

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

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

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

Applicant, Wheel Specialties, Ltd., through its undersigned counsel, hereby responds to Opposer's Motion to Test the Sufficiency of Applicant's Response to Opposer's Admission Requests as follows:

I. Introduction and Background

On January 30, 2006 Opposer filed a motion to compel Applicant to serve amended and/or supplemental responses to Opposer's interrogatories, requests for production of documents, and to test the sufficiency of Applicant's responses to requests for admission. On February 21, 2006, Applicant filed a motion to compel Opposer to serve amended and/or supplemental responses to Applicant's interrogatories and requests for production of documents.

In the Board's September 20, 2006 ruling on the motions, the Board found that although the parties' motions included the requisite written statements that



02-28-2008

they made good faith efforts to resolve their discovery disputes prior to filing their respective motions to compel, a true good faith effort had not been made by either party to resolve all outstanding discovery disputes. Accordingly, the Board denied the parties' respective motions without prejudice, and ordered the parties to meet and confer to discuss all of their respective outstanding discovery disputes. A copy of the Board's September 20, 2006 Order is attached hereto as Exhibit 1.

Subsequent to the Board's Order, the parties had several "meet and confer" discovery conferences during which good faith efforts were made by both parties to resolve all discovery disputes, including the sufficiency of Applicant's responses to Opposer's admission requests which is the subject of Opposer's current motion.

During the January 4 and June 22, 2007 "meet and confer" discovery conferences referenced in Opposer's motion, Applicant's counsel was of the belief that counsel for the parties reached a compromise settlement concerning all of the outstanding discovery disputes. In particular, counsel agreed to supplement their respective discovery responses and document production. However, at no time during these "meet and confer" discovery conferences or at any other time subsequent thereto did Opposer's counsel request Applicant's counsel to supplement its responses to Opposer's admission requests. To the contrary, during the January 4, 2007 conference, Opposer's counsel informed

Applicant's counsel there was no need at that time for Applicant to supplement its responses to any of Opposer's admission requests.

Thereafter, on November 7, 2007, the parties served supplemental discovery responses and document production pursuant to the compromise settlement reached between counsel during the January 4 and June 22, 2007 discovery conferences.

The only additional discovery dispute raised by Opposer's counsel subsequent to receiving Applicant's November 7, 2007 supplemental discovery responses and document production took place via a telephone conference between counsel on December 12, 2007. During that telephone conversation, the only additional supplementation requested by Opposer's counsel was Applicant's confidential sales and advertising information. This supplementation was served on Opposer's counsel on January 28, 2008 along with a cover letter from Applicant's counsel, attached hereto as Exhibit 2.

II. Argument

For the reasons set forth above, Applicant respectfully submits that the compromise settlement regarding all outstanding discovery disputes between the parties did not include any requirement on the part of Applicant to supplement any of its responses to the admission requests. To the contrary, Opposer's counsel specifically informed Applicant's counsel that there was no need for Applicant to supplement its responses to any of Opposer's admission requests. Therefore, Opposer's motion should be denied for that reason alone.

As to the sufficiency of Applicant's response to Opposer's admission requests, Opposer argues that because Applicant admits in response to Request Nos. 6-8 that, prior to Applicant's selection of Applicant's Mark, Applicant had actual knowledge of Opposer and Opposer's stores, Applicant had of Opposer's stores, 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). However, merely because Applicant has admitted that prior to Applicant's selection of Applicant's mark, Applicant had knowledge of Opposer and one or more of Opposer's stores and had visited one or more of Opposer's stores, that does not necessarily mean that prior to Applicant's selection of Applicant's mark, Applicant had actual knowledge of one or more of Opposer's stores, that or more of Opposer's Marks in connection with tires and automotive services. To the contrary, Applicant specifically denies having such knowledge. Therefore, it is respectfully submitted that Applicant's denials of these requests should not be deemed admitted.

