



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

BIG O TIRES, INC.,
Opposer,
v.
WHEEL SPECIALTIES, LTD.,
Applicant.

TTAB

Opposition No. 91163791

78264260

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

COMES NOW the Opposer, Big O Tires, Inc., through its counsel, and hereby moves for an Order from the Trademark Trial and Appeal Board (the "Board") deeming as "admitted" Opposer's requests for admission nos. 1, 3-5, 12-14, and 21-23.

Additionally, Opposer asks that the Board suspend these proceedings and reset the discovery and trial dates upon lifting the suspension. In further support of this Motion, Opposer states as follows:

I. Introduction and Background

On April 19, 2005, Opposer served Opposer's written discovery, which included, *inter alia*, request for admissions. See Opposer's First Set of Request for Admissions, attached hereto as Exhibit A.

Applicant served its discovery responses on May 24, 2005, including responses to the request for admissions. See Applicant's Responses to Request for Admissions, attached hereto as Exhibit B.

On September 26, 2005, counsel for Opposer sent a letter to Applicant's counsel, by mail and facsimile, setting forth Opposer's concerns with Applicant's discovery responses including responses



02-12-2008

to the requests for admission. *See* Opposer's counsel's September 26, 2005 letter attached hereto as Exhibit C.

On September 28, 2005, Opposer's counsel sent an email message following up on the earlier letter. *See* Opposer's counsel's September 28, 2005 email, attached hereto as Exhibit D.

After further contacts in September – November of 2005, Opposer's counsel sent a letter on December 5, 2005 seeking Applicant's supplemental responses and/or a substantive reply to Opposer's September 26, 2005 letter. *See* Exhibit E.

On January 3, 2006, Opposer's counsel sent a "reminder" letter, by facsimile and mail, to Applicant's counsel. *See* Opposer's counsel's January 3, 2006 letter attached hereto as Exhibit F. When Applicant did not respond; yet another "reminder" letter was sent on January 17, 2006. *See* Exhibit G.

The matter was suspended from January 2006 – September, 2006, pending various discovery motions filed by the parties.

On January 4, 2007, counsel for the parties engaged in a "meet and confer" discovery conference which lasted 2 ½ hours. Counsel discussed the outstanding discovery issues.

On June 22, 2007, a subsequent "meet and confer" discovery conference was held by counsel for the parties, which lasted 1 ½ hours.

During the discovery conferences, Applicant's counsel confirmed that Applicant would not amend its responses to admission request nos. 1, 3-5, 12-14, and 21-23.

On November 7, 2007, the parties served supplemental discovery responses and document production. Applicant did not supplement its responses to the admission requests.

II. Argument

Opposer respectfully submits that certain of Opposer's admission requests, namely, nos. 3-5, 12-14, and 21-23, should be deemed admitted.

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

III. Rule 2.120(e) Statement

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

IV. Request for Suspension

Opposer understands that this proceeding will be suspended based on the filing of this discovery Motion, pursuant to Trademark Rule 2.120(h)(2). Nevertheless, Opposer requests that the proceeding be suspended to allow the Board to consider the present Motion (and any responsive filings), and to issue an Order as requested herein. Opposer further requests that, following a ruling on this Motion, the trial dates be reset with at least a sixty (60) day discovery period to follow any supplementation and/or amendment the Board may order.

¹ Applicant's counsel confirmed that a principal of Applicant had visited one or more Big O stores/service centers prior to Applicant's selection of the opposed mark.

V. Conclusion

For all the foregoing reasons, Opposer respectfully requests that the Board GRANT Opposer's Motion to Test the Sufficiency of Applicant's Admissions; and issue an Order to: 1) deeming Opposer's requests for admission nos. 1, 3-5, 12-14, and 21-23 as "admitted"; 2) suspending these proceedings; and 3) resetting the trial dates upon lifting the suspension.

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: February 12, 2008

CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of February, 2008, a true copy of the foregoing Opposer's Motion to Test the Sufficiency of Applicant's Response to Opposer's Admission Requests 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



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

Exhibit A

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

BIG O TIRES, INC.,

Opposer,

vs.

WHEEL SPECIALTIES. LTD.,

Applicant.

Opposition No. 91163791

OPPOSER'S REQUESTS FOR ADMISSION TO APPLICANT

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

INSTRUCTIONS

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

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

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

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

REQUESTS

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

39. The website located at www.rimfinancing.com sells wheels.

40. The website located at www.rimfinancing.com lists "BIGG" as hyperlinked text.

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

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

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

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

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

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

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

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

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

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

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

52. Opposer sells wheels at its BIG O stores.

53. Opposer installs wheels at its BIG O stores.

54. Opposer promotes wheels at its Internet website.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

BIG O TIRES, INC.

