

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.)		

TTAB

APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO COMPEL

Applicant, Wheel Specialties, Ltd., through its undersigned counsel, hereby responds to Opposer's Motion to Compel Applicant to serve amended and/or supplemental responses to Opposer's interrogatories, document requests and requests for admissions as follows:

I. Introduction

Opposer asserts in the Introduction and Background section of its Motion that Applicant will not engage in substantive discussions regarding alleged defects in Applicant's discovery responses. However, as explained below, Applicant tried to get Opposer to engage in substantive discussions regarding not only the discovery disputes asserted by Opposer but also those asserted by Applicant, and Opposer refused to do that.

Applicant timely served its discovery responses on May 24, 2005. Opposer's counsel did not inform Applicant's counsel of Opposer's concerns



02-21-2006

about Applicant's discovery responses until Applicant's counsel received Opposer's counsel's letter dated September 26, 2005 (attached hereto as Exhibit A), some four months after Applicant served its discovery responses.

On September 29, 2005 (within a few days after receiving Opposer's counsel's September 26, 2005 letter), Applicant's counsel phoned Opposer's counsel and asked him to send Applicant's counsel the Board's standard protective order with any changes Opposer's counsel thought might be appropriate. At the same time, Applicant's counsel told Opposer's counsel Applicant had many of the same issues with respect to Opposer's discovery responses. In fact, Applicant's counsel told Opposer's counsel that virtually none of the information requested by Applicant's discovery was provided. Also Applicant's counsel asked Opposer's counsel to let Applicant's counsel know when Opposer would send the documents Opposer promised to produce in Opposer's discovery responses. See copy of Applicant's counsel's handwritten notes of such telephone conference and typed copy thereof for clarity attached hereto as Exhibits B and B1, respectively.

Opposer's counsel did not send Applicant's counsel the draft protective order until December 5, 2005, more than two months after Opposer's counsel agreed to do so. See Opposer's counsel's letter dated December 5, 2005 attached hereto as Exhibit C.

Applicant's counsel signed and sent the protective order to Opposer's counsel along with a letter dated January 12, 2006 requesting Opposer's counsel to file it with the Board and send Applicant's counsel a fully executed copy with a

form of certification attached. A copy of such letter and signed protective order enclosed therewith are attached hereto as Exhibit D. In the same letter, Applicant's counsel again requested Opposer's counsel to send the documents Opposer promised to produce in its discovery responses. That was over a month ago, and Opposer's counsel has yet to inform Applicant's counsel that he signed and filed the protective order with the Board. Also Opposer has yet to produce the promised documents.

Applicant's counsel sent Applicant's document production to Opposer's counsel on July 29, 2005. See copy of Applicant's counsel's July 29, 2005 letter attached hereto as Exhibit E.

Opposer states on page 2 of its Motion that Applicant's document production was quite limited. However, Applicant's counsel states that Applicant made a good faith effort to produce the documents Applicant said it would in its discovery responses. Opposer, on the other hand, has yet to produce any of the promised documents, notwithstanding having received no less than four reminders from Applicant's counsel to do so.

Applicant's counsel's January 19, 2006 letter to Opposer's counsel, referred to in footnote 2 on page 4 of Opposer's Motion, did more than simply raise deficiencies in Opposer's discovery responses. In such letter, a copy of which is attached hereto as Exhibit F, Applicant's counsel once again reminded Opposer's counsel that Opposer has yet to produce the promised documents. Moreover, Applicant's counsel proposed in the last paragraph of such letter that before either party responds to the other's alleged discovery deficiencies, the

parties try to reach an agreement as to the extent to which the parties should supplement their responses so it isn't one sided. Also Applicant's counsel suggested that Opposer's counsel file a further sixty day extension request to give the parties time to resolve these issues. Instead of responding to Applicant's letter, Opposer went ahead with the filing of its Motion to Compel on January 30, 2006, one day after the close of discovery.¹

From the foregoing, Applicant submits Opposer is only interested in resolving alleged deficiencies in Applicant's discovery responses, not alleged deficiencies in Opposer's discovery responses. Accordingly, Applicant is proceeding with the filing of its own Motion to Compel discovery from Opposer.