III. Conclusion

For the foregoing reasons, Applicant respectfully requests that the Board deny Opposer's Motion to Test the Sufficiency of Applicant's Admissions and reset the trial dates. However, Applicant opposes Opposer's further request in the second paragraph on page 1 of its motion that the Board reset the discovery dates since the discovery period closed on April 19, 2007.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.
By Its Attorneys



Date: February 26, 2008

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Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 26th day of February, 2008.

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



Donald L. Otto

CERTIFICATE OF MAILING

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

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

on February 26, 2008



Donald L. Otto

Don Otto

From: ESTTA@uspto.gov
Date: Wednesday, September 20, 2006 10:24 AM
To: Don Otto
Subject: TTAB Response

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

Mailed: September 20, 2006

Opposition No. 91163791

BIG O TIRES, INC.

v.

WHEEL SPECIALTIES, LTD.

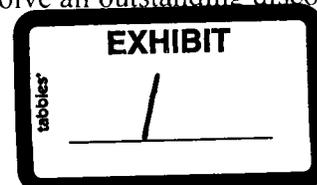
Thomas W. Wellington
Interlocutory Attorney,
Trademark Trial and Appeal Board:

This case now comes up on (1) opposers motion (filed January 30, 2006) to compel applicant to serve amended and/or supplemental responses to opposers interrogatories, requests for production of documents, and to test the sufficiency of applicants responses to requests for admission;^[1] (2) applicants motion (filed February 21, 2006) to compel opposer to serve amended and/or supplemental responses to applicants interrogatories and requests for production of documents;^[2] and the parties stipulate protective agreement (dated March 9, 2006) filed with the Board.

Both Trademark Rules 2.120(e) and 2.120(h) provide, respectively, that a motion to compel and motion to determine the sufficiency of response to a request for admission must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement.

In support of their respective motions, the parties state that they have made good faith efforts to resolve their discovery disputes prior to filing the motions to compel. However, based on the record before us, it appears that each party only made a good faith effort to obtain what it alleges are shortcomings in the other partys discovery responses. Accordingly, we find that a true good faith effort has not been made by either party to resolve all outstanding discovery

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issues, as contemplated by Trademark Rules 2.120(e) and 2.120(h). The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with some disfavor on those that do not. TBMP 408.01 (2d ed. rev. 2004) [duty to cooperate].

Accordingly, the parties respective motions are denied without prejudice. Instead, the parties are hereby ordered to meet and confer to discuss all of their respective outstanding discovery issues. The parties have ample time (see rescheduled discovery deadline and trial dates below) to make serious attempts to resolve their discovery disputes. Should the parties fail to resolve their differences and file a renewed or amended motion to compel or motion to determine the sufficiency of answers, the moving party must include a statement with said motion that details the topics discussed during the meet and confer session.

The stipulated protective agreement filed on March 14, 2006 is noted. The parties are referred, as appropriate, to TBMP 416 (2d ed. rev. 2004) regarding signature of protective order, filing confidential materials with board, and handling of confidential materials by board. The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Opposers motion to extend the discovery period is granted to the extent that the discovery deadline (and trial dates) are rescheduled below. Opposers request, contained in its reply brief, that the discovery period be applicable only to opposer is denied.

Accordingly, proceedings herein are resumed and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **12/20/06**

Thirty (30) day testimony period for party in position of plaintiff to close: **3/20/07**

Thirty (30) day testimony period for party in position of defendant to close: **5/19/07**

Fifteen (15) day rebuttal testimony period to close: **7/3/07**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as

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provided by Trademark Rule 2.129.

* * *

[1] Opposer also moves to reset the discovery deadline so that the parties would have an additional sixty (60) day discovery period. In its reply brief, opposer requests that said extension only be applicable to opposer.

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January 28, 2008

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

Dear Matthew:

Enclosed are Applicant's Supplemental Responses to Opposer's Interrogatories 2(c), 2(d) and 4(a) and Opposer's Request for Production Nos. 38-40 and 78-87 that you requested.

Very truly yours,

Donald L. Otto

DLO:jm
enclosures
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