovery, Applicant objects to the production thereof.

6. To the extent that these document requests are overly broad or unduly burdensome or are directed to matters which are not relevant to the subject matter involved in this action or seek information not reasonably calculated to lead to the discovery of admissible evidence, such documents will not be produced.

7. To the extent that these document requests call for information which Applicant considers to be confidential or proprietary, and otherwise not immune from discovery, such documents will only be produced under a suitable Confidentiality Stipulation and Order entered into between the parties to this proceeding.

8. Applicant objects to these document requests to the extent that they seek information already known to Opposer or is available to Opposer from documents in its own files or from public sources.

9. Applicant further objects to Opposer's instructions and definitions to the extent that they seek to impose a duty on Applicant which exceeds the permissible scope of discovery under the Federal Rules of Civil Procedure.

10. Applicant's statement that responsive documents will be produced or will be made available for inspection and copying is not and should not be taken as an affirmative indication that responsive documents exist. Rather, the statement only indicates that if discoverable responsive documents do exist, they will be made available.

Each of the foregoing objections is applicable to all of the following responses and is incorporated herein.

### **REQUESTS FOR PRODUCTION**

1. The documents requested to be identified in Opposer's First Set of Interrogatories, served on Applicant concurrently herewith.

### **RESPONSE**

Applicant re-asserts the general objections made in these responses and the objections in Applicant's responses to Opposer's First Set of Interrogatories. Subject to and without waiving any objections, Applicant will produce any relevant non-privileged and/or non-confidential documents responsive to this request.

2. The documents referenced or identified by Applicant in response to Opposer's First Set of Interrogatories.

**RESPONSE**

Applicant re-asserts the general objections made in these responses and the objections in Applicant's responses to Opposer's First Set of Interrogatories. Subject to and without waiving any objections, Applicant will produce any relevant non-privileged and/or non-confidential documents responsive to this request.

3. All documents that constitute, contain, comment on, refer to, relate to, reflect, describe, and/or disclose, any consideration, proposal or decision to adopt and/or use Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

4. All documents which do, or may, support any claims or defenses of Applicant herein, and/or which Applicant believes would be admissible evidence on its behalf at the trial of this proceeding.

## **RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce copies of any non-privileged documents responsive to this request.

5. All documents which list, show, explain or describe each of the products sold and/or services offered by Applicant under Applicant's Mark and/or planned to be offered and/or sold under Applicant's Mark, including without limitation, each catalogue, brochure, or other printed materials or video/audio tapes.

## **RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce exemplary advertising and promotional materials identifying the products sold by Applicant under Applicant's Mark.

6. A sample (or if due to the physical size of same, in lieu thereof a photograph sufficiently legible to show the product and any writing or marks thereon) of each product sold and/or intended to be sold under Applicant's Mark, and each display, tag, label, warranty, insert, and any other material included

and/or intended to be included with such product when offered for sale, sold, and/or shipped in interstate commerce.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce documents sufficient to show the products sold or offered by Applicant under Applicant's Mark and any materials that may be included with such products.

7. A sample of each sign, brochure, handbill, stationery, advertisement, business card, identification card, display, pre-printed contract or form, decal, badge, label, and other advertising, promotional, and/or printed materials on which Applicant's Mark has been displayed or has appeared.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce exemplary documents responsive to this request.

8. All materials which have been produced, drafted, or proposed for use, including mock-ups for same, which display, refer or relate, in any way, to Applicant's Mark, whether or not such have ever been used, displayed, and/or disseminated.

## **RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information that constitutes confidential, proprietary information of the Applicant. Subject to and without waiving any objections, Applicant will produce exemplary documents responsive to this request.

9. A sample of each advertisement (including, but not limited to, television and/or radio commercials or spots) and promotional material (including, but not limited to audio and video tapes and CD's, Internet web site(s) and other material intended for viewing and/or listening by computer or other machine), bearing, mentioning or displaying Applicant's Mark and/or the products sold and/or offered for sale under Applicant's Mark.

## **RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce exemplary documents responsive to this request.

10. A specimen of each label, tag, nameplate, packaging and other material (including, but not limited to, packaging, warranty cards, instruction

sheets, promotional items, etc.) bearing, displaying and/or containing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce exemplary documents responsive to this request.

11. A sample of each and every document and thing bearing Applicant's Mark, or to which Applicant's Mark is affixed, whether or not such material ever has been used, distributed, disseminated, or displayed.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce exemplary documents responsive to this request.

12. Documents sufficient to show and/or identify each catalog, sales outlet, Internet web site or other electronic means, retail outlet, and wholesale outlet in which Applicant's services or goods are advertised, promoted, sold, offered for sale, and/or distributed under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that it seeks confidential, proprietary business information of the Applicant and is not relevant to the issues involved in this opposition and/or seeks information not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving any objections, Applicant refers Opposer to Applicant's response to Opposer's document requests Nos. 6-11 above and to interrogatory No. 6 of Opposer's First Set of Interrogatories.

13. All mailing lists and other lists of actual or potential customers, clients, sales representatives, brokers, dealers, and/or distributors of Applicant with respect to the products sold and/or to be sold in connection with Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome and is directed to matters which are not relevant to any issues involved in this opposition and/or seeks information not reasonably calculated to lead to the discovery of admissible evidence. Further, Applicant objects to this request on the ground that it seeks confidential, proprietary business information of the Applicant.

14. All documents which evidence, support, refer, or relate to Applicant's knowledge of Opposer's Mark, and/or to the circumstances under which such knowledge was obtained, including but not limited to all documents referring or relating to Opposer or Opposer's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents relating to Applicant's knowledge of Opposer's Mark prior to the institution of this proceeding.

15. All documents which evidence, support, or show the denials in Applicant's Answer related to the Notice of Opposition.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

16. All documents which were reviewed, consulted and/or relied upon by Applicant in making the denials in Applicant's Answer related to the Notice of Opposition.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

17. All documents which evidence, support, or show Applicant's First Affirmative Defense as pleaded at paragraph 13 in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

18. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's First Affirmative Defense in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

19. All documents which evidence, support, or show Applicant's Second Affirmative Defense as pleaded at paragraph 14 in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

20. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Second Affirmative Defense in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

21. All documents which evidence, support, or show Applicant's Third Affirmative Defense as pleaded at paragraph 15 in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

22. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Third Affirmative Defense in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

23. All documents which evidence, support, or show Applicant's Fourth Affirmative Defense as pleaded at paragraph 16 in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

24. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Fourth Affirmative Defense in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

25. All documents which evidence, support, or show Applicant's Fifth Affirmative Defense as pleaded at paragraph 17 in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

26. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Fifth Affirmative Defense in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

27. All documents which evidence, support, or show Applicant's Sixth Affirmative Defense as pleaded at paragraph 18 in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

28. All documents which were reviewed, consulted and/or relied upon by Applicant in pleading Applicant's Sixth Affirmative Defense in Applicant's Answer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

29. All documents which refer or relate to Opposer.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

30. All documents which refer or relate to Opposer's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to

this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

31. All documents which refer or relate to Opposer's products.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

32. All documents which refer or relate to Opposer's services.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

33. All documents which refer or relate to Opposer's stores.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

34. All documents which refer or relate to any of the registrations and application pleaded by Opposer in the Notice of Opposition.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

35. All documents which refer or relate to the circumstances under which Applicant first became aware of the actual or possible use of Opposer's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

36. All documents which evidence, relate or refer to the time Applicant first learned of Opposer

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

37. All documents which evidence, relate or refer to the time Applicant first learned of Opposer's BIG O stores.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

38. Documents sufficient to show Applicant's annual sales in numbers of units and in gross revenues, for products sold under Applicant's Mark, from the date of alleged first use of Applicant's Mark to the present.