By:



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

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

Attorneys for Opposer

CERTIFICATE OF SERVICE

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

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

A handwritten signature in cursive script that reads "Sheryl S. Harris". The signature is written in black ink and is positioned above a horizontal line.

EXHIBIT A



Wheel World LLC

Wheels, Tires, and Auto Parts

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

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- Classics, Vintage, Etc..
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- Custom Color Wheels with Chrome Lip

Tires:

- Nitto™
- Pirelli™
- Hankook™
- 13" to 26" tires
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Automotive Parts:

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- Taillights
- Custom Hoods & Scoops
- Billet accessories
- Spoilers

Quality You Can Count On

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

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

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

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



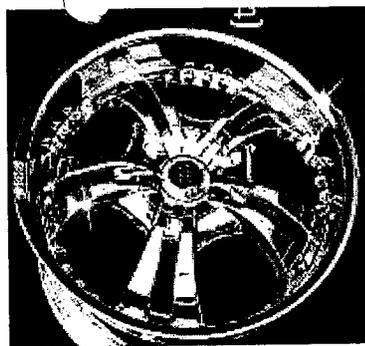
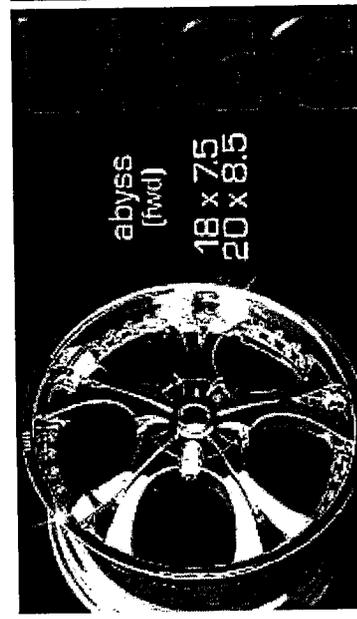
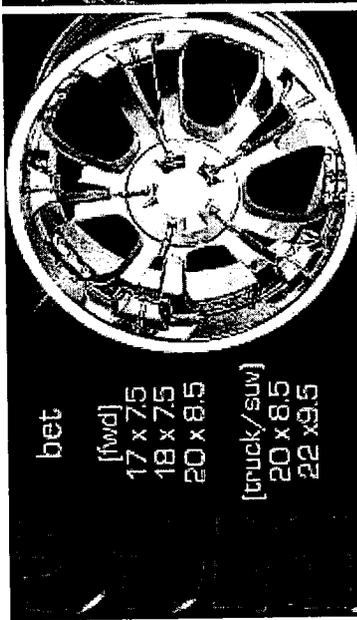
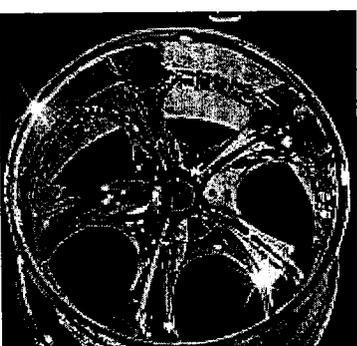
Wheel World LLC

Wheels, Tires, and Auto Parts

Images & Text Layout 6

BIGG WHEELS

- Home
- Wheel Gallery
- AKUZA
- AMERICAN EAGLE
- AMERICAN RACING
- ARELLI
- ASA
- ASANTI
- ▶ BIGG
- CENTER LINE
- DAVIN
- DEVINO
- DONZ
- DRIV
- DUB
- FERRETTI
- HIPNOTIC
- KAIZER
- LIMITED
- MHT
- MIZATI
- ROX
- STATUS



Wheels, Tires, and Auto Parts in Olive Branch, Mississippi. - BIGG

VERDE

WELD

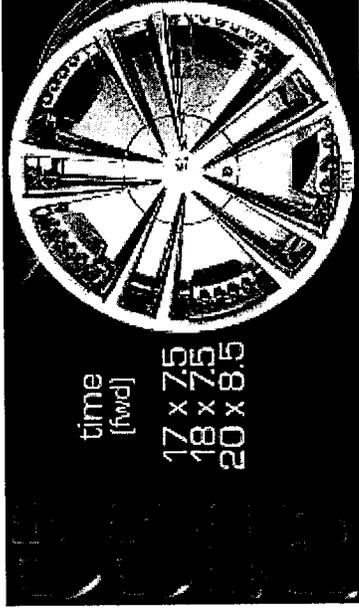
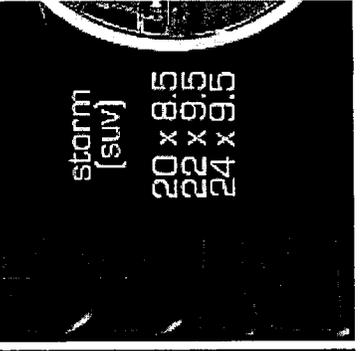
ZENETTI

