

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

BIG O TIRES, INC.,

Opposer,

v.

Opposition No. 91163791

WHEEL SPECIALTIES, LTD.,

Applicant.

OPPOSER'S BRIEF IN FURTHER SUPPORT OF ITS MOTION TO COMPEL

and

OPPOSER'S MOTION TO STRIKE APPLICANT'S UNTIMELY MOTION TO COMPEL

or, in the alternative,

OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S MOTION TO COMPEL

In response to the Motion to compel filed by Opposer Big O Tires, Inc. ("Opposer" or "Big O"), on January 30, 2006, Applicant Wheel Specialties, Ltd. ("Applicant" or "Wheel Specialties"), filed on February 17, 2006 two papers: Applicant's Response to Opposer's Motion to Compel ("Applicant's Response") and Applicant's Motion to Compel ("Applicant's Motion").

Big O now files this combined paper in which it respectfully requests that the Trademark Trial and Appeal Board ("Board") issue an Order striking Applicant's Motion as untimely. In the alternative, Big O seeks a denial of Applicant's Motion. Finally, Big O submits its Reply brief in further support of its Motion to compel. Each issue separately will be set forth below.

These papers collectively evince Applicant's bad faith. Not only has Applicant refused to respond to Opposer's repeated attempts to resolve Opposer's concerns with Applicant's discovery



03-09-2006

responses; and in its lack of engaging in good faith efforts before bringing its discovery motion – in retaliation for Opposer’s discovery motion, but the papers filed by Applicant (*e.g.*, Applicant’s Response and Applicant’s Motion) do not even bother to explain why Applicant should not respond, or why Opposer should respond, to a particular request. Applicant just states it in conclusionary terms.

**I. OPPOSER’S MOTION TO COMPEL SHOULD BE GRANTED.**

Remarkably, Applicant attempts to contest its inaction in addressing the discovery issues Opposer raised four (4) months before Big O filed its Motion to compel. In relevant part, Applicant’s Response states that “Applicant tried to get Opposer to engage in substantive discussions regarding not only the discovery disputes asserted by Opposer . . . and Opposer refused to do that.” *See* Applicant’s Response, p. 1. However, Applicant does not – and cannot – point to a letter or a telephone conference in which it substantively addressed Opposer’s long lingering discovery issues, because there were none. Indeed, the only “effort” made by Applicant , after Opposer’s months long, numerous and repeated urgings, was an eleventh hour *non*-effort in which Applicant *again* failed to address Opposer’s aging discovery issues, *again* promised to address them sometime in the future, and sought yet *another* extension request for the purpose of addressing discovery issues raised four (4) months earlier. A party is not required to wait indefinitely for the opposing party’s position on discovery disputes; and in this case Opposer waited four (4) months.

Additionally, the extent of Applicant's defense of its position in various discovery requests is to simply regurgitate a list of its originally interposed objections and then to claim, in conclusionary terms, that the original response is sufficient. This, of course, is tantamount to a non-response, and Applicant should be deemed to have conceded to Opposer's position on such requests. It is incumbent upon the party asserting the objection to establish that the grounds for such objection exist, not *vice versa*. Therefore, with respect to interrogatory nos. 4(b)<sup>1</sup> and document request nos. 14 and 58<sup>2</sup>, the Motion to compel should be granted.<sup>3</sup>

Finally, Applicant's Response promised to produce and/or disclose various documents and information. However, to date, Opposer has received no such supplementation.

#### INTERROGATORIES

No. 1(a): Applicant did not answer Interrogatory 1(a), which seeks a description of the manner of use of Applicant's mark as of the earliest date of use. Applicant now claims that one of the many documents it produced provides the information. However, as an initial matter, the answer does not rely on Rule 33(d) of the Federal Rules of Civil

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<sup>1</sup> Additionally, in responding to this interrogatory, Applicant raised, *sua sponte*, its customer's promotional activities; however, it refuses to provide any details since "Applicant should not be required to specify Applicant's customers' activities about which Applicant has no specific knowledge or control." As an initial matter, Applicant cannot have it both ways – relying on its customers' activities in responding to an interrogatory, but refusing to provide any information. Moreover, if Applicant has "no specific knowledge" of such activities, then there was no factual basis for its initial answer. The issue of "control" is irrelevant to the inquiry. Applicant should provide the information.