**RESPONSE**

Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant and is not relevant to any issues involved in this proceeding or reasonably calculated to lead to the discovery of admissible evidence.

39. Documents sufficient to show Applicant's annual sales in numbers of units and in gross revenues, for services offered under Applicant's Mark, from the date of alleged first use of Applicant's Mark to the present.

**RESPONSE**

Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant and is not relevant to any issues involved in this proceeding or reasonably calculated to lead to the discovery of admissible evidence.

40. Documents sufficient to show or evidence Applicant's advertising expenditures in connection with Applicant's Mark and/or the products sold or services offered under Applicant's Mark, for each year from the date of alleged first use of Applicant's Mark through the present.

**RESPONSE**

Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant and is not relevant to any issues

involved in this proceeding or reasonably calculated to lead to the discovery of admissible evidence.

41. All documents relating and/or referring to the channels of trade through which services offered under, or products bearing, Applicant's Mark have been sold or are intended to be sold, including but not limited to documents describing the types of customers to whom Applicant advertises, promotes, and/or sells Applicant's products, and/or the retail and wholesale outlets in which Applicant's products in connection with Applicant's Mark are or have been used and/or sold.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks the identity of Applicant's actual customers on the grounds that this is confidential, proprietary business information of Applicant and is not relevant to any issues involved in this proceeding or reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving any objections, Applicant will produce documents sufficient to show the channels of trade through which Applicant's products bearing Applicant's Mark are sold.

42. All documents referring or relating to Applicant's Mark that have been filed with or received from any federal, state or local governmental office or

regulatory agency, including without limitation all documents filed in connection with efforts to obtain approval to offer any services or sell any products under Applicant's Mark, or to obtain registration of Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent it seeks information protected by the attorney/client privilege and/or attorney work product doctrine. Subject to and without waiving any objections, Applicant states that there are no documents responsive to this request other than the documents filed in connection with Applicant's U.S. Trademark Application No. 78/264,260 opposed herein.

43. All documents relied upon, either in whole or in part, as a basis for each opinion to be rendered by:

- (a) each expert witness that Applicant will or may call; and
- (b) each person from whom Applicant has obtained, or will obtain, statements or affidavits, or who is expected to give testimony in this case.

**RESPONSE**

Subject to and without waiving any objections, Applicant states there are no such documents responsive to this request

44. All documents constituting and/or comprising any opinion(s) and/or report(s) furnished by:

- (a) each expert witness that Applicant will or may call; and
- (b) each person from whom Applicant has obtained, or will obtain, statements or affidavits, or who is expected to give testimony in this case.

**RESPONSE**

Subject to and without waiving any objections, Applicant states there are no documents responsive to this request.

45. All documents which constitute, evidence, support, refer, or relate to any search (including but not limited to any trademark search reports), survey, poll, and/or investigation concerning, referring or relating to Opposer's Mark or any trademark comprised in whole or in part of the term "BIG", and/or to the products sold and/or offered under Opposer's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

46. All documents which constitute, evidence, support, refer, or relate to any search (including but not limited to any trademark search reports), survey, poll, and/or investigation concerning, referring or relating to Applicant's Mark or any trademark comprised in whole or in part of the term "BIGG", and/or to the products sold and/or offered (or intended to be sold and/or offered) under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

47. All documents referring or relating to any United States service mark and trademark registrations, or applications, issued to, or filed by, Applicant, for any mark incorporating "BIG" or "BIGG" alone or in combination with other words, letters, or symbols.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent it seeks information protected by the attorney-client privilege and/or attorney work product doctrine. Subject to and without waiving

any objections, Applicant states that there are no documents responsive to this request other than the documents filed in connection with Applicant's U.S. Trademark Application No. 78/264,260 opposed herein.

48. All documents which evidence, refer, or relate to the strength (as that term is used in determining likelihood of confusion) of Opposer's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

49. All documents which evidence, support, refer, or relate to any license, assignment, agreement, understanding, or other grant or transfer of rights referring or relating to Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant states there are no documents responsive to this request.

50. Each document reviewed, consulted, or on which Applicant relied, to draft its answers to Opposer's First Set of Interrogatories, served concurrently herewith.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

51. Each document reviewed, consulted, or on which Applicant relied, to draft its answers to Opposer's First Set of Requests for Admissions, served concurrently herewith.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

52. Each document which shows, evidences, or supports Applicant's responses to Opposer's First Requests for Admissions, served concurrently herewith.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

53. Each document which shows, evidences, or supports Applicant's responses to Opposer's First Set of Interrogatories, served concurrently herewith.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

54. Each document which shows, evidences, or supports that Applicant's Mark, as used in connection with Applicant's goods, is not likely to be confused with Opposer's Mark.

## **RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant will produce any non-privileged documents responsive to this request.

55. All marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by or for Applicant relating to its sale or proposed sale of products bearing, and/or in connection with which Applicant uses, Applicant's Mark.

## **RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant states there are no documents responsive to this request.

56. All marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by of for Applicant relating to its offer or proposed offer of services under and/or in connection with Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant states there are no documents responsive to this request.

57. All marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by or for Applicant relating to the offer or proposed offer of goods under and/or in connection with Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant states there are no documents responsive to this request.

58. If Applicant's response to any of the requests in Opposer's First Request for Admissions, served concurrently herewith, is anything other than an unqualified admission, for each such request, all documents which evidence, show and/or support the denial of such Request for admission, and/or Applicant's basis for Applicant's response to the Request for admission.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine.

59. A complete copy of each version of any web site linked to a domain name registered to Applicant, including but not limited to the HTML code for same, from the creation of the web site through the present.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome.

60. For each mark identified in response to Interrogatory Number 15, all documents which demonstrate, refer or relate to:

- a) the dates of usage(s) of such mark,
- b) the goods/services sold in connection with the mark,
- c) the identity of the party so using the mark, and
- d) where (name and address) these goods/services can be

found in the marketplace.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving

any objections, Applicant will produce any non-privileged documents responsive to this request.

61. Produce a copy of the certificate of registration for each trademark or service mark registration identified in response to Interrogatory Number 12.

**RESPONSE**

Subject to and without waiving any objections, Applicant will produce any documents responsive to this request.

62. All documents relating to the price of each of the goods sold or to be sold under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce documents sufficient to show the price of the goods sold under Applicant's Mark.