II. **Applicant's Response to the Alleged Deficiencies in Applicant's Discovery Responses**

INTERROGATORIES

No. 1: Opposer complains that interrogatory 1(a) (a description of the manner of use of Applicant's mark) is unanswered. Admittedly many of the exemplary documents that Applicant produced do not show Applicant's entire mark as it appears on the goods. However, Applicant's production No. WSL00141 (which was included along with Applicant's amendment to allege use and is attached hereto as Exhibit H) clearly shows Applicant's mark imprinted on the goods. Accordingly,

¹ Opposer states on page 4 of its Motion that the discovery period closes "today" (i.e., January 30, 2006). However, the discovery period actually closed on January 29, 2006. See Motion for Extension of Discovery filed by Opposer on November 29, 2005 and the Board's Order granting the Motion attached hereto as Exhibit G.

Applicant submits it should not be required to supplement its response to this interrogatory.

- No. 2(e): Opposer complains that Applicant has not identified each state in which Applicant's products have been sold in connection with Applicant's mark. However, Applicant's response states that it intends to sell automobile and truck wheels bearing Applicant's mark throughout the United States. Applicant submits that this response should be sufficient.
- No. 3: Opposer seeks identification of "searches or other investigations" related to Applicant's mark or the term(s) BIGG/BIG. Applicant objected to this interrogatory on a claim of privilege. Applicant will supplement its response to this interrogatory by describing the nature of the withheld information in a privilege log.
- No. 4(b): Applicant objected to this interrogatory as being vague, ambiguous, overbroad and unduly burdensome. Applicant submits that Applicant's identification of each medium employed by Applicant is a sufficient response to this interrogatory. Also Applicant should not be required to specify Applicant's customers' activities about which Applicant has no specific knowledge or control.

- No. 8: Applicant will supplement its response by providing the business address(es), occupation(s), and business position(s) held by Messrs. Lamb and Nicols as requested in footnote 3 on page 5 of Opposer's Motion. However, Applicant states that its response to this interrogatory sets forth the reasons for selecting Applicant's mark.
- No. 10: Applicant states its response to this interrogatory provides all of the information Applicant has concerning when and how Applicant first became aware of Opposer.
- No. 11: Applicant stands by its response to this interrogatory.
- No. 12: The registrations identified in Applicant's response to this interrogatory are the ones that Applicant presently believes are relevant to this opposition. However, should Applicant subsequently become aware of any other relevant registrations, Applicant should not be prohibited from relying on any testimony or evidence which is based on information responsive to this interrogatory as requested by Opposer.²
- No. 15: Applicant will supplement its response to this interrogatory by identifying by production numbers those documents produced by

² For example, Applicant should not be prohibited from relying on any testimony or evidence based on information obtained from Opposer in response to Applicant's Interrogatory No. 12 (which Opposer has refused to provide but should be required to do so) regarding Opposer's knowledge of any past or present third party uses or registrations of any marks including "BIG" or "BIGG".

Applicant that show third party uses of the term "BIG" in connection with goods and/or services related to those of the Applicant and/or the Opposer. It is submitted that this supplemental response should be sufficient and should not prohibit Applicant from relying on any testimony or evidence which is based on information responsive to this interrogatory as requested by Opposer.

No. 22: Applicant stands by its response to this interrogatory.

ADMISSIONS

Nos. 51, 55, 56, 94, 100-107:

Opposer argues Applicant based its denials of these requests on the ground that the term "Opposer's Marks" was not defined, but since it was, these requests should be deemed admitted. However, the reason for their denial was not because the term "Opposer's Marks" was not defined, but because Opposer's definition of that term includes, in addition to all of the marks/applications/registrations pleaded in the Notice of Opposition, any other term incorporating "BIG" as used by or on behalf of Opposer. Since Opposer did not identify which of Opposer's Marks apply to these particular requests, Applicant submits that its denial of these requests based on Applicant's objection that these requests are vague and ambiguous is proper and therefore

these requests should not be deemed admitted as requested by
Opposer.

