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

Proceeding	91163791
Party	Plaintiff BIG O TIRES, INC.
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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 BRIEF IN REPLY TO
APPLICANT'S RESPONSE TO
OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF
APPLICANT'S RESPONSE TO OPPOSER'S ADMISSION REQUESTS

Applicant's Response to Opposer's Motion to Test the Sufficiency of Applicant's Response to Opposer's Admission Requests ("Applicant's Response") raised two arguments against Opposer's discovery Motion – one procedural and one substantive. Opposer respectfully submits that neither is meritorious, and Opposer's Motion should be granted.

Additional Background and Argument

During the January 4, 2007 "meet and confer" discovery conference, the parties' counsel discussed numerous discovery issues, including the disputed admission responses (which were raised by Opposer's counsel as a group). Applicant's counsel stated that this group contained so many that he would revisit the issue at a later time. Thus, the issue as to request nos. 1, 3-5, 12-14, and 21-23 was then deferred.[1]

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[1] Opposer notes Applicant's assertion that "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." *See* Applicant's Response, p.3. However, this assertion, made in the "Argument" section of Applicant's Response, does not appear to be supported by the factual recitation found in the "Introduction and Background" section of Applicant's Response, which states "... during the January 4, 2007 conference, Opposer's counsel informed Applicant's counsel there was no need *at that time* for Applicant to supplement

During the June 22, 2007 "meet and confer" discovery conference, Applicant's counsel initially stated that no amended response would be forthcoming and that he did not have to offer an explanation. Subsequently, he explained that a principal of Applicant had visited one or more Big O stores/service centers prior to Applicant's selection of the opposed mark. After further discussion on the issue, Applicant's counsel stated Applicant's position that it would not amend Applicant's responses to admission request nos. 1, 3-5, 12-14, and 21-23. Opposer's counsel understood that the matter had been exhausted, and that the parties agreed to disagree on this issue.

Applicant's Response notes that Opposer's counsel did not request amendment of the disputed responses in a subsequent telephone conference. The purpose of that call was to obtain from Applicant that discovery which Opposer understood Applicant agreed to provide (*i.e.*, confidential information), but had not yet been received by Opposer. Again, since the Opposer understood that the disputed issue had been exhausted without resolution, there would have been no point in revisiting it again. In any event, that Applicant maintains its refusal to amend its responses in Applicant's Response offers further evidence that the issue was exhausted without resolution during the pre-Motion conferences.

Applicant's substantive objection to Opposer's Motion fails, as well. In response to Opposer's argument, Applicant does not attempt to explain how Applicant's admission responses are not self-contradictory. Rather, Applicant simply denies the requests in conclusionary fashion. For example, while Applicant admits that, prior to Applicant's selection of Applicant's mark,

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its responses to any of Opposer's admission requests." *See* Applicant's Response, pp.2-3 (emphasis supplied). Notably missing from the former is the temporal modifier ("at this time") contained in the latter. In any event, while Opposer's notes do not reflect either assertion, the latter assertion is not inconsistent with Applicant's request during the January 4, 2007 conference to defer the issue.

Applicant had actual knowledge of Opposer and Opposer's stores; and had visited one or more of Opposer's stores, nevertheless Applicant denies that it had actual knowledge of Opposer's Mark – even the "BIG O" and/or "BIG O TIRES" marks. Since the name of Opposer includes "BIG O TIRES", and its retail stores have BIG O TIRES signage, this assertion would seem nonsensical. Similarly, Applicant does not explain – nor does an explanation readily come to mind – how despite shopping in one or more of Opposer's BIG O stores, Applicant denies that it had actual knowledge of, *inter alia*, use of the BIG O mark in connection with *retail stores* featuring automotive parts and accessories. Inexplicably, similar denials issued on requests concerning Applicant's actual knowledge of, *inter alia*, use of the BIG O mark on tires and for automotive maintenance and repair services – goods and services sold in Opposer's stores. Accordingly, these responses should be deemed admitted.

II. Conclusion

For all the foregoing reasons and those raised in Opposer's initial moving papers, Opposer respectfully requests that the Board GRANT Opposer's Motion to Test the Sufficiency of Applicant's Admissions; and issue an Order deeming as "admitted" Opposer's requests for admission nos. 1, 3-5, 12-14, and 21-23.

Respectfully Submitted,

BIG O TIRES, INC.,

By: _____

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Dated: March 17, 2008

CERTIFICATE OF SERVICE

I hereby certify that on this 17th day of March, 2008, a true copy of the foregoing OPPOSER'S BRIEF IN REPLY TO APPLICANT'S RESPONSE TO 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:

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