63. All documents relating to the price of the services offered or to be offered under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving

any objections, Applicant states there are no documents responsive to this request.

64. All documents relating to any objection, lawsuit, opposition proceeding, cancellation proceeding or other proceeding involving or relating to Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant states there are no documents responsive to this request other than documents relating to the instant opposition proceeding.

65. With respect to each product and/or service with which Applicant's Mark has been used, documents sufficient to show whether or not Applicant's use of the mark in connection with such product/service has been continuous.

**RESPONSE**

Applicant objects to this request on the grounds that it seeks information that constitutes confidential, proprietary business information of the Applicant. Subject to and without waiving any objections, Applicant will produce documents sufficient to show that Applicant's use of its mark has been continuous.

66. With respect to each product and/or service in connection with which Applicant's Mark has been used, all documents which evidence, refer, or relate to Applicant's first use in interstate commerce of Applicant's Mark in connection with each such product and/or service.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce documents sufficient to show its first use in interstate commerce of Applicant's Mark in connection with Applicant's product.

67. With respect to the earliest date on which Applicant will rely in this proceeding to establish Applicant's rights in Applicant's Mark, all documents which evidence, support, refer, or relate to such claim or rights in Applicant's Mark by Applicant as of that date.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant will produce documents sufficient to show the earliest date on which Applicant will rely in this proceeding to establish Applicant's rights in Applicant's Mark.

68. All documents that reflect, relate to or refer to any confusion as to origin, endorsement, approval or sponsorship of goods or services sold,

distributed or offered by Applicant under Applicant's Mark and/or by Opposer under Opposer's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant states it is not aware of any documents responsive to this request.

69. For each year in which products have been sold under Applicant's Mark, documents sufficient to identify each state where such product was sold.

**RESPONSE**

Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant and is not relevant to any issues involved in this proceeding or reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving any objections, Applicant states that Applicant intends to sell its product bearing Applicant's Mark throughout the United States.

70. Documents sufficient to identify all automotive-related entities that purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

71. Documents sufficient to identify all entities that sell tires and also purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

72. Documents sufficient to identify all entities that have sold tires and also purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

73. Documents sufficient to identify all entities that sell automotive parts and accessories and also purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

74. Documents sufficient to identify all entities that have sold automotive parts and accessories and also have purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

75. Documents sufficient to identify all entities that offer automotive repair and maintenance services and have purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

76. Documents sufficient to identify all entities that have offered automotive repair and maintenance services and have purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

77. Documents sufficient to identify all entities that offer tire-related automotive services and that have purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

78. Documents sufficient to identify all entities that have offered tire-related automotive services and that have purchased goods under Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

79. Documents sufficient to identify all automotive-related entities that sell Applicant's goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

80. Documents sufficient to identify all entities that sell tires and also sell Applicant's goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

81. Documents sufficient to identify all entities that have sold tires and also sold goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

82. Documents sufficient to identify all entities that sell automotive parts and accessories and also sold goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

83. Documents sufficient to identify all entities that have goods/automotive parts and accessories and also have sold goods hearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

84. Documents sufficient to identify all entities that offer automotive repair and maintenance services and have sold goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

85. Documents sufficient to identify all entities that have offered automotive repair and maintenance services and have sold goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

86. Documents sufficient to identify all entities that offer tire-related automotive services and that have sold goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

87. Documents sufficient to identify all entities that have offered tire-related automotive services and that have sold goods bearing Applicant's Mark.

**RESPONSE**

Applicant objects to this request on the grounds that it is over-broad and unduly burdensome. Further, Applicant objects to this request on the grounds that this is confidential, proprietary business information of the Applicant.

88. Documents sufficient to identify all goods sold by Applicant in the automotive industry.

**RESPONSE**

Subject to and without waiving any objections, Applicant will produce documents responsive to this request.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.  
By Its Attorneys

Date: 5/24/05



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Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 24<sup>th</sup> day of May, 2005.

Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004



Donald L. Otto

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

BIG O TIRES, INC.,	)	OPPOSITION No: 91163791
	)	
Opposer,	)	SERIAL No: 78/264,260
	)	
v.	)	
	)	
WHEEL SPECIALTIES, LTD.	)	
	)	
Applicant.	)	

**APPLICANT'S RESPONSE TO OPPOSER'S  
FIRST SET OF INTERROGATORIES**

Applicant hereby responds to Opposer's first set of interrogatories as follows:

**GENERAL OBJECTIONS/DEFINITIONS**

1. Applicant has not concluded its investigation into the facts relating to this proceeding, its formal discovery, or its preparation for the trial of this proceeding. These responses represent Applicant's reasonable effort to provide the information requested based upon information in its possession, custody or control, and based upon its current knowledge. Applicant reserves the right to produce information regarding subsequently discovered facts, to alter or amend its responses as set forth herein and otherwise to assert factual and legal contentions as additional facts are ascertained, analyses are made and legal research completed.

2. Applicant objects to these interrogatories insofar as they may be construed as limiting or restricting its right to rely upon any document or

information for any purpose whatsoever, including but not limited to the use of responsive documents or information as evidence in this proceeding.

3. Applicant also objects to these interrogatories to the extent that they do not contain any limitation on time or scope, making them overly broad.

4. Applicant also objects to identifying each and every document responsive to an interrogatory. Identifying all documents responsive to an interrogatory would be unduly burdensome. When indicated and in lieu of identifying documents, Applicant will either produce or make responsive documents available for inspection and copying, subject to the objections contained herein, in a manner authorized by applicable Federal Rules of Civil Procedure.

5. To the extent that these interrogatories call for information which is protected by the attorney-client privilege, the work product doctrine, or is otherwise immune from discovery, Applicant objects to the production thereof and such information will not be provided.

6. To the extent that these interrogatories are overly broad or unduly burdensome or are directed to matters which are not relevant to the subject matter involved in this action or seek information not reasonably calculated to lead to the discovery of admissible evidence, such information will not be provided.

7. To the extent that these interrogatories call for information which Applicant considers to be confidential or proprietary, and otherwise not immune from discovery, such information will only be provided under a suitable

Confidentiality Stipulation and Order entered into between the parties to this proceeding.

8. Applicant objects to these interrogatories to the extent that they seek information already known to Opposer or is available to Opposer from documents in its own files or from other public sources.

9. Applicant further objects to Opposer's instructions and definitions to the extent that they seek to impose a duty on Applicant which exceeds the permissible scope of discovery under the Federal Rules of Civil Procedure.

10. Applicant's statement that responsive documents will be produced or will be made available for inspection and copying is not and should not be taken as an affirmative indication that responsive information exists. Rather, the statement only indicates that if discoverable responsive information does exist, it will be made available.

Each of the foregoing objections is applicable to all of the following responses and is incorporated herein.