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Location

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 9991 Highway 178
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F
 wh

EXHIBIT B

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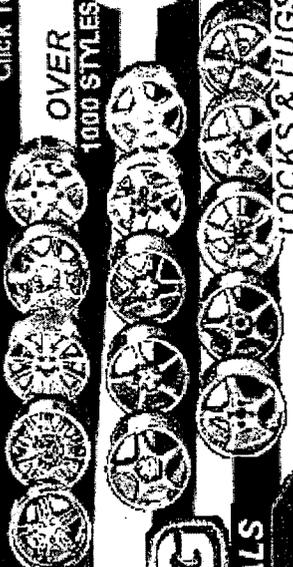
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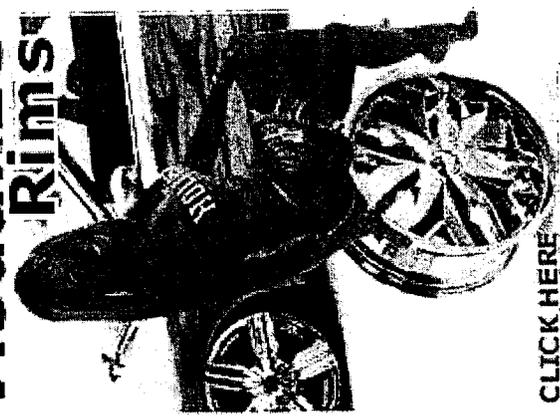
- ✔ Low Down Payments !
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- ✔ Easy Installments !
- ✔ Ride In Style !

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PURCHASE AGREEMENT

<http://www.rimfinancing.com/>

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Wheel Visualizer

American Racing
Soft Wheels

HARDCORE TOOLS FOR THE STREET

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BACCARAT **ES**

American Racing **Verde ZINB**

FALKEN

FOOSE

FOX **BIGG**

ION

NOTEGI RACING

niche *drive*

REPP

WHEEL REPLICAS

Pacer.

ST

Ultra

Platinum

MAAS

Parthen

Mossa

CRUISER ALLOY

AMG

RTZ

Magya

BAZO

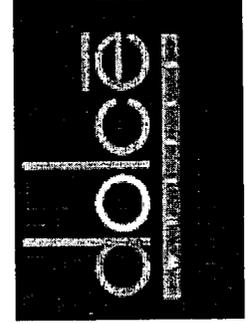


CUSTOM WHEELS SLIDESHOWS

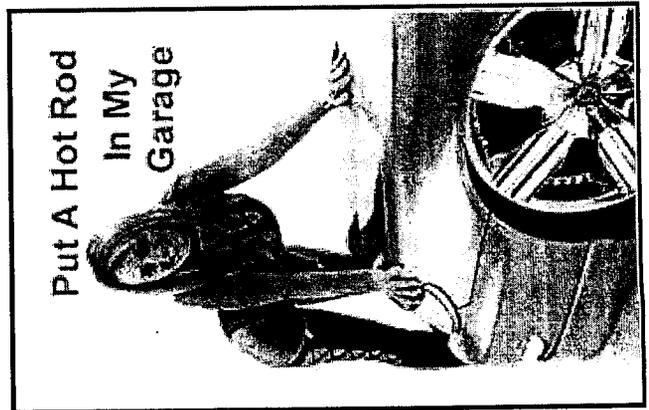
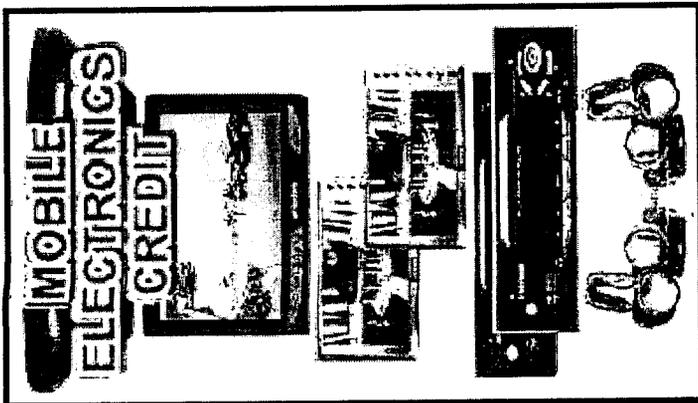
AKITA	DK ALLOYS	LOWENHART	SPORT METAL
ALBA	DOLCE	MAAS	TEAM DYNAMICS
AMERICAN RACING	DRIFZ	MAYA	TIS
AMG		MAZZI	
ASANTI	DRIV	MKW	ULTRA
AVENUE		MOGUL	
BACARAT	DUB	MOSSA	VELOCHE
BAZO	EQUUS	MOTEGI RACING	VERDE
BBS	EXCESS SPIN	NICHE	WHEEL REPLICA
BIGG	FALKEN	OE PERFORMANCE	ZINIK
BOYD CODDINGTON	FOOSE	PACER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