Nos. 1, 3-5, 12-14 and 21-23:

Opposer argues that because Applicant admits in response to Request Nos. 6-8 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, 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). However, merely because prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of Opposer and one or more of Opposer's stores and had visited one or more of Opposer's stores, that does not mean that prior to Applicant's selection of Applicant's Mark Applicant had actual knowledge of one or more of Opposer's Mark(s) or use of one or more of Opposer(s) Marks in connection with tires and automotive services. Therefore, Applicant's denials of these requests should stand.

DOCUMENT RESPONSES AND PRODUCTION

Opposer complains that many of Applicant's responses do not state whether responsive documents exist or will be produced. However, Applicant already produced the documents it promised to produce that are responsive to these requests, except for documents withheld on a claim of privilege. Accordingly,

Applicant will provide a privilege log for any documents withheld on a claim of privilege for request Nos. 3, 14, 17-28, 29-37, 45-47 and 58 as requested by Opposer on page 10 of its Motion. Also, Applicant will supplement its production by identifying by Applicant's production numbers the documents produced to correspond with the categories in the requests as requested by Opposer.

Opposer's assertion that Applicant intentionally has withheld non-privileged documents it possesses supporting Applicant's affirmative defenses and various contentions made in papers filed with the Trademark Office is not correct. These documents have been produced. The reason Applicant admitted in response to request Nos. 68, 71, 74, 77, 83 and 88 that Applicant has not as yet produced such documents is that these admissions were made prior to Applicant's document production.

No. 6: Applicant includes a limited structural warranty sheet with some of Applicant's products, which will be produced. Additionally, Applicant's document production No. WSL0014 is a copy of a photograph of one of Applicant's BIGG WHEELS products that is clearly legible enough to show writings or markings thereon. Therefore, Applicant should not be required to produce anything more in response to this request.

No. 7: Applicant produced representative samples of promotional items on which Applicant's Mark appears including a catalog (production Nos. WSL001-024), a flyer (WSL025), a banner (WSL030), Internet print-

outs for two web sites (WSL031-65 and 66-97), and a magazine advertisement (WSL99-100). Applicant submits this should be sufficient.

No. 9: The same documents that were produced in response to request No. 7 are responsive to this request and should be sufficient.

No. 10: The same documents that were produced in response to request No. 7 are responsive to this request except for the limited structural warranty sheet that is included with some of Applicant's Products, which will be produced.

No. 14: Applicant objected to this request as being vague, ambiguous, overbroad and unduly burdensome. Further, Applicant objected to this request to the extent that it seeks information protected by the attorney-client privilege and/or the attorney work product doctrine. Applicant stands by these objections. Additionally, Applicant produced documents production Nos. WSL142-169 and 113-125 relating to Applicant's knowledge of Opposer's Mark prior to the institution of this proceeding and production No. WSL102 relating to when Applicant first became aware of Opposer. Applicant submits that this should be sufficient.

Nos. 36/37: To Applicant's knowledge, the only document it has responsive to these requests was produced, namely, WSL production No. 102.

Nos. 45/46: Applicant will provide a privilege log identifying any documents withheld on a claim of privilege that are responsive to these requests.

No. 58: Applicant objected to this request as being vague, ambiguous, over-broad and unduly burdensome. Applicant stands by this objection. Applicant will provide a privilege log for any documents withheld on a claim of privilege that are responsive to this request. Request No. 59 has nothing to do with any of the issues in this proceeding. Therefore, Applicant stands by its objection to this request as being vague, ambiguous, over-broad and unduly burdensome.