## INTERROGATORIES

1. State the earliest date on which Applicant will rely in this proceeding to establish any rights in Applicant's mark *vis-à-vis* Opposer, and state in detail the basis for Applicant's claim of rights in Applicant's mark as of that date, including:

(a) a description of the manner of use of Applicant's mark as of that date (i.e., imprinted on the goods, on labels or tags for the goods, on packaging for the goods, in store displays, etc.);

(b) the identity of each person involved in any way in such use, including, but not limited to the identity of each witness who can testify on personal knowledge as to such use;

(c) the identification of each product and/or service in connection with which the mark was used on that date; and

(d) the identification of each document which evidences or supports such claim of use as of that date.

## RESPONSE

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant responds as follows:

As at present advised, the earliest date on which Applicant will rely in this proceeding to establish its rights in the mark BIGG WHEELS (hereafter "Applicant's Mark") are Applicant's June 18, 2003 application filing date and applicant's February 20, 2004 first use date of Applicant's Mark in commerce on

automobile and truck wheels. Mark Lamb, managing member of Applicant, has personal knowledge of such use. Exemplary documents evidencing such use will be produced.

2. Identify each product and/or service with which Applicant's mark has been used, and with respect to each such product and/or service identify:

(a) the period of time during which Applicant's mark has been used with said product and/or service (*i.e.*, the date of Applicant's first sale of the product bearing Applicant's mark to the date of Applicant's last sale);

(b) if the use was by a person other than Applicant, identify that person, and state in detail the basis upon which Applicant claims such use inures, or will inure, to its benefit;

(c) the sales, on an annual basis, in terms of dollar volume and units, of such product and/or service from the date of first use of Applicant's mark in connection with such product and/or service, through the present;

(d) each price charged and/or to be charged by and/or paid to Applicant for such products and/or service; and

(e) each state in which such product and/or service has been or is intended to be sold under or in connection with Applicant's mark.

**RESPONSE**

Applicant has used Applicant's Mark on automobile and truck wheels since February 20, 2004 to the present. Applicant intends to sell automobile and truck wheels bearing Applicant's Mark throughout the United States. Applicant

objects to identifying Applicant's sales and price information on the grounds that this is confidential, proprietary business information of the Applicant and is not relevant to the issues involved in this opposition or reasonably calculated to lead to the discovery of admissible evidence.

3. Identify each survey, search or other investigation conducted and/or obtained with respect to Opposer's Mark, Applicant's mark, the term "BIGG" or "BIG" as used as a trademark or part of a trademark, and/or the actual, potential, or intended market, and/or the actual, potential, or intended customers of, or consumers for, the goods to be offered for sale and/or sold under or in connection with any of Opposer's Mark and/or Applicant's mark.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this interrogatory on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine, or constitutes confidential, proprietary information of the Applicant. Subject to and without waiving any objections, Applicant states that no surveys were conducted and/or obtained and that no searches or other investigations were conducted and/or obtained with respect to Opposer's Mark.

4. (a) State the annual volume of advertising under and/or in connection with Applicant's mark in connection with the goods set forth in the opposed application for each year since such advertising commenced.

(b) Identify each medium in which Applicant's mark has been or is intended to be listed, advertised, promoted, offered for sale and/or sold, and/or in which the products sold under Applicant's mark have been listed, advertised, promoted, offered for sale and/or sold.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to providing the annual volume of advertising on the grounds that this is confidential, proprietary business information of the Applicant and is not relevant to the issues involved in this opposition or reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving any objections, Applicant states that Applicant has advertised the products sold under Applicant's Mark in the following mediums: automotive magazines, Applicant's web site, and Applicant's catalog. Also Applicant's products sold under Applicant's Mark are sometimes advertised by Applicant's customers.

5. Identify each broker, sales representative, licensee, franchisee, dealer, distributor, wholesaler, each retail outlet, trade show, catalog, and Internet web site and/or other electronic means, to and/or through which

Applicant's goods have been or are intended to be advertised, promoted, offered for sale, distributed and/or sold, under or in connection with Applicant's mark.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this interrogatory on the grounds that it seeks confidential, proprietary business information of the Applicant and is not relevant to the issues involved in this opposition and/or seeks information not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving any objections, Applicant states that Applicant only sells the products offered under Applicant's Mark to automotive retailers.

6. For each product and service in connection with which Applicant is using or intends to use Applicant's mark, identify, in detail, the channels of trade through which such products and/or services have been or are intended to be sold and/or rendered, including but not limited to a general description of the type of customers to whom Applicant does or intends to advertise, promote, and/or sell Applicant's products and/or services in connection with Applicant's mark.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad, and unduly burdensome. Subject to and without waiving any objections, Applicant states that Applicant only sells Applicant's products

under Applicant's Mark to automotive retailers who in turn sell Applicant's products to those individuals who want custom style wheels for their vehicles.

7. Identify each agreement, assignment, license, contract, consent grant, or transfer of rights which concerns, refers or relates to Applicant's mark and/or any rights in connection with such mark.

**RESPONSE**

There are no such documents.

8. Identify each person who participated in the selection, creation, and/or decision to adopt and/or to use Applicant's mark; and describe in detail the reasons for and/or relating to the selection and adoption of Applicant's mark.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad, and unduly burdensome. Subject to and without waiving any objections, Applicant states that Mark Lamb and Gordon Nicols, both members of the Applicant, participated in the selection, creation and decision to adopt and use Applicant's Mark to identify a line of Applicant's custom style wheels for automobiles and trucks and to distinguish Applicant's custom style wheel line from those of others.

9. (a) Identify all persons employed by Applicant, and/or persons affiliated with, or contracted by, Applicant, responsible for advertising Applicant's

mark and/or the goods/services sold or are intended to be sold under Applicant's mark (including but not limited to the designer of Applicant's Internet website(s)); and

(b) Identify the person(s) responsible for, or if there is no such person, with the most knowledge of, the marketing of goods and/or services offered for sale under or in connection with Applicant's mark. (As used in this interrogatory, the term "marketing" includes but is not limited to, the customers, channels of trade, and type(s) of outlets where such goods are or will be offered for sale and/or sold.)

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad, and unduly burdensome. Subject to and without waiving any objections, Applicant states that Mark Lamb, managing member of Applicant, is responsible for advertising and marketing of Applicant's products under Applicant's Mark.

10. (a) Identify the circumstances under which (including, but not limited to, the date) Applicant first became aware of Opposer's Mark, Opposer's stores, and/or Opposer; the actual or possible use in any manner by Opposer of Opposer's Mark; and/or any products sold or distributed, and/or services rendered, bearing any of Opposer's Mark.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Subject to and without waiving any objections, Applicant states that it first became aware of Opposer when Applicant first sold some vehicle wheels to Opposer in August 2002.

11. (a) Prior to the institution of the instant proceeding, did Applicant ever consider Opposer and/or Opposer's Mark with respect to and/or in connection with Applicant's mark and/or the products sold or to be sold under Applicant's mark or otherwise in connection with Applicant's business?