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VISUALIZERS

ALBA

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Rim Financing



CUSTOM SLIDESHOW 1	MOTEGI RACING
CUSTOM SLIDESHOW 2	SOFT WHEELS
FALKEN SLIDESHOW	
GFG SLIDESHOW	
GIOVANNA SLIDESHOW	
MKW SLIDESHOW	

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PATRIOTS MOBILE OUTFITTERS ROANOKE, VIRGINIA 2005

PURCHASE AGREEMENT

CUSTOM WHEELS

EXHIBIT C



[Home](#)

RIMS AND TIRES SHIPPED MOUNTED AND BALANCED

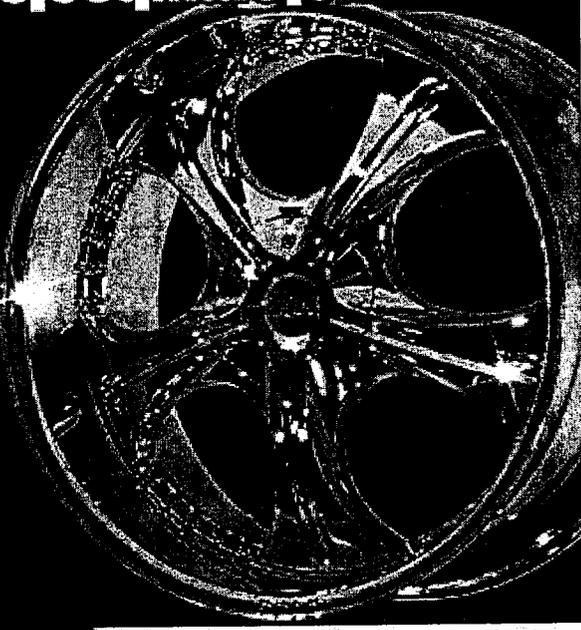
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FREE
wheels

BILL BILL BILL
 PLAYER DEAL EZ PUSH STORM MONEY BLING SHOT
 ERO BET TIME HUMONGOUS ABYSS VI ERO

BIGG Wheels ©2005 Patriot's Rims & Mobile Electronics Outfitters, Financing Roanoke, Virginia

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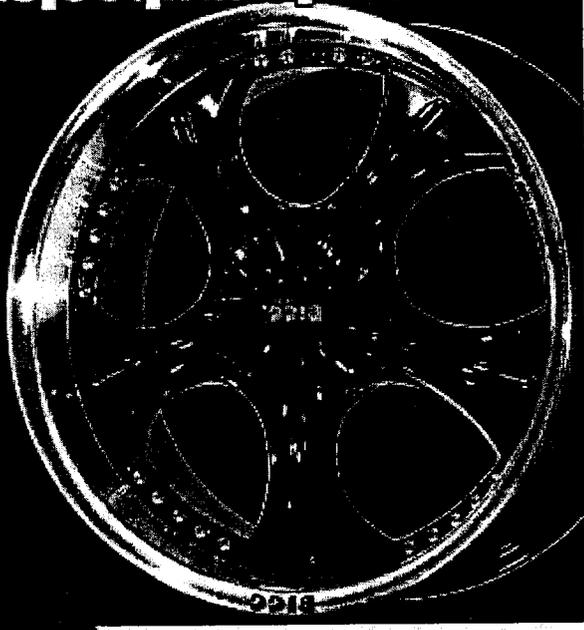
BILL