<sup>2</sup> Additionally, Applicant continues to – but does not explain why – it limits its answer to Applicant's knowledge of "Opposer's Mark", despite the explicit request for documents 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.

<sup>3</sup> Similarly without any explanation, Applicant simply "stands by" its answer to interrogatory no. 22, which should be deemed conceded.

Procedure (and it is not clear that the produced document is a “business record”). More importantly, however, document WSL00141 is not dated and there is no way to know if this is the manner of *use as of the earliest date of use*.

No. 2(e): Since Applicant refuses to identify each state in which Applicant’s products have been sold in connection with Applicant’s mark, Applicant should be precluded from relying on any evidence/testimony at trial concerning the geographic use of the parties’ respective marks.

No 3: This interrogatory sought an identification of surveys, searches or other investigations. Applicant refuses to respond as to “searches or other investigations” related to Applicant’s mark or the term(s) BIGG/BIG, claiming that such information is protected by a privilege. Applicant asserts that it will “describ[e] the nature of the withheld information in a privilege log.” As an initial matter, the promised privilege log has not yet been produced. More to the point, however, the mere identification of a search report is not privileged. *See* TBMP §414(6)(“Search reports are discoverable . . . .”); *cf* §414(1)(“The identification of discovery documents . . . is not privileged or confidential”). Applicant should respond completely.

No. 8: Applicant has not “describe[d] in detail” the reasons for selecting Applicant’s BIGG WHEELS mark – the answer is a definition of the function of a trademark, not a detailed reason why this particular mark was chosen for the particular goods.

Moreover, while Applicant's Response *promises* to provide the most basic information about Applicant's principals (e.g., business address, occupations, and positions held), it still has not done so. Therefore, Opposer respectfully requests that the requirement to do so be included in any Order issued by the Board.

No. 10: Applicant refuses to provide more information concerning the claimed Big O–Custom Wheel transaction of August, 2002, pursuant to Definition K; and cannot rely on the single document Applicant produced. For example, the document does not identify the brand of vehicle wheels, or the involved sales person(s), as well as others with knowledge of said activity. A complete, written response is required.

Applicant's interrogatory answer failed to respond to – and Applicant's Response ignored – the inquiry as to the circumstances under which Applicant 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. This continued failure is problematic, especially since 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's interrogatory answer did not respond to – and Applicant's Response wholly ignored – the inquiry concerning Applicant's 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: Applicant has clarified its use of the limiting phrase "at least" in identifying the responsive registrations, by stating that it may learn of other registrations. However, Applicant should be precluded from relying on any registrations which were not promptly disclosed in discovery.

No. 15: In responding to this interrogatory, which sought an identification of certain third party marks, Applicant simply referred to documents to be produced. Applicant's Response *promises* to supplement its response by identifying the documents. Of course, despite Applicant's promise no such identification has occurred to date.

Moreover, as discussed during the oral hearing, and in Big O's Motion to compel, this answer constitutes an improper use of Rule 33(d) of the Federal Rules of Civil Procedure. Since Applicant has refused to respond to this interrogatory, it should be prohibited from relying on any testimony or evidence which is based on information responsive to this interrogatory.

#### ADMISSIONS<sup>4</sup>

Applicant's Response indicates that Applicant denied several requests, *see e.g.*, response nos. 51, 55, 56, 94, 100 - 107, because the term "Opposer's Marks," as defined, was "vague and ambiguous." *See* Applicant's Response, p.7. Interestingly, the term "Opposer's Marks" – as defined – appears throughout Opposer's written discovery; and yet Applicant responded to those requests. Opposer respectfully submits that the disputed term is sufficiently clear, and the requests should be deemed admitted.

Applicant's Response argues that just because, 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, this does not mean that Applicant also had actual knowledge of Opposer's Mark (even "BIG O" and/or "BIG O TIRES") (no. 1) or use of the mark in connection with tires and automotive services (nos. 3-5, 12-14, and 21-23). Applicant does not attempt to explain this seemingly self-contradictory observation, and none come to mind. Accordingly, these responses should be deemed admitted.