(b) If the response to sub-paragraph (a) of this interrogatory is other than an unqualified negative, state the date of such consideration, the action considered, and identify each person involved in, and communication related to, such consideration.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous, over-broad and unduly burdensome. Further, Applicant objects to this interrogatory on the grounds that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant states that the only time Applicant considered Opposer's Mark with respect to Applicant's Mark prior to the institution of the instant proceeding was when the Examining Attorney in the first Office Action of December 4, 2003 refused registration of Applicant's Mark

allegedly because of a likelihood of confusion with the marks in Opposer's U.S. Registration Nos. 0,933,415 (of the mark BIG-O), 1,611,160 (of the mark BIG O TIRES and design), and 2,411,926 (of the mark BIG O TIRES).

12. Identify each and every trademark and service mark registration you believe relevant to this Opposition proceeding, including for each, the reason(s) why you believe such to be relevant.

### **RESPONSE**

Applicant objects to this interrogatory to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine, and/or calls for disclosure of the mental impressions, conclusions, opinions or legal theories of Applicant's attorneys. Subject to and without waiving any objections, Applicant states that at least Registration Nos. 0,772,529, 1,388,039, 2,195,058, 2,580,562, 2,596,506 and 2,875,923 are relevant to this opposition in that they are all third party registrations of composite marks including the term "BIG" for goods and/or services related to those of the Applicant and/or the Opposer. This clearly demonstrates the relative weakness of composite marks including the term "BIG" and therefore such marks must be narrowly construed to be limited to the particular forms of the marks as a whole and the goods and/or services with which the marks are used. Also Registration No. 0,900,272 of the mark BIG WHEEL for tires is relevant in that although this registration expired on August 28, 1990, two of the Opposer's Marks, namely, BIG-O Registration No. 0,993,415 and BIG O TIRES and Design Registration

No. 1,616,160, were granted while Registration No. 0,900,272 was still in existence.

13. (a) Is Applicant aware of any instance of confusion or mistake regarding it and Opposer, their respective goods, services, or businesses, and/or Applicant's mark and Opposer's Mark?

(b) Has Applicant received any communication addressed or directed to, or which mentions, refers or relates in any way to, Opposer, Opposer's Mark and/or Opposer's products/services?

(c) Is Applicant aware of any instance where any person thought, assumed or otherwise indicated a belief that there is or may be an association between Applicant and Opposer, Applicant's mark and Opposer's Mark, and/or the respective products or services or businesses of Applicant and Opposer?

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is vague, ambiguous and over-broad. Subject to and without waiving any objections, Applicant states that it is not aware of any such instance of confusion or mistake, has not received any communication addressed or directed to Opposer, and is not aware of any instance where any person thought, assumed or otherwise indicated such a belief.

14. (a) If the answer to Interrogatory No. 13(a), above, is other than an unqualified negative, identify each instance of confusion or mistake.

(b) If the answer to Interrogatory No. 13(b) above, is other than an unqualified negative, identify each such communication to which that interrogatory refers.

(c) If the answer to Interrogatory No. 13(c), above, is other than an unqualified negative, identify each such instance where any person thought, assumed or otherwise indicated a belief that there is may be an association between Applicant and Opposer and/or their respective products, services or businesses.

**RESPONSE**

See response to Interrogatory 13 above.

15. Identify each and every actual, present use of a trademark consisting of or containing the terms "BIG" or "BIGG" of which Applicant is aware and which Applicant contends is relevant to any of the claims and/or defenses in this proceeding, including for each such mark, the dates of usage(s) of such mark, the goods/services sold in connection with the mark, the identity of the party so using the mark, where (name and address) these goods/services can be found in the marketplace, the identity of each individual having knowledge of such use and whether that knowledge is personal knowledge or information and belief.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is over-broad and unduly burdensome. Also Applicant objects to this interrogatory to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine, and/or calls for disclosure of the mental impressions, conclusions, opinions or legal theories of Applicant's attorney concerning the opposition, or seeks to impose on Applicant a duty to prematurely marshal its proof, in contravention of Fed. R. Civ. P. 26(a)(3) and (b)(3). Subject to and without waiving any objections, Applicant states that it will produce documents showing third party uses of the term "BIG" in connection with goods and/or services related to those of the Applicant and/or the Opposer.

16. Identify each objection, complaint, lawsuit, opposition, cancellation and other *inter partes* proceeding involving and/or with respect to, and/or in which Applicant asserted any rights in, Applicant's Mark.

**RESPONSE**

None other than the present opposition proceeding.

17. State in detail each fact and all information (including, but not limited to, each witness with personal knowledge of same) and identify all documents which evidence(s) or support(s) Applicant's denials to the Notice of Opposition as stated in Applicant's Answer to Opposer's Notice of Opposition filed in this proceeding.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is over-broad and unduly burdensome. Applicant also objects to this interrogatory to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine, and/or calls for disclosure of the mental impressions, conclusions, opinions or legal theories of Applicant's attorneys concerning the opposition. Subject to and without waiving any objections, Applicant states that given the differences between Applicant's Mark as a whole as applied to its goods and Opposer's Marks as applied to its goods and/or services in sound, appearance and meaning and the various third party registrations and common law uses of composite marks including the term BIG for related goods/services, Applicant's Mark is sufficiently different from Opposer's Marks to avoid any likelihood of confusion.

18. State in detail each fact and all information (including, but not limited to, each witness with personal knowledge of same) and identify all documents which evidence(s) or support(s) each of Applicant's Affirmative Defenses to the Notice of Opposition as stated in Applicant's Answer to Opposer's Notice of Opposition filed in this proceeding.

**RESPONSE**

See response to Interrogatory 17 above.

19. Identify each person who furnished any information on which any part of an answer to these interrogatories is based, indicating the parts based on information so furnished by such person, and whether such information is within the personal knowledge of such person, and if not within such personal knowledge, identify the source of the information so furnished.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is over-broad and unduly burdensome. Applicant also objects to this interrogatory to the extent it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine, and/or calls for disclosure of the mental impressions, conclusions, opinions or legal theories of Applicant's attorneys concerning the opposition. Subject to and without waiving any objections Applicant states that Mark Lamb and Applicant's attorneys furnished information on which the responses to these interrogatories are based.

20. Identify each expert witness who has been consulted and/or who may be called by Applicant to testify in this proceeding.

**RESPONSE**

Applicant objects to this interrogatory to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Subject to and without waiving any objections, Applicant states that to date no expert witness has been consulted and Applicant has not determined whether it may call any expert witness to testify in this proceeding.

21. Identify each person whom Applicant has consulted with respect to the Answer to Notice of Opposition herein and/or with respect to the possibility of testifying herein, and for each, summarize the information such person has regarding the Applicant's claims and/or this Opposition.

**RESPONSE**

Applicant objects to this interrogatory to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine, and/or calls for disclosure of the mental impressions, conclusions, opinions or legal theories of Applicant's attorneys concerning the opposition. Subject to and without waiving any objections, Applicant states that it has not consulted anyone with respect to the Answer to the Notice of Opposition and/or with respect to the possibility of testifying herein.

22. Identify, by request number, each request in Opposer's First Request for Production of Documents served in this opposition for which (a) Applicant has not or will not produce any documents; and/or (b) there are no responsive documents in Applicant's possession, custody or control.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is over-broad and unduly burdensome. Subject to and without waiving any objections, see Applicant's Response to Opposer's First Request for Production of Documents.