CHROME

TRUCK/SUV
20X8.5
22X9.5

FWD
7X7.5
18X7.5
20X8.5

www.customwheelsunlimited.com



BIG

TRUCK/SUV
20X8.5
22X9.5

RWD
17X7.5
18X7.5
20X8.5

BLACK
w/ Machined Lip

BILL

www.customwheelsunlimited.com



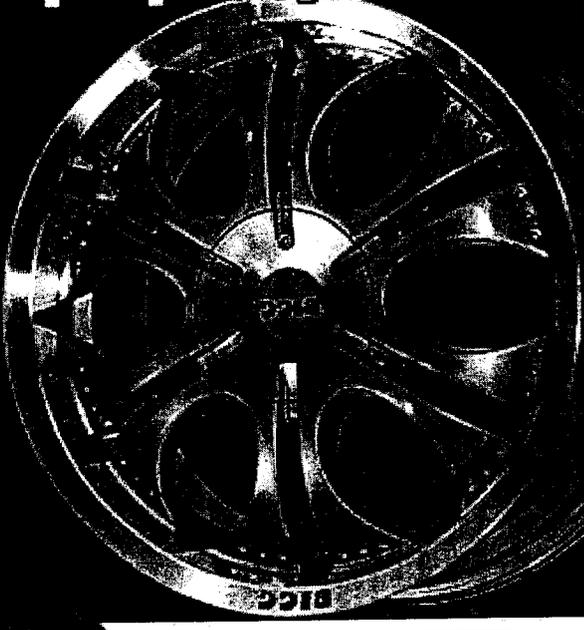
17X7.5
18X7.5
20X8.5

GUNMETAL
w/ Machined Lip

FWD

BILL

www.customwheelsunlimited.com



JOE

FWD

GUNMETAL
w/Machined Lip

7X7.5
18X7.5
20X8.5

www.customwheelsunlimited.com

TRUCK/SUV
20X85
22X95
24X95
FWD
17X7.5
18X7.5
20X85

BLACK w/ Machined Lip

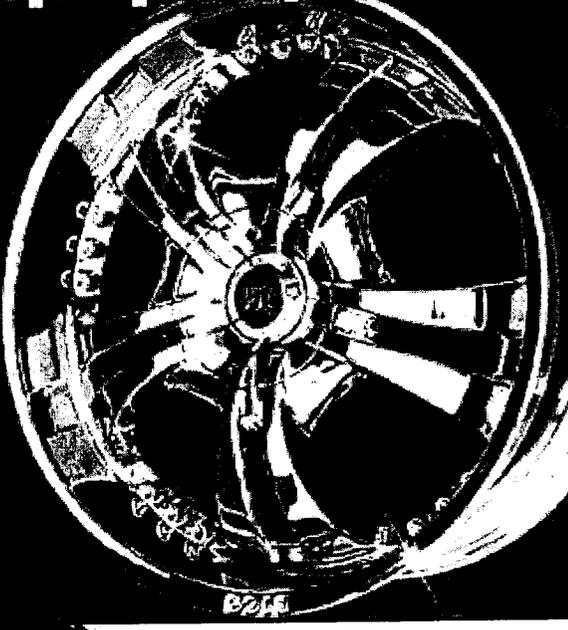
JOE

PLAYER

CHROME

TRUCK/SUV
20X8.5
22X9.5
24X9.5

RWD
17X7.5
18X7.5
20X8.5



www.customwheelsunlimited.com

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

Exhibit B

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

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

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

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

REQUESTS FOR ADMISSION

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

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

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

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

39. The website located at www.rimfinancing.com sells wheels.

RESPONSE

Admitted.

40. The website located at www.rimfinancing.com lists "BIGG" as hyperlinked text.

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

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

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

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

52. Opposer sells wheels at its BIG O stores.

RESPONSE

Admitted.

53. Opposer installs wheels at its BIG O stores.

RESPONSE

Admitted.

54. Opposer promotes wheels at its Internet website.

RESPONSE

Admitted.

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

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

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

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

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

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

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

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

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

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

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

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

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

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

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

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

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

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Denied.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

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

RESPONSE

Admitted.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.
By Its Attorneys

Date: 5/24/05



Donald L. Otto
Warren A. Sklar
RENNER, OTTO, BOISSELLE & SKLAR, LLP

1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115-2191
Phone: 216-621-1113
Fax: 216-621-6165
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S REQUESTS FOR ADMISSION was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 29th day of May, 2005.

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



Donald L. Otto

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

Exhibit C



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September 26, 2005

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

Via Facsimile
(216) 621-6165
Seven (7) pages
Confirmation copy by mail

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

Dear Mr. Otto:

After our review of Applicant's responses to Opposer's discovery requests, we have the following concerns.

Confidentiality

Applicant has refused to provide answers to certain requests and produce numerous documents on the basis of their confidential nature. Accordingly, we propose that the parties adopt the Board's Standard Order. Please advise if this is acceptable to Applicant.

General Comments on the Responses

Applicant seeks to interpose numerous objections to Opposer's interrogatories and document requests, covering the first three (3) pages of Applicant's responses (e.g., "Each of the foregoing objections is applicable to all of the following responses and is incorporated herein."). This is improper since it does not put Opposer on notice as to the nature of the allegedly objectionable request or whether any response has been limited on the basis of any such objection. The objections should be withdrawn.

We now turn to Applicant's responses to specific discovery requests. The comments below are to be read in conjunction with appropriate discovery request and response. Moreover, the characterization of the discovery requests in this letter is not intended to, and does not, restrict the scope of the requests, as served.