No. 61: Applicant produced copies of these registrations (production Nos. WSL119-120, 124-125 and 177-197) obtained from the USPTO TARR System. It is submitted this should be sufficient and should not prohibit Applicant from relying on any testimony or evidence related thereto as requested by Opposer.

No. 62: Applicant already produced its 2005 price list (production Nos. WSL026-029) for Applicant's goods, which should be sufficient.

No. 69: Applicant stands by its objection that this request for documents which show each state in which Applicant's products have been sold under Applicant's Mark 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. Also Applicant's answer that it intends to sell its products bearing Applicant's Mark throughout the United States should be sufficient.

III. Conclusion

For the foregoing reasons, Applicant respectfully requests that the Board deny Opposer's Motion to Compel. Also Applicant respectfully requests that the Board deny Opposer's request that the discovery deadline be reset/extended in view of the fact that Opposer's request was filed on January 30, 2006, the day after the close of discovery on January 29, 2006.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.

By Its Attorneys



Date: February 17, 2006

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO COMPEL was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 17th day of February, 2006.

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



Donald L. Otto

CERTIFICATE OF MAILING

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

on February 17, 2006.



Donald L. Otto



Law Offices
Jacobson Holman
Professional Limited Liability Company
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Washington, D.C. 20004-2218

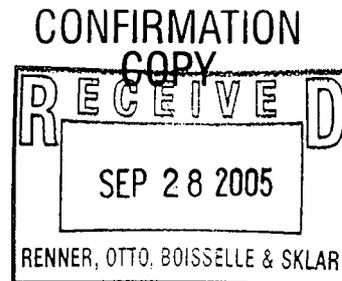
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September 26, 2005

Donald L. Otto, Esquire
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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.

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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.

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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.

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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.

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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.

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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

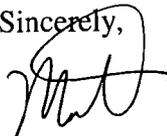
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- No. 47: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.
- No. 58: Applicant has refused to produce any documents in response to this request, 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



Tell copy Matthew Cuccini -

9/29/05

Re Big Wheels Matter -

- 1) He to ~~sample~~ consented
wishes to extend all discovery of
testimony periods and extend 60 days
- 2) He to send me a the bel's
suggested Protective Order for their
web site with any changes he
thinks might be appropriate -
- 3) What he does he will also
let me know what they
will be saying about their / all
road of protection and why so
they would produce -
- 4) I told him I had many of
the same issues with respect to
their responses to our discovery
requests - in fact virtually none of
the information we requested was
provided - also if they are going
to require a privilege log, we
are going to require that to provide
one as well. Matthew said they

was only requesting the log for
a few other deserving requests,
but they can provide as
I go as well if we are going to
request it -

Tel conf. Matthew Cuccias -
9/29/05

Re: Bigg Wheels Matter –

- 1) He to file a consented motion to extend all discovery & testimony periods an additional 60 days
- 2) He to send me a the Bd's suggested Protective Order from their web site with any changes he thinks might be appropriate –
- 3) When he does he will also let me know when they will be sending me their 1st round of production that they said they would produce –
- 4) I told him I had many of the same issues with respect to their responses to our discovery requests – in fact virtually none of the information we requested was provided – also if they are going to require a privilege log, we are going to require them to provide one as well. Matthew said they were only requesting the log for a few of the discovery requests, but they can provide a log as well if we are going to require it –

Tel conf. Matthew Cuccias -
9/29/05

Re: Bigg Wheels Matter –

- 1) He to file a consented motion to extend all discovery & testimony periods an additional 60 days
- 2) He to send me a the Bd's suggested Protective Order from their web site with any changes he thinks might be appropriate –
- 3) When he does he will also let me know when they will be sending me their 1st round of production that they said they would produce –
- 4) I told him I had many of the same issues with respect to their responses to our discovery requests – in fact virtually none of the information we requested was provided – also if they are going to require a privilege log, we are going to require them to provide one as well. Matthew said they were only requesting the log for a few of the discovery requests, but they can provide a log as well if we are going to require it –

