ESTTA Tracking number: **ESTTA133134**
Filing date: **04/02/2007**

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

Proceeding	91173105
Party	Defendant Michael Dalton Michael Dalton Box 18137 670 Northland Blvd Cincinnati, OH 452180137 DALTONME@hotmail.com
Correspondence Address	Michael Dalton Box 18137 670 Northland Blvd. Cincinnati, OH 45218-0137 UNITED STATES DALTONME@hotmail.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Michael Dalton
Filer's e-mail	DALTONME@hotmail.com
Signature	/ Michael Dalton /
Date	04/02/2007
Attachments	MemorandumandMotion003.pdf (10 pages)(740037 bytes)

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

Honda Motor co., Ltd

Plaintiff

Opposition no. **91173105**
Application no. **78339571**

v.

Michael Dalton
Defendant

DEFENDANT'S MOTION TO DISMISS, SANCTIONS, alternative MOTION TO STRIKE

DEFENDANT'S MOTION TO DISMISS, MOTION FOR SANCTIONS
Or alternative
MOTION TO STRIKE

Now comes applicant, Michael Dalton, and hereby moves to dismiss Honda Motor Co., LTD's opposition to applicant's trademark/ service mark DealerDashboard for failure to state a claim upon which relief can be granted and/or lack of jurisdiction and/ or waiver of claims.

1. The opposer, an alleged corporation organized under the laws of Japan, located and doing business at 1-1, 2-Crome, Minami-Aoyama, Minato-Ku, Tokyo 107-8556 JAPAN is not within the districts for which this board has jurisdiction, nor, has the opposer claimed protection under Title XII – The MADRID PROTOCOL. The applicant had several communications with the attorney's representing Honda Motor Co. Ltd while they represented American Honda Motor Co., Inc. 1919 Torrance Boulevard, Torrance, CA 90501-2746 (see attachment I, J, K, Def

exhibit). Those communications resulted in the extra-judicial success of the defense of the applicants brand DealerDashboard via a cease and desist demand. The applicant advised, American Honda Motor Co., Inc., that the non-secure website http://www.inhonda.com/RRAADCTM/Content?AAD/AD85/DashboardiNadmin.htmhttp://trade

infringed on the applicant's DealerDashboard brand, thus, American Honda Motor Co., Inc. removed the site. It should be noted that the site resided at the **http://**, hypertext protocol tag, and not the first step of security **https://**, hypertext protocol secure tag. American Honda Motor Co. Inc., via their agent attorney, Mark G. Matuschak, attempted to intimidate, harass and defame applicant by stating:

"Your unauthorized access is itself a trespass on Honda's internal network, a violation of Honda's confidentiality and contract rights. Accordingly, I must insist that you immediately stop your unauthorized access of Honda's proprietary network and provide me with information regarding how you obtained access to this proprietary network so Honda can ensure that its confidential information is adequately protected from unauthorized access." (Def's attachment J, p.2 pp.5).

Certainly a website published at the **http://** tag is public in nature and reinforces applicants claims that the opposer is merely on a fishing expedition aimed to intimidate, harass, and defame the applicant. Just as their agents / attorney's claim of trespass is merit less, their claims in the opposition are ludicrous, and aimed to

frivolously harass, the applicant, and extract competitive information through irrelevant interrogatories and motions for discovery. Further, the opposition claim is filed in a manner to increase applicants time and cost of litigation as the opposer, an alleged corporation organized under the laws of Japan, located and doing business at 1-1, 2-Crome, Minami-Aoyama, Minato-Ku, Tokyo 107-8556 JAPAN is not within the jurisdiction of this board and to proceed would prejudice applicant. The applicant is prejudice as the board is without jurisdiction to compel discovery or subpoena witness from opposer and hereby moves to dismiss opposer's opposition for lack of jurisdiction and sanction opposer as the board deems necessary to prevent further abuse of process.

2. The applicants registration of the service mark, DealerDashboard, was delayed due to a conflict for which applicant prevailed, (see exhibit D, Def. Exhibits Doc # 9). After recommendation for publication on June 29, 2004, in case serial no. 7630506, the opposer, Honda Motor Co. Ltd., failed to file a timely opposition to the term Dealer Dashboard in case serial no. 7630506 and therefore waved their alleged rights to the term DealerDashboard, (see exhibit D, Def. Exhibits Doc # 9). Therefore, the opposition should be dismissed as the opposer waved their rights to the term in opposition and failed to state a claim upon which relief can be granted.

3. The opposer has constructed it's international opposition, interrogatories, production of documents, and requests for admission in it's motion for discovery

in such a manner as to increase the time and cost of litigation irrelevant to the claims of the opposer . Certainly, the applicant's sales records, sales history, vendor lists are confidential and proprietary in nature and have no relevance to the opposers claims. The opposer's agent attorney was noticed that their claims were frivolous (attachment K) and the board has applicant's exhibits to date (see Doc # 9), as a matter of record. The opposer's international claim is designed to increase the costs of litigation and their interrogatories are designed to extract confidential competive information with no relevancy to the opposer's claims and constitute an abuse of process. The applicant alternatively moves for protection from such behavior and moves to strike the interrogatories, production of documents, requests for admissions, and motion to compel as sham and signed in a manner contrary to just adjudication of opposers claims and violates federal rules of procedure.