Jacobson Holman PLLC

Donald L. Otto, Esquire
September 26, 2005
Page 2

Interrogatories

- No. 1: Interrogatory 1(a) is unanswered. Additionally, the “exemplary documents evidencing” use of Applicant’s mark are not entirely legible. Please forward better copies.
- No. 2(c): Please confirm that Applicant will provide the requested information once a Protective Order is entered.
- No. 2(d): While Applicant objects to providing price information here, it agreed – without interposing a confidentiality objection – to “produce documents sufficient to show the price of the goods sold under Applicant’s Mark.” *See* document response no. 62. Please provide the requested information.
- No. 2(e): Please identify each state in which Applicant’s products have been sold in connection with Applicant’s mark.
- No 3: Applicant’s answer is deficiently narrow. For example, Applicant has not responded as to “searches or other investigations” related to Applicant’s mark or the term(s) BIGG/BIG. Please supplement.
- No. 4(a): Please confirm that Applicant will provide the requested information once a Protective Order is entered.
- No. 4(b): This answer is insufficient as to Applicant’s activities in light of Definition P. Additionally, please specify Applicant’s customer’s activities.
- No. 6: This answer is insufficient in light of Definition O; please supplement.
- No. 8: Please provide the business address, occupation and business position held for Messrs. Lamb and Nicols.
- Additionally, Applicant has not “describe[d] in detail” the reasons for selecting Applicant’s BIGG WHEELS mark. Please supplement.
- No. 10: Please provide more information concerning the claimed Big O–Custom Wheel transaction of August, 2002 (*e.g.*, brand of vehicle wheels, *etc.*). *See* Definition K. The single document Applicant produced does not suffice. Please supplement.

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

Page 3

Applicant has not responded as to the circumstances under which it first became aware of Opposer's Mark, Opposer's stores, the actual or possible use of Opposer's Mark, and the goods and services bearing Opposer's Mark. We note that, at a minimum, Applicant was aware of, and visited, Opposer's stores before it selected Applicant's mark. *See* no. 7-8. Please supplement.

No. 11: The response is too limited. For example, Applicant has not responded as to its consideration of Opposer. Applicant has admitted that it had actual knowledge of Opposer prior to Applicant's selection of Applicant's mark. *See* response to admission request no. 6.

No. 12: Use of the limiting phrase "at least" in describing the relevant registrations is unacceptable. Please supplement with an identification of "each and every" such registration; failing which we will move to exclude any testimony or evidence which Applicant seeks to introduce at trial that is based on information responsive to this request.

No. 15: Applicant's answer refers to documents to be produced. As discussed during the oral hearing, this answer constitutes an improper use of Rule 33(d) of the Federal Rules of Civil Procedure. As an initial matter, the referenced documents are not Applicant's "business records." Moreover, the requested information is not found on the documents Applicant produced on August 22, 2005. Furthermore, the burden of deriving the requested information falls more heavily on Opposer. Thus, Opposer demands a written response to the interrogatory where all of the requested information is provided for each responsive mark – if Applicant does not know or does not have the requested information, it should so state.

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

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

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

Page 4

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

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

Admissions

Applicant denied several requests presumably because the term "Opposer's Marks" was not defined. *See e.g.*, response nos. 51, 55, 56, 94, 100 - 107. However, this term was defined. *See* Definition D in Opposer's First Set of Interrogatories, which was incorporated by reference into Opposer's First Set of Requests for Admission. Please supplement Applicant's answers.

Applicant admits that, prior to Applicant's selection of Applicant's mark, Applicant had actual knowledge of Opposer and Opposer's stores; and had visited one of Opposer's stores. *See* responses to nos. 6-8. Presumably, Applicant also had actual knowledge of Opposer's Mark, at least, "BIG O" and/or "BIG O TIRES" (no. 1) and use of the mark in connection with tires and automotive services (nos. 3-5, 12-14, and 21-23). Please amend.

We note that Applicant has mistyped the parenthetical of request no. 61 – it is not "(other than markets involved in this proceeding)" but rather "(other than marks involved in this proceeding)." Please amend.

Applicant admits that it possesses documents supporting Applicant's affirmative defenses, namely, Applicant's first, second, third, fourth, and sixth affirmative defenses (*see* nos. 66, 69, 72, 75 and 81). However, Applicant admits that it has not produced such documents (*see* nos. 68, 71, 74, 77, and 83). Similarly, Applicant admits that it possess documents supporting various contentions made in papers filed with the Trademark Office its Answer (*see* no. 84), but that such documents have not been produced (*see* nos. 86). All of these documents were requested, are responsive and must be produced immediately.

Please explain the basis for Applicant's denial of request nos. 95 and 96 that tires are not similar or related to wheels.

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

Page 5

Document Responses and Production

We received Applicant's document production (WSL00001 – WSL00249) under your cover letter of July 29, 2005. The production is quite limited and basically includes: a third party catalog, a single advertisement, excerpts from Applicant's website(s), a couple of invoices, the prosecution history of the opposed application, and, ostensibly, some Internet printouts of third party references. Please supplement Applicant's document production.