#### **DOCUMENT RESPONSES AND PRODUCTION**

Applicant promised it will supplement its production by identifying documents produced in response to certain requests; but has not yet done so. In any event, while a good first step, this is not sufficient since Applicant is obligated to state *with regard to each request* whether responsive documents exist and were (or will be) produced. Accordingly, Applicant should be compelled to:

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<sup>4</sup> Applicant has not clarified its position on the mistyped parenthetical of request no. 61, but should be compelled to do so in any supplemental responses Applicant serves.

state as to each request whether it has responsive documents, whether it will produce them, and to then make the production; and to properly identify which documents are responsive to which document requests.

In response to Big O's Motion to compel, Applicant has promised to provide a privilege log, but has failed to do so. Accordingly, Applicant should be compelled to provide, for request nos. 3, 14, 17-28, 29-37, 45-47, 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: If Applicant produces the limited structural warranty sheet it promised to do in Applicant's Response, Opposer will be satisfied.

No. 10: Applicant's Response claims that its response to request no. 7 is responsive to this request (other than a warranty sheet). However, that would mean that Applicant's products are sold without any product packaging, and does not include any other inserts. Also, while Applicant's Response has promised to produce a warranty sheet, it has failed to do so.<sup>5</sup>

Nos. 36/7 Opposer is satisfied with Applicant's Response to these requests.

Nos. 45/46: Applicant has promised to provide a privilege log (but has failed to do so) in lieu of producing documents. Applicant should be compelled to provide a privilege log *in*

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<sup>5</sup> Applicant has ignored Opposer's Motion to compel as it relates to Request No. 12.

*addition to non-privileged documents, such as search reports. See e.g., TBMP §414(6) (“Search reports are discoverable . . .”).*

No. 59: Applicant’s Response claims that this request has “nothing to do with any of the issues in this proceeding.” This would appear to be an objection challenging the “relevance” of the request – an objection *not* timely interposed by Applicant, and, accordingly, waived. In any event, the request is clearly relevant since Applicant has promoted its BIGG WHEELS products on the Internet.

No. 61. Applicant has not produced any certificates of registration for the marks identified in response to Interrogatory No. 12, but only a handful of (partially illegible) TARR printouts.

No. 62. Opposer is satisfied with Applicant’s Response.

No. 69. In light of Applicant’s refusal to produce documents which show each state in which Applicant’s products have been sold under Applicant’s mark, Applicant should be precluded from relying on evidence/testimony regarding the geographic scope of use of the party’s respective marks.

Finally, Opposer withdraws its Motion as to Nos. 7 & 9.

## DISCOVERY SHOULD BE RESET – BUT FOR OPPOSER ALONE

In its Motion to compel, Big O requested that 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. However, Applicant opposed this request “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.” See Applicant’s Response, p.12 and n.1. Applicant’s baseless position is clearly contradicted by the Trademark Rules and the TBMP.

While the Board’s November 29, 2005 order extended the discovery period until Sunday, January 29, 2006, the discovery period, in fact, did not close until Monday, January 30, 2006 since January 29th was a Sunday. See 37 CFR 2.196; TBMP §112 (“If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, written requests for discovery . . . may be served, and discovery depositions may be taken, on the next business day.”). Accordingly, the discovery period closed on Monday, January 30, 2006 – the day that Opposer filed its request.

While Applicant’s position is wholly without merit, it is not without value inasmuch as it further demonstrates Applicant’s tenacious determination to improperly deprive Opposer of discovery. Accordingly, and in light of Applicant’s conduct, Opposer respectfully submits that the extension should be for Opposer Big O Tires, alone.

**II. BIG O'S MOTION TO STRIKE  
APPLICANT'S UNTIMELY FILED DISCOVERY MOTION**

On February 14, 2006, the Board issued an Order suspending this proceeding pending a decision on Big O's Motion to compel. Specifically, the Board commanded that the "parties should not file any paper which is not germane to the motion to compel." See Board's February 14, 2006 Order; see also 37 C.F.R. §2.120(e). However, after the issuance of this Order, Applicant filed a Motion to compel – contemporaneous with its response to Big O's discovery Motion. Patently, Applicant's post-suspension Motion to compel is not germane to Big O's Motion to compel. Accordingly, Applicant's untimely Motion to compel should be stricken.

If the Board grants this request, it need not consider Section III of this paper ("Applicant's Motion to Compel Should Be Denied"), below. However, if such grant is not forthcoming, Big O offers the following alternative argument.