Tel conf. Matthew Cuccias -
9/29/05

Re: Bigg Wheels Matter –

- 1) He to file a consented motion to extend all discovery & testimony periods an additional 60 days
- 2) He to send me a the Bd's suggested Protective Order from their web site with any changes he thinks might be appropriate –
- 3) When he does he will also let me know when they will be sending me their 1st round of production that they said they would produce –
- 4) I told him I had many of the same issues with respect to their responses to our discovery requests – in fact virtually none of the information we requested was provided – also if they are going to require a privilege log, we are going to require them to provide one as well. Matthew said they were only requesting the log for a few of the discovery requests, but they can provide a log as well if we are going to require it –



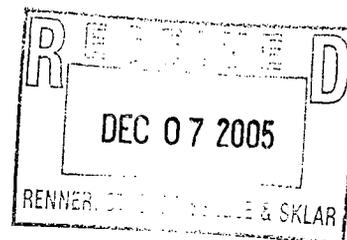
Law Offices
Jacobson Holman
Professional Limited Liability Company
400 Seventh Street, N.W.
Washington, D.C. 20004-2218

(202) 638-6666
(202) 393-5350/51/52 (fax)
www.jhip.com
Firm e-mail: ip@jhip.com

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

LAW OFFICES
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TEL: (216) 621-1113 FAX: (216) 621-6165
EMAIL: MAILROOM@RENNEROTTO.COM

January 12, 2006

Direct e-mail: dotto@rennerotto.com
Writer's direct dial: 216-736-3173

Matthew J. Cuccias, Esq.
Jacobson Holman
400 Seventh Street, N.W.
Washington, D. C. 20004-2218

Re: Opposition No. 163,791
Big O Tires, Inc. vs. Wheel Specialties, Ltd.
BIGG WHEELS - Serial No. 78/264,260
Your Ref: 11386/I-5156
Our Ref: WHEL.L0101

Dear Matthew:

The TTAB's standard Protective Order that accompanied your December 5, 2005 letter is acceptable. However, the form of certification referred to in section 4 of the Order as being attached was not included with your letter. Accordingly, please attach a copy to the enclosed signed Order before you sign and file it with the Board. Also please send me a fully executed copy of the Order with the form of certificate attached.

I will get back to you shortly regarding the various discovery disputes that you raised with respect to applicant's discovery responses as well as those I told you we also have with respect to opposer's discovery responses. Also this is a reminder that you have yet to send us the documents that opposer agreed to produce in its discovery responses. Please do so at this time.

Very truly yours,

Donald L. Otto

DLO:jm
enclosure
Z:\SEC177\WHELL101\CORRES\Cuccias-It1.wpd

**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]



LAW OFFICES
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE, NINETEENTH FLOOR
CLEVELAND, OHIO 44115-2191
TEL: (216) 621-1113 FAX: (216) 621-6165
EMAIL: MAILROOM@RENNEROTTO.COM

July 29, 2005

Direct e-mail: dotto@rennerotto.com
Writer's direct dial: 216-736-3173

Marsha G. Gentner, Esq.
Jacobson Holman PLLC
400 Seventh Street, NW
Washington, DC 20004

**Re: Big O Tires, Inc. v. Wheel Specialties, Ltd.
Opposition N^o 91163791
Our File WHEL.L0101**

Dear Ms. Gentner:

Enclosed are Applicant's First Set of Interrogatories and First Request for Production of Documents. Please provide us with Opposer's responses to these discovery requests within thirty days hereof pursuant to the Federal Rules of Civil Procedure.

Also enclosed are documents bearing Applicant's Production Nos. WSL 1-249 which are being produced in response to Opposer's First Request for Production of Documents.