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

We now turn to Applicant's responses to Opposer's document requests, many of which are deficient on a number of grounds.

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

In light of Applicant's improperly ambiguous responses and the quality of Applicant's document production, Opposer cannot now fully evaluate these responses and reserves the right to object to these responses once they are supplemented and/or additional documents produced.

No. 3: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

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

No. 7: Applicant has only produced one magazine advertisement and one banner. This is insufficient; and Applicant should produce all of the requested documents.

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

Page 6

No. 9: Applicant has only produced one magazine advertisement, Internet prints out for two websites and one banner. This is insufficient; and Applicant should produce all of the requested documents.

No. 10: Despite Applicant's promise to produce exemplary documents responsive to this request, Applicant has not produced any such documents.

No. 11: *See* comments regarding no. 6.

No. 12: This response is insufficient.

No. 14: Applicant's response is limited to Applicant's knowledge of "Opposer's Mark." However, the request is not so limited, and includes "Opposer."

Additionally, please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

Nos. 29-34: Applicant has refused to respond to these requests or produce responsive documents on the basis of attorney-client privilege and/or attorney work product doctrine. At a minimum, any non-privileged documents should be produced immediately. We refer to our demand for a privilege log, above.

In order to test the very broad application of privilege asserted by Applicant, we request that you immediately identify any withheld documents.

Nos. 35-37: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.

Nos. 36/7: Applicant has produced one document responsive to this request – an August 2002 invoice. Please advise whether there are other documents responsive to this request and produce them.

Nos. 38-40: We note Applicant's confidentiality and relevance objections to these requests. As to the latter, the requests are clearly relevant. Please confirm that Applicant will provide the requested documents once a Protective Order is entered.

Nos. 45/46: Despite Applicant's promise to "produce any non-privileged documents responsive to" the requests, it appears that no documents have been produced. Please state whether any responsive documents exist and whether they have been withheld on grounds of privilege. As you likely know, search reports are not privileged.

Jacobson Holman PLLC

Donald L. Otto, Esquire

September 26, 2005

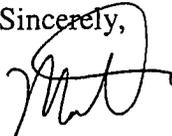
Page 7

- No. 47: Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine.
- No. 58: Applicant has refused to produce any documents in response to this request, which seeks documents that support Applicant's denials of Opposer's admission requests. Please provide sufficient identifying information for any documents withheld on the basis of attorney-client privilege and/or attorney work product doctrine. In the meantime, Applicant should produce non-privileged documents. However, if Applicant is not producing any documents on the ground that the request is so "vague, ambiguous, over-broad and/or] unduly burdensome" that no response may be made or document produced, please explain to us the basis for this assertion
- No. 59: Please explain why no response is made or document produced in response to this request.
- No. 61. No documents have been produced to date.
- No. 62. No documents have been produced to date.
- No. 69. This request seeks documents which show each state in which Applicant's products have been sold under Applicant's mark. Applicant's answer that it *intends* to sell its products "throughout the United States" is not responsive. Please respond to the request *as stated* and produce responsive documents.
- Nos. 70-87: Please confirm that Applicant will provide the requested documents once a Protective Order is entered.

We look forward to Applicant's supplemental responses, document production and/or your comments.

In the meantime, we suggest that an extension request be filed to allow the parties time to resolve these issues, including the negotiation, execution, and entering of a Protective Order. Please call me to discuss.

Sincerely,



Matthew J. Cuccias

TRANSMITTED/STORED : SEP. 26. 2005 3:38PM
FILE MODE OPTION

ADDRESS

RESULT

PAGE

896 MEMORY TX

12166216165

OK

7/7

REASON FOR ERROR OR LINE FAIL
E-1) HANG UP
E-3) NO ANSWER

E-2) BUSY
E-4) NO FACSIMILE CONNECTION



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September 26, 2005

Donald L. Otto, Esquire
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1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115-2191

Via Facsimile
(216) 621-6165
Seven (7) pages
Confirmation copy by mail

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

Dear Mr. Otto:

After our review of Applicant's responses to Opposer's discovery requests, we have the following concerns.

Confidentiality

Applicant has refused to provide answers to certain requests and produce numerous documents on the basis of their confidential nature. Accordingly, we propose that the parties adopt the Board's Standard Order. Please advise if this is acceptable to Applicant.

General Comments on the Responses

Applicant seeks to interpose numerous objections to Opposer's interrogatories and document requests, covering the first three (3) pages of Applicant's responses (e.g., "Each of the foregoing objections is applicable to all of the following responses and is incorporated herein."). This is improper since it does not put Opposer on notice as to the nature of the allegedly objectionable request or whether any response has been limited on the basis of any such objection. The objections should be withdrawn.