**III. APPLICANT'S MOTION TO COMPEL SHOULD BE DENIED**

Applicant failed to engage in good faith consultation prior to filing the discovery motion. Moreover, even if the Board were to consider the merits of Applicant's Motion, it would find the Motion wanting.

**A. Applicant Has Failed to Engage in Good Faith Negotiations Required by Rule 2.120(e)**

Opposer served its discovery responses on September 9, 2005. As recounted more fully in Big O's Motion to compel, on September 26, 2005, Opposer sent a detailed letter setting forth numerous concerns with Applicant's discovery responses; and *repeatedly* sought Applicant's response thereto for four months (to no avail) before filing a Motion to compel. It was not until January 19, 2006 that Applicant sent a single letter raising *for the first time* various discovery issues

with Big O's discovery responses served almost five months earlier.<sup>6</sup> Shortly thereafter, this proceeding was suspended and Applicant made no other effort to address its discovery concerns – it simply (and untimely) filed a Motion to compel. Thus, the entirety of Applicant's attempt to resolve the dispute was sending a single letter – an effort that was retaliatory in nature. However, such a paltry showing does not discharge Applicant of its duty to engage in good faith efforts to resolve the discovery dispute.<sup>7</sup> To address Applicant's Motion to compel now, and in this context, eviscerates the purpose of Trademark Rule 2.120(e). The party who delayed and frustrated "good faith" efforts to resolve discovery disputes for months and which was extraordinarily dilatory in its own discovery review and action should not be in an equal or better position than the party which promptly reviewed discovery responses and whose efforts to resolve discovery disputes were completely frustrated for months.

B. There is no Basis to Compel the Production of Big O's Documents

Applicant's request that the Board issue "an Order requiring Opposer to produce the promised and responsive documents by mail . . .", *see* Applicant's Motion to Compel, p. 11, is wholly without merit.

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<sup>6</sup> Notably, the letter still did not address the issues raised by Opposer some four months earlier, in its September 26, 2005 letter.

Moreover, Applicant states that in the context of seeking a response to Opposer's discovery concerns: "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." This vague claim is not sufficiently detailed to constitute a good faith effort. Moreover, the timing of the comment – only raised when Opposer repeatedly sought better discovery from Applicant – betrays its retaliatory nature.

<sup>7</sup> While Applicant did comply with its duty in connection with the request for documents, Opposer timely objected to the defective nature of the request, as discussed below.

On September 9, 2005, Opposer seasonably objected to Applicant's improper demand that Opposer's documents be collected, copied, and mailed to Applicant's counsel's office in Cleveland, Ohio. *See* Exhibit B to Applicant's Motion to compel. Applicant's demand was clearly improper as Opposer's documents are not usually kept there. *See* 37 C.F.R. §2.120(d)(2) ("The production of documents and things under the provision of Rule 34 of the Federal Rules of Civil Procedure will be made at the place *where the documents and things are usually kept*, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.") (emphasis supplied). Indeed, the Board has supported this right:

We will not sanction defendant for failing to forward copies of documents to plaintiff. A party is not *required* to copy responsive documents and forward them to its adversary in response to document requests. Parties often do this as a reciprocal courtesy, but it is sufficient for a responding party to make documents available, at the place they are normally kept, for inspection and copying by the inquiring party.

*Electronic Industries Assoc. v. Potega*, 50 U.S.P.Q.2d 1775, 1777 (TTAB 1999) (emphasis in original).

There is nothing to compel, because Opposer's objection patently is supported by the Trademark Rules of Practices and was appropriately and seasonably interposed. Opposer fully, and timely, complied with its discovery obligations.<sup>8</sup>

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<sup>8</sup> Indeed, Applicant seeks the desired relief through an inappropriate mechanism. *See* TBMP §522 (Motion for Order re Manner or Place of Document Production). However, even if the appropriate motion were filed on the same basis as Applicant's Motion to compel, it would still be without merit.

C. Opposer's Response to Applicant's Discovery Concerns

The following is offered only if the Board determines that Applicant's Motion is both timely and in compliance with Trademark Rule 2.120(e).

**Interrogatories**

No. 2: Opposer has produced a copy of the directory of Big O Stores.

Nos. 4(a)/4(e) The information found in Opposer's pleaded registrations provides the requested information.