23. Identify all third parties who sell Applicant's products bearing Applicant's Mark and also sell tires; offer automotive repair and maintenance services; and/or sell automotive parts and accessories.

**RESPONSE**

Applicant objects to this interrogatory on the grounds that it is over-broad and unduly burdensome and seeks confidential, proprietary business information of the Applicant. Subject to and without waiving any objections, Applicant states that a majority of Applicant's customers who sell Applicant's products bearing Applicant's Mark also sell tires, and/or offer automobile repair and maintenance services, and/or sell automotive parts and accessories.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.

(As to Objections)

By Its Attorneys

Date:

5/24/05



Donald L. Otto

Warren A. Sklar

RENNER, OTTO, BOISSELLE & SKLAR, LLP

1621 Euclid Avenue

Nineteenth Floor

Cleveland, Ohio 44115-2191

Phone: 216-621-1113

Fax: 216-621-6165

Attorneys for Applicant

**VERIFICATION**

I, Mark Lamb, declare:

I am managing member of Wheel Specialties, Ltd. (Applicant). I am authorized to execute this Verification on behalf of Applicant.

The foregoing Applicant's Response to Opposer's First Set of Interrogatories was prepared with the assistance and advice of counsel for Applicant, upon whose advice Applicant and I rely. Further, it was necessary to obtain information to prepare such responses from various sources, including records of Applicant. Accordingly, Applicant reserves the right to make changes in these Responses if it appears at any time that omission or errors have been made therein, or more accurate information is available.

Subject to the statements herein and above set forth, I declare under penalty of perjury that the foregoing Responses are true and correct.

Executed on May 18, 2005.

  
\_\_\_\_\_  
Mark Lamb

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S FIRST SET OF INTERROGATORIES was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 24<sup>th</sup> day of May, 2005.

Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004



Donald L. Otto

# EXHIBIT C

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**



Law Offices  
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September 26, 2005

Donald L. Otto, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

*Via Facsimile*  
(216) 621-6165  
Seven (7) pages  
Confirmation copy by mail

Re: Opposition No. 163,791  
Big O Tires, Inc. vs. Wheel Specialties, Ltd.  
BIGG WHEELS – Serial No. 78/264,260  
Our Reference: 11386/I-5156

Dear Mr. Otto:

After our review of Applicant's responses to Opposer's discovery requests, we have the following concerns.

Confidentiality

Applicant has refused to provide answers to certain requests and produce numerous documents on the basis of their confidential nature. Accordingly, we propose that the parties adopt the Board's Standard Order. Please advise if this is acceptable to Applicant.

General Comments on the Responses

Applicant seeks to interpose numerous objections to Opposer's interrogatories and document requests, covering the first three (3) pages of Applicant's responses (*e.g.*, "Each of the foregoing objections is applicable to all of the following responses and is incorporated herein."). This is improper since it does not put Opposer on notice as to the nature of the allegedly objectionable request or whether any response has been limited on the basis of any such objection. The objections should be withdrawn.

We now turn to Applicant's responses to specific discovery requests. The comments below are to be read in conjunction with appropriate discovery request and response. Moreover, the characterization of the discovery requests in this letter is not intended to, and does not, restrict the scope of the requests, as served.

# Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

Page 2

## Interrogatories

- No. 1: Interrogatory 1(a) is unanswered. Additionally, the "exemplary documents evidencing" use of Applicant's mark are not entirely legible. Please forward better copies.
- No. 2(c): Please confirm that Applicant will provide the requested information once a Protective Order is entered.
- No. 2(d): While Applicant objects to providing price information here, it agreed – without interposing a confidentiality objection – to "produce documents sufficient to show the price of the goods sold under Applicant's Mark." *See* document response no. 62. Please provide the requested information.
- No. 2(e): Please identify each state in which Applicant's products have been sold in connection with Applicant's mark.
- No. 3: Applicant's answer is deficiently narrow. For example, Applicant has not responded as to "searches or other investigations" related to Applicant's mark or the term(s) BIGG/BIG. Please supplement.
- No. 4(a): Please confirm that Applicant will provide the requested information once a Protective Order is entered.
- No. 4(b): This answer is insufficient as to Applicant's activities in light of Definition P. Additionally, please specify Applicant's customer's activities.
- No. 6: This answer is insufficient in light of Definition O; please supplement.
- No. 8: Please provide the business address, occupation and business position held for Messrs. Lamb and Nicols.
- Additionally, Applicant has not "describe[d] in detail" the reasons for selecting Applicant's BIGG WHEELS mark. Please supplement.
- No. 10: Please provide more information concerning the claimed Big O–Custom Wheel transaction of August, 2002 (*e.g.*, brand of vehicle wheels, *etc.*). *See* Definition K. The single document Applicant produced does not suffice. Please supplement.

# Jacobson Holman PLLC

Donald L. Otto, Esquire  
September 26, 2005  
Page 3

Applicant has not responded as to the circumstances under which it first became aware of Opposer's Mark, Opposer's stores, the actual or possible use of Opposer's Mark, and the goods and services bearing Opposer's Mark. We note that, at a minimum, Applicant was aware of, and visited, Opposer's stores before it selected Applicant's mark. *See* no. 7-8. Please supplement.

No. 11: The response is too limited. For example, Applicant has not responded as to its consideration of Opposer. Applicant has admitted that it had actual knowledge of Opposer prior to Applicant's selection of Applicant's mark. *See* response to admission request no. 6.

No. 12: Use of the limiting phrase "at least" in describing the relevant registrations is unacceptable. Please supplement with an identification of "each and every" such registration; failing which we will move to exclude any testimony or evidence which Applicant seeks to introduce at trial that is based on information responsive to this request.

No. 15: Applicant's answer refers to documents to be produced. As discussed during the oral hearing, this answer constitutes an improper use of Rule 33(d) of the Federal Rules of Civil Procedure. As an initial matter, the referenced documents are not Applicant's "business records." Moreover, the requested information is not found on the documents Applicant produced on August 22, 2005. Furthermore, the burden of deriving the requested information falls more heavily on Opposer. Thus, Opposer demands a written response to the interrogatory where all of the requested information is provided for each responsive mark – if Applicant does not know or does not have the requested information, it should so state.

No. 22: This interrogatory sought an identification of each request for which Applicant a) has not or will not produce documents; and b) there are no responsive documents. Applicant's reference to its responses to Opposer's document requests is not responsive. As an initial matter, Applicant's Objection No. 10 states that

Applicant's statement that responsive documents will be produced or will be made available for inspection and copying is not and should not be taken as an affirmative indication that responsive documents exist. Rather, the statement only indicates that if discoverable responsive documents do exist, they will be made available.

Donald L. Otto, Esquire

September 26, 2005

Page 4

Thus, this objection contradicts Applicant's apparent reliance on its responses to Opposer's document requests.

Moreover, use of the term "any" in many of Applicant's document responses – "Applicant will produce any relevant non-privileged and/or non-confidential documents responsive to this request" – further demonstrates the need for a written response to the interrogatory.