Very truly yours,

Donald L. Otto

DLO:jm
enclosures
Z:\SEC177\WHELLL101\CORRES\Gentner-lt1.wpd

LAW OFFICES
RENNER, OTTO, BOISSELLE & SKLAR, LLP
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January 19, 2006

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Writer's direct dial: 216-736-3173

Matthew J. Cuccias, Esq.
Jacobson Holman
400 Seventh Street, N.W.
Washington, D. C. 20004-2218

Via Facsimile
202-393-5350
5 pages

**Re: Opposition No. 163,791
Big O Tires, Inc. vs. Wheel Specialties, Ltd.
BIGG WHEELS - Serial No. 78/264,260
Your Ref: 11386/I-5156
Our Ref: WHEL.L0101**

Dear Matthew:

As I advised you previously, many of Opposer's responses to Applicant's discovery requests are deficient for substantially the same reasons set forth in your September 26, 2005 letter concerning Applicant's responses to Opposer's discovery requests. In fact, very little of the information requested in Applicant's discovery requests was provided, and Opposer has yet to produce any of the requested documents.

We specifically call your attention to the following deficiencies in Opposer's responses to Applicant's interrogatories and document requests:

INTERROGATORIES

Number

2. Opposer agreed to produce a directory of Big O Stores but has yet to do so. Please produce.

4a and 4e. These responses are insufficient. Opposer did not identify which of Opposer's Marks is used on or in association with each product or service offered by Opposer as requested in 4a. Also Opposer did not give the inclusive dates during which Opposer has offered or sold each product or service under each of Opposer's Marks as requested in 4e. Please supplement.

4f. Opposer's agreement to produce documents from which Opposer's annual sales figures for a reasonable period may be derived or ascertained is not responsive to this interrogatory which requests the annual sales figures of each product or service identified in 4a from the date of first use of each of Opposer's Marks on or in association with each product or service. Please supplement.

6. This response is insufficient. In addition to providing a listing of all USPTO *inter partes* proceedings in which Opposer's Marks have been pleaded, please state the disposition or current status of each proceeding, and identify all documents relating thereto including particularly any settlements that may have been reached.

7. Opposer has objected to this interrogatory as seeking confidential and attorney-client privileged and/or attorney work product information and material of Opposer. Please provide sufficient identifying information for all documents responsive to this interrogatory.

12. Opposer's knowledge of any past or present third party uses or registrations of any names or marks including the term "BIG" or "BIGG" with respect to any goods or services marketed or sold in the automotive accessories, automotive repair services and automotive maintenance services is clearly relevant. To the extent that Opposer considers this information to be confidential, please provide such information under the agreed to protective order.

13. This response is inadequate. Applicant is entitled to know the factual basis for each of Opposer's allegations as stated in paragraphs 5-7 and 9-12 of Opposer's Notice of Opposition. Please supplement. Also please provide sufficient identifying information for all documents responsive to this interrogatory.

DOCUMENT REQUESTS

Number

1. This response is insufficient. In addition to providing representative samples of the current use of Opposer's Marks (which Opposer agreed to produce but has yet to do so), please produce documents sufficient to show Opposer's continuing use of each of Opposer's Marks at least since prior to Applicant's BIGG WHEELS trademark application filing date of June 18, 2003.
2. This response is too limited. Please produce all documents relating to any permission given by Opposer to any third party (not just franchisees of Opposer) to use a mark or trade name which Opposer considered or considers to be similar or identical to any of Opposer's Marks, including all documents permitting such use. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
3. This response is too limited. Please produce all documents relating to any permission given by Opposer to any third party (not just franchisees of Opposer) to use a trademark, service mark or trade name constituting or including the term "BIG" or "BIGG", including all documents permitting such use. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
4. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
5. This request is clearly relevant. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.
6. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

Matthew J. Cuccias, Esq.
January 19, 2006
Page 4

7. This response is insufficient. In addition to providing a listing of any action or proceeding in any court or other tribunal including but not limited to the USPTO filed by Opposer against a third party or filed by a third party against Opposer involving any of Opposer's Marks, please produce all documents relating to any settlements that may have been reached in any such action or proceeding. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

8.-11, 13 and 24. No documents have been produced to date. Please produce the documents Opposer already agreed to produce.