No. 4(f): Opposer originally agreed to provide documents from which Opposer's annual sales figures for a reasonable period of time could be ascertained. Opposer states now that it may be able to provide documents from which its annual sales figures may be separately ascertained for services and for goods; however, to the extent that Opposer's records are not kept in the manner that Applicant seeks it would be unduly burdensome for Opposer to provide the requested information for each good and each service.

No. 6 Opposer's answer was intended to include the disposition or current status of each proceeding. It is Opposer's understanding that its answer to this discovery request complies with current Board policies regarding same; and that was Opposer's intention.

No. 12. The interrogatory is irrelevant, overly broad and unduly burdensome as it relates to non-current uses or registrations of which Opposer has personal knowledge. In this regard, it is noted that the time period in question dates back over forty (40) years.

No. 13: As stated in Opposer's response, this is a thinly disguised effort to have Opposer lay out its complete case at trial – long before Opposer's testimony period is required to commence. Indeed, the Board has declined to apply Fed. R. Civ. Pro. 26(a)(1)'s requirement for initial disclosures – which essentially is the substance of Applicant's discovery request – to Board proceedings.

#### **Document Requests and Production**

No. 1: Since Opposer has used some of its pleaded marks for over forty years, it objected to the demand to produce documents showing initial and continuous use of all of its marks. However, Opposer agreed to produce representative samples of current use of its marks; and such documents likely will be in the time frame *now* requested by Applicant (since the June 18, 2003 filing date of the opposed application). For example, Big O may produce a specimen evidencing use of the BIG O TIRES mark which was in use sometime from June of 2003 to the present; however, it will not produce monthly (or even yearly) specimens for each such mark for each such good/service – especially since abandonment is not at issue in this proceeding.

- Nos. 2-3: Opposer did not mean to imply that any third party consents/licenses beyond those with franchisees would not be produced, pursuant to a protective order.
- No. 4: Opposer's response states that it will produce responsive documents. This amply demonstrates that Applicant's Motion was ill-conceived, premature, and should not have been filed before good faith efforts to resolve any "dispute" were pursued by Applicant.
- No. 5: Opposer's response indicates that a listing of inter partes and other proceedings, in accordance with the Board's established procedures, would be produced. However, to the extent this request seeks every document regarding every cease and desist letter or objection over a four decade period, it is clearly unduly burdensome, and far outweighs any probative value of such information.
- No. 7 & 41: It is Opposer's understanding that the listings it indicated would be produced constitute a sufficient response to these inquiries, under established Board policy. Indeed, the production this request seeks would be voluminous, would require extensive man-hours (to cull privileged documents and those covered by protective orders) and would have little or no relevance.
- No. 37-38: These requests seek to impose upon Opposer a duty to undertake searches and investigations on behalf of Applicant. Opposer is not required to do Applicant's own

discovery and trial preparation. To the extent that these requests seek documents relative to objections and/or proceedings of Big O with third parties, *see* Opposer's response to nos. 5, 7, and 41, above.

No. 42-43: Opposer objected on grounds of vagueness because it is not understood what Applicant means by "referenced." But as to "identified" documents, Opposer referred to its interrogatory responses – meaning, if there was an objection to producing a document relative to a particular interrogatory, it was incorporated here; not that the document would be produced.

#### **Miscellaneous**

Applicant requested a privilege log for certain requests. Opposer will comply – assuming that the request is otherwise answerable (*e.g.*, not so overly broad as to include every document Opposer or Opposer's counsel has ever written *etc.*).

Finally, as noted above, Opposer seasonably interposed a proper objection to Applicant's defective demand to produce documents at Applicant's counsel's office. This addresses Applicant's concerns raised in connection with document request nos. 6, 8-11, 13-15, 17, 23, 25-31, 33-35, and 40.

#### **IV. CONCLUSION**

For all the foregoing reasons, Opposer respectfully requests that the Board:

A. 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), and a privilege log; 2) suspend these proceedings; and 3) reset the discovery and trial dates upon lifting the suspension, with an extension for Opposer alone; and

B. STRIKE, or in the alternative, DENY Applicant's untimely filed Motion to Compel.

Respectfully Submitted,

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: March 9, 2006

CERTIFICATE OF SERVICE

I hereby certify that on this 9<sup>th</sup> day of March, 2006, a true copy of the foregoing paper 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