We now turn to Applicant's responses to specific discovery requests. The comments below are to be read in conjunction with appropriate discovery request and response. Moreover, the characterization of the discovery requests in this letter is not intended to, and does not, restrict the scope of the requests, as served.

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

Exhibit D

Matthew Cuccias

From: Matthew Cuccias [mcuccias@jhip.com]
Sent: Wednesday, September 28, 2005 3:41 PM
To: dotto@rennerotto.com
Cc: Matthew J. Cuccias
Subject: Big O v. Wheel Specialties, Ltd. (Your File No. WHEL.L0101; Our File No. I-5156)

Dear Mr. Otto:

I tried calling you today but only received your voicemail. Please call me to discuss the issues raised in my September 26, 2005 letter.

Regards,

Matthew

Matthew J. Cuccias, Esq.
Jacobson Holman, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004-2201
(202) 638-6666x2260
email: mcuccias@jhip.com

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

Exhibit E



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December 5, 2005

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

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

Dear Mr. Otto:

In order to address the confidentiality issues, we enclose a draft Protective Order based on the Trademark Trial and Appeal Board's Standard Protective Order. If this is acceptable to your client, please have it executed and forwarded to us for execution and filing with the Board.

Further to our September 26, 2005 correspondence regarding various discovery disputes, we continue to await the receipt of Applicant's supplemental discovery responses and/or substantive comments relating to our September 26, 2005 correspondence.

Cordially,

Matthew J. Cuccias

MGG/MJC
Enclosure

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

BIG O TIRES, INC.,

Opposer,

vs.

WHEEL SPECIALTIES. LTD.,

Applicant.

Opposition No. 91163791

**PROVISIONS FOR PROTECTING
CONFIDENTIALITY OF INFORMATION
REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential - Material to be shielded by the Board from public access.

Highly Confidential - Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive - Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as **confidential** or **highly confidential**, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as **trade secret/commercially sensitive**.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall

be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare.**

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

13) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction: Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Agreement of the Following, effective

_____ [insert signature date]

BIG O TIRES, INC.

WHEEL SPECIALTIES, LTD.

Matthew J. Cuccias
Jacobson Holman, PLLC
400Seventh Street, N.W.
Suite 600
Washington, D.C. 20004-2218
Counsel for Big O Tires, Inc.

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

By order of the Board, effective _____.

[print or type name and title of Board attorney
or judge imposing order]

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

BIG O TIRES, INC.,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

**OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS**

Exhibit F



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

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

URGENT REMINDER
January 3, 2006

~~December 5, 2005~~

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

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

Dear Mr. Otto:

In order to address the confidentiality issues, we enclose a draft Protective Order based on the Trademark Trial and Appeal Board's Standard Protective Order. If this is acceptable to your client, please have it executed and forwarded to us for execution and filing with the Board.

Further to our September 26, 2005 correspondence regarding various discovery disputes, we continue to await the receipt of Applicant's supplemental discovery responses and/or substantive comments relating to our September 26, 2005 correspondence.

Cordially,

Matthew J. Cuccias

MGG/MJC
Enclosure

* * * COMMUNICATION RESULT REPORT (JAN. 3. 2 0 6 7:20PM) * * *

FAX HEADER: JACOBSON HOLMAN PLLC

TRANSMITTED/STORED : JAN. 3. 2006 7:19PM
FILE MODE OPTION

ADDRESS

RESULT

PAGE

643 MEMORY TX

12166216165

OK

1/1

REASON FOR ERROR
E-1) HANG UP OR LINE FAIL
E-3) NO ANSWER

E-2) BUSY
E-4) NO FACSIMILE CONNECTION



Law Offices
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Opposer,

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Applicant.

Opposition No. 91163791

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Exhibit G



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

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

~~URGENT REMINDER~~

~~January 3, 2006~~

~~December 5, 2005~~

**URGENT REMINDER
VIA FACSIMILE
(216) 621-6165
January 17, 2006**

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

Re: Opposition No. 163,791
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MGG/MJC
Enclosure

* * * CC JNICATION RESULT REPORT (JAN. 17. 2006 4:01PM) * * *

FAX HEADER: JACOBSON HOLMAN PLLC

TRANSMITTED/STORED : JAN. 17. 2006 3:55PM
FILE MODE OPTION

ADDRESS

RESULT

PAGE

181 MEMORY TX

12166216165

OK

1/1

REASON FOR ERROR
E-1) HANG UP OR LINE FAIL
E-3) NO ANSWER

E-2) BUSY
E-4) NO FACSIMILE CONNECTION



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~~URGENT REMINDER~~

~~January 3, 2006~~

~~December 5, 2005~~

URGENT REMINDER

VIA FACSIMILE

(216) 621-6165

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Enclosure