15, 17, 23, 25-31, 33-35 and 40. No documents have been produced to date. Please produce the documents Opposer already agreed to produce. If Opposer withholds any documents responsive to any of these requests, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

37. Please produce all documents responsive to this request. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

38. This response is too limited. Please produce all documents relating to any third party uses (not just franchisees of Opposer) of any trademark, service mark or trade name incorporating "BIG" or "BIGG" alone or in combination with other words, letters or symbols. If Opposer withholds any documents responsive to this request, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

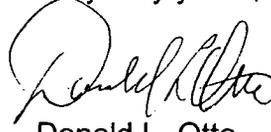
39 and 41. These requests are clearly relevant. Please produce all documents responsive to these requests. If Opposer withholds any documents responsive to these requests, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

42 and 43. Please produce all documents responsive to these requests. If Opposer withholds any documents responsive to these requests, please provide sufficient identifying information for any such withheld documents and the basis for withholding same.

Matthew J. Cuccias, Esq.
January 19, 2006
Page 5

I look forward to receiving Opposer's supplemental responses and document production. However, before either party responds to the other's additional requests, I suggest we try to reach an agreement as to the extent to which the parties need supplement their responses so it isn't one sided. Also I suggest that you file a further sixty day extension request to give us time to resolve these issues. Please let me know if you concur with that.

Very truly yours,

A handwritten signature in black ink, appearing to read "Donald L. Otto". The signature is written in a cursive style with a large initial "D".

Donald L. Otto

DLO:jm

Z:\SEC177\WHELL\101\CORRES\Cuccias-It2.wpd



ESTTA Tracking number: **ESTTA55383**

Filing date: **11/29/2005**

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

Proceeding.	91163791
Applicant	Plaintiff BIG O TIRES, INC. BIG O TIRES, INC. 12650 EAST BRIARWOOD AVENUE CENTENNIAL, CO 80112 UNITED STATES
Other Party	Defendant WHEEL SPECIALTIES, LTD. WHEEL SPECIALTIES, LTD. 2088 Center Ridge Road, Suite 100 Rocky River, OH 44116

Motion for an Extension of Discovery or Trial Periods With Consent

The Close of Discovery is currently set to close on 11/30/2005. BIG O TIRES, INC. requests that such date be extended for 60 days, or until 01/29/2006, and that all subsequent dates be reset accordingly. The grounds for this request are as follows:

- *The parties have been engaged in discussions directed to the resolution of certain discovery disputes.*

BIG O TIRES, INC. has secured the express consent of all other parties to this proceeding for the extension requested herein.

BIG O TIRES, INC. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Respectfully submitted,
/Matthew J. Cuccias/
Matthew J. Cuccias
mcuccias@jhip.com, tcaudle@jhip.com
dotto@rennerotto.com
11/29/2005

Don Otto

From: ESTTA@USPTO.GOV
Sent: Tuesday, November 29, 2005 5:46 PM
To: mcuccias@jhip.com; tcaudle@jhip.com; Don Otto
Subject: MOTION TO EXTEND GRANTED

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

November 29, 2005

PROCEEDING NO. 91163791

BIG O TIRES, INC.

v.

WHEEL SPECIALTIES, LTD.

MOTION TO EXTEND GRANTED

BIG O TIRES, INC.'s consent motion filed, Nov 29, 2005, to extend the discovery period until Jan 29, 2006, is granted. Accordingly, discovery and trial periods are reset as indicated below.