#### Admissions

Applicant denied several requests presumably because the term "Opposer's Marks" was not defined. *See e.g.*, response nos. 51, 55, 56, 94, 100 - 107. However, this term was defined. *See* Definition D in Opposer's First Set of Interrogatories, which was incorporated by reference into Opposer's First Set of Requests for Admission. Please supplement Applicant's answers.

Applicant admits that, prior to Applicant's selection of Applicant's mark, Applicant had actual knowledge of Opposer and Opposer's stores; and had visited one of Opposer's stores. *See* responses to nos. 6-8. Presumably, Applicant also had actual knowledge of Opposer's Mark, at least, "BIG O" and/or "BIG O TIRES" (no. 1) and use of the mark in connection with tires and automotive services (nos. 3-5, 12-14, and 21-23). Please amend.

We note that Applicant has mistyped the parenthetical of request no. 61 – it is not "(other than markets involved in this proceeding)" but rather "(other than marks involved in this proceeding)." Please amend.

Applicant admits that it possesses documents supporting Applicant's affirmative defenses, namely, Applicant's first, second, third, fourth, and sixth affirmative defenses (*see* nos. 66, 69, 72, 75 and 81). However, Applicant admits that it has not produced such documents (*see* nos. 68, 71, 74, 77, and 83). Similarly, Applicant admits that it possess documents supporting various contentions made in papers filed with the Trademark Office its Answer (*see* no. 84), but that such documents have not been produced (*see* nos. 86). All of these documents were requested, are responsive and must be produced immediately.

Please explain the basis for Applicant's denial of request nos. 95 and 96 that tires are not similar or related to wheels.

Donald L. Otto, Esquire

September 26, 2005

Page 5

Document Responses and Production

We received Applicant's document production (WSL00001 – WSL00249) under your cover letter of July 29, 2005. The production is quite limited and basically includes: a third party catalog, a single advertisement, excerpts from Applicant's website(s), a couple of invoices, the prosecution history of the opposed application, and, ostensibly, some Internet printouts of third party references. Please supplement Applicant's document production.

Additionally, we note that Applicant has failed to identify which documents are responsive to which document requests. As you know, the Trademark Rules require that a party producing documents by mail "organize and label them to correspond with the categories in the requests." See TBMP § 406.04(b). However, Applicant did not produce its documents in this fashion, but should do so now.

We now turn to Applicant's responses to Opposer's document requests, many of which are deficient on a number of grounds.

First, many responses do not state whether responsive documents exist or will be produced. See e.g. response nos. 1-4, 14 - 28, 35 - 37, 45-46, 48, 52-54, and 60-61. This is improper. See TBMP §406.04(b); see also, *No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (a proper response requires stating as to each request either that there are responsive documents and they will be produced [or withheld on a claim of privilege] or stating party has no responsive documents). Accordingly, Applicant must state as to each request whether it has responsive documents, whether it will produce them, and to then make the production.

In light of Applicant's improperly ambiguous responses and the quality of Applicant's document production, Opposer cannot now fully evaluate these responses and reserves the right to object to these responses once they are supplemented and/or additional documents produced.

- No. 3: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.
- No. 6: Applicant promised to produce documents sufficient to show Applicant's BIGG WHEELS products and any materials that may be included with such products. The latter documents were not produced. Please produce same. Additionally, the pictures are not legible enough to show "writings or marks thereon." Please produce legible photographs.
- No. 7: Applicant has only produced one magazine advertisement and one banner. This is insufficient; and Applicant should produce all of the requested documents.

# Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

Page 6

No. 9: Applicant has only produced one magazine advertisement, Internet prints out for two websites and one banner. This is insufficient; and Applicant should produce all of the requested documents.

No. 10: Despite Applicant's promise to produce exemplary documents responsive to this request, Applicant has not produced any such documents.

No. 11: *See* comments regarding no. 6.

No. 12: This response is insufficient.

No. 14: Applicant's response is limited to Applicant's knowledge of "Opposer's Mark." However, the request is not so limited, and includes "Opposer."

Additionally, please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

Nos. 29-34: Applicant has refused to respond to these requests or produce responsive documents on the basis of attorney-client privilege and/or attorney work product doctrine. At a minimum, any non-privileged documents should be produced immediately. We refer to our demand for a privilege log, above.

In order to test the very broad application of privilege asserted by Applicant, we request that you immediately identify any withheld documents.

Nos. 35-37: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

Nos. 36/7: Applicant has produced one document responsive to this request – an August 2002 invoice. Please advise whether there are other documents responsive to this request and produce them.

Nos. 38-40: We note Applicant's confidentiality and relevance objections to these requests. As to the latter, the requests are clearly relevant. Please confirm that Applicant will provide the requested documents once a Protective Order is entered.

Nos. 45/46: Despite Applicant's promise to "produce any non-privileged documents responsive to" the requests, it appears that no documents have been produced. Please state whether any responsive documents exist and whether they have been withheld on grounds of privilege. As you likely know, search reports are not privileged.

# Jacobson Holman PLLC

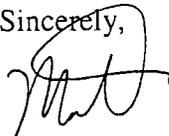
Donald L. Otto, Esquire  
September 26, 2005  
Page 7

- No. 47: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.
- No. 58: Applicant has refused to produce any documents in response to this request, which seeks documents that support Applicant's denials of Opposer's admission requests. Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine. In the meantime, Applicant should produce non-privileged documents. However, if Applicant is not producing any documents on the ground that the request is so "vague, ambiguous, over-broad and[or] unduly burdensome" that no response may be made or document produced, please explain to us the basis for this assertion
- No. 59: Please explain why no response is made or document produced in response to this request.
- No. 61. No documents have been produced to date.
- No. 62. No documents have been produced to date.
- No. 69. This request seeks documents which show each state in which Applicant's products have been sold under Applicant's mark. Applicant's answer that it *intends* to sell its products "throughout the United States" is not responsive. Please respond to the request *as stated* and produce responsive documents.
- Nos. 70-87: Please confirm that Applicant will provide the requested documents once a Protective Order is entered.

We look forward to Applicant's supplemental responses, document production and/or your comments.

In the meantime, we suggest that an extension request be filed to allow the parties time to resolve these issues, including the negotiation, execution, and entering of a Protective Order. Please call me to discuss.

Sincerely,



Matthew J. Cuccias

\* \* \* COMMUNICATION RESULT REPORT ( SEP. 26. 5 3:39PM ) \* \* \*

FAX HEADER: JACOBSON HOLMAN PLLC

TRANSMITTED/STORED : FILE MODE	SEP. 26. 2005 3:38PM OPTION	ADDRESS	RESULT	PAGE
896	MEMORY TX	12166216165	OK	7/7

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

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

**JH**  
P L L C

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September 26, 2005

Donald L. Otto, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

*Via Facsimile*  
(216) 621-6165  
Seven (7) pages  
Confirmation copy by mail

Re: Opposition No. 163,791  
Big O Tires, Inc. vs. Wheel Specialties, Ltd.  
BIGG WHEELS - Serial No. 78/264,260  
Our Reference: 11386/I-5156

Dear Mr. Otto:

After our review of Applicant's responses to Opposer's discovery requests, we have the following concerns.