DISCOVERY PERIOD TO CLOSE: Jan 29, 2006

Thirty-day testimony period for party in position of plaintiff to close: Apr 29, 2006

Thirty-day testimony period for party in position of defendant to close: Jun 28, 2006

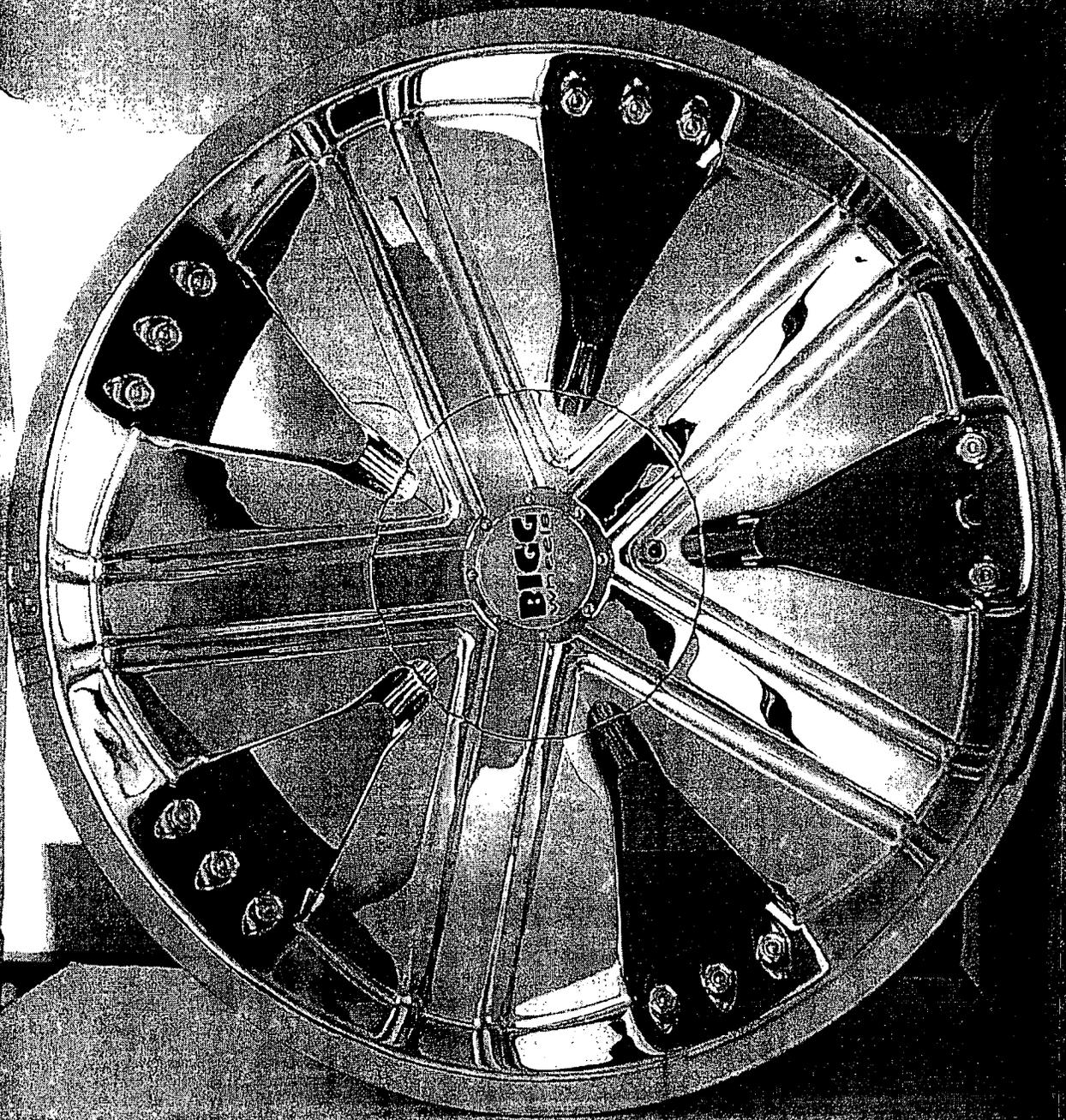
Fifteen-day rebuttal testimony period to close: Aug 12, 2006

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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

and Appeal Board

By the Trademark Trial



WSL00141