Confidentiality

Applicant has refused to provide answers to certain requests and produce numerous documents on the basis of their confidential nature. Accordingly, we propose that the parties adopt the Board's Standard Order. Please advise if this is acceptable to Applicant.

General Comments on the Responses

Applicant seeks to interpose numerous objections to Opposer's interrogatories and document requests, covering the first three (3) pages of Applicant's responses (e.g., "Each of the foregoing objections is applicable to all of the following responses and is incorporated herein."). This is improper since it does not put Opposer on notice as to the nature of the allegedly objectionable request or whether any response has been limited on the basis of any such objection. The objections should be withdrawn.

We now turn to Applicant's responses to specific discovery requests. The comments below are to be read in conjunction with appropriate discovery request and response. Moreover, the characterization of the discovery requests in this letter is not intended to, and does not, restrict the scope of the requests, as served.

# EXHIBIT D

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**

## Matthew Cuccias

---

**From:** Matthew Cuccias [mcuccias@jhip.com]  
**Sent:** Wednesday, September 28, 2005 3:41 PM  
**To:** dotto@rennerotto.com  
**Cc:** Matthew J. Cuccias  
**Subject:** Big O v. Wheel Specialties, Ltd. (Your File No. WHEL.L0101; Our File No. I-5156)

Dear Mr. Otto:

I tried calling you today but only received your voicemail. Please call me to discuss the issues raised in my September 26, 2005 letter.

Regards,

Matthew

Matthew J. Cuccias, Esq.  
Jacobson Holmar, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004-2201  
(202) 638-6666x2260  
email: mcuccias@jhip.com

# EXHIBIT E

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**



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December 5, 2005

Donald L. Otto, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

Re: Opposition No. 163,791  
Big O Tires, Inc. vs. Wheel Specialties, Ltd.  
BIGG WHEELS – Serial No. 78/264,260  
Our Reference: 11386/I-5156

Dear Mr. Otto:

In order to address the confidentiality issues, we enclose a draft Protective Order based on the Trademark Trial and Appeal Board's Standard Protective Order. If this is acceptable to your client, please have it executed and forwarded to us for execution and filing with the Board.

Further to our September 26, 2005 correspondence regarding various discovery disputes, we continue to await the receipt of Applicant's supplemental discovery responses and/or substantive comments relating to our September 26, 2005 correspondence.

Cordially,

Matthew J. Cuccias

MGG/MJC  
Enclosure

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

BIG O TIRES, INC.,

Opposer,

vs.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**PROVISIONS FOR PROTECTING  
CONFIDENTIALITY OF INFORMATION  
REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

## TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

**Confidential** - Material to be shielded by the Board from public access.

**Highly Confidential** - Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

**Trade Secret/Commercially Sensitive** - Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

**Parties** and their attorneys shall have access to information designated as **confidential** or **highly confidential**, subject to any agreed exceptions.

**Outside counsel, but not in-house counsel**, shall have access to information designated as **trade secret/commercially sensitive**.

**Independent experts or consultants, non-party witnesses, and any other individual** not otherwise specifically covered by the terms of this order may be afforded access to **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall

be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction: Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare.**

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

**CONFIDENTIAL**

*This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.*

13) Acceptance of Information: Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Agreement of the Following, effective \_\_\_\_\_

[insert signature date]

BIG O TIRES, INC.

WHEEL SPECIALTIES, LTD.

\_\_\_\_\_  
Matthew J. Cuccias  
Jacobson Holman, PLLC  
400Seventh Street, N.W.  
Suite 600  
Washington, D.C. 20004-2218  
Counsel for Big O Tires, Inc.

\_\_\_\_\_  
Donald L. Otto, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191  
Counsel for Wheel Specialties, Ltd.

By order of the Board, effective \_\_\_\_\_.

\_\_\_\_\_  
[print or type name and title of Board attorney  
or judge imposing order]

# EXHIBIT F

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**



Law Offices  
**Jacobson Holman**  
Professional Limited Liability Company  
400 Seventh Street, N.W.  
Washington, D.C. 20004-2218

(202) 638-6666  
(202) 393-5350/51/52 (fax)  
www.jhip.com  
Firm e-mail: ip@jhip.com

**URGENT REMINDER**  
*January 3, 2006*

~~December 5, 2005~~

Donald L. Otto, Esquire  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115-2191

Re: Opposition No. 163,791  
Big O Tires, Inc. vs. Wheel Specialties, Ltd.  
BIGG WHEELS – Serial No. 78/264,260  
Our Reference: 11386/I-5156

Dear Mr. Otto:

In order to address the confidentiality issues, we enclose a draft Protective Order based on the Trademark Trial and Appeal Board's Standard Protective Order. If this is acceptable to your client, please have it executed and forwarded to us for execution and filing with the Board.

Further to our September 26, 2005 correspondence regarding various discovery disputes, we continue to await the receipt of Applicant's supplemental discovery responses and/or substantive comments relating to our September 26, 2005 correspondence.

Cordially,

Matthew J. Cuccias

MGG/MJC  
Enclosure

\* \* \* COMMUNICATION RESULT REPORT ( JAN. 3. 2006 7:20PM ) \* \* \*

FAX HEADER: JACOBSON HOLMAN PLLC

TRANSMITTED/STORED : FILE MODE	JAN. 3. 2006 OPTION	7:19PM ADDRESS	RESULT	PAGE
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 E-3) NO ANSWER  
 E-2) BUSY  
 E-4) NO FACSIMILE CONNECTION



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MGG/MJC  
 Enclosure

# EXHIBIT G

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

BIG O TIRES, INC.,

Opposer,

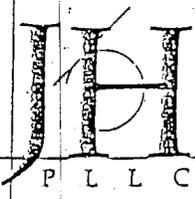
v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO COMPEL**



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~~URGENT REMINDER~~

~~January 3, 2006~~

~~December 5, 2005~~

**URGENT REMINDER**

**VIA FACSIMILE**

**(216) 621-6165**

**January 17, 2006**

Donald L. Otto, Esquire  
 RENNER, OTTO, BOISSELLE & SKLAR, LLP  
 1621 Euclid Avenue  
 Nineteenth Floor  
 Cleveland, Ohio 44115-2191

Re: Opposition No. 163,791  
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 Matthew J. Cuccias

MGG/MJC  
 Enclosure

\* \* \* COMMUNICATION RESULT REPORT ( JAN. 17. 2006 4:01PM ) \* \* \*

FAX HEADER: JACOBSON HOLMAN PLLC

TRANSMITTED/STORED : JAN. 17. 2006 3:55PM  
FILE MODE OPTION

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REASON FOR ERROR  
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~~URGENT REMINDER~~  
~~January 3, 2006~~  
~~December 5, 2005~~

**URGENT REMINDER**  
**VIA FACSIMILE**  
**(216) 621-6165**  
**January 17, 2006**

Donald L. Otto, Esquire  
 RENNER, OTTO, BOISSELLE & SKLAR, LLP  
 1621 Euclid Avenue  
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