Therefore,

The applicant moves to dismiss the opposers claim for failure to state a claim upon which relief can be granted, lack of jurisdiction, waver and moves to assess sanctions against the opposer and their agent / attorneys for pursuing a claim which is aimed to harass, intimidate, and increase the cost of litigation of an amount sufficient to deter further abuse and such other relief as the board deems necessary.

Alternatively,

The applicant moves to strike the opposers motion to compel discovery as sham and abuse of process as they're clearly designed to increase the cost of litigation by going beyond the claims of the opposer and designed to harass, intimidate, and extract

competitive information, which has no relevancy to the opposer's claims. The applicant moves for protection from opposer's abuse. These motions shall additionally serve as memorandum in opposition to opposers motion to compel discovery.

Respectfully submitted,

Michael Dalton, prose
PO Box 18137
Cincinnati, Ohio 45218-0137
(513) 557-2901

DEFENDANT'S EXHIBIT
I

Cease and Desist

TO: American Honda Motor Co., Inc.
Honda Automobile Legal Dept.
1919 Torrance Boulevard
Mail Stop: 500 - 2N - 7D
Torrance, CA 90501-2746

From: DealerDashboard.com
670 Northland Blvd.
PO Box 18137
Cincinnati, Ohio 45218-0137

Legal Department:

We are the owners of the trademark / service mark DealerDashboard and currently operate a website DealerDashboard.com. We offer services, since 1999, to automotive dealerships.

It has been brought to our attention that you are currently utilizing our trademark DealerDashboard to offer competing service to your dealer body. The use of our service mark can be found on your website:

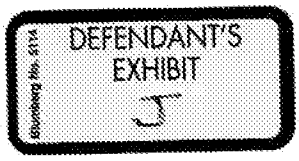
http://www.in.honda.com/RRAADCTM/Content/AAD/AD85/DashboardiNadmin.htmhttp://trade

We respectfully ask that you immediately cease and desist the use of our brand and remove all reference to the terms DealerDashboard or similar market confusing variations from all materials and search engines.

Your cooperation in this matter is appreciated.

Respectfully,

Michael Dalton
DealerDashboard.com
670 Northland Blvd.
Box 18137
Cincinnati, Ohio 45218-0137
(513) 557-2901



WILMERHALE

BY EXPRESS MAIL

June 30, 2006

Mark G. Matuschak

+1 617 526 6559 (t)
+1 617 526 5000 (f)
mark.matuschak@wilmerhale.com

Mr. Michael Dalton
DealerDashboard.com
670 Northland Blvd.
Box 18137
Cincinnati, Ohio 45218-0137

Dear Mr. Dalton:

I write on behalf of my client, American Honda Motor Co., Inc. ("Honda"), in response to your correspondence dated May 24, 2006, and follow-up telephone call to Honda counsel Laura Cuddy, about Honda's use of the terms "dealer dashboard" and "dashboard" on its internal network. For the reasons described below, Honda's use of these common terms is entirely lawful.

First, your claim to own the exclusive right to use the terms "dealer dashboard" and "dashboard" is mistaken. Both of these terms are either generic or, at best, descriptive and lacking in secondary meaning. As you must be aware, the term "dashboard" is a common term of art in the internet industry, denoting a user interface for organizing and displaying key information. Such a generic term "can never function as a trademark to indicate origin." *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 12:1, at 12-4 (4th ed. 2006) (a generic term is "[t]he name of a product or service itself - what it is - [and] is the very antithesis of a mark.") The addition of the generic word "dealer" before "dashboard" merely denotes a more specific type of dashboard and does not alter the conclusion that "dealer dashboard" is also generic. *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1161 (7th Cir. 1996) (where a composite term is "nothing more than the sum of [its] parts," the generic components will produce a generic composite) (citation omitted).

At best, the terms "dashboard" and "dealer dashboard" start their lives as the weakest of descriptive terms, ones that exist "perilously close to the 'generic' line." *Computerland Corp. v. Microland Computer Corp.*, 586 F. Supp. 22, 25 (N.D. Cal. 1984) (describing "Computerland" as extremely weak descriptive term that "literally communicates the goods and services offered by the plaintiff"). Such weak descriptive terms constitute valid trademarks only when accompanied by a strong showing of secondary meaning - that is, a showing that consumers view these terms as denoting a single seller or source. *See* 2 McCarthy on Trademarks and Unfair Competition § 11:25, at 11-55 ("The more descriptive the term, the greater the evidentiary burden on plaintiff to prove secondary meaning.") We firmly believe you would be unable to make such a showing with respect to either "dashboard" or "dealer dashboard."

Indeed, an examination of the real-world context belies your claim to exclusive use of the terms "dealer dashboard" and "dashboard." A quick internet search for the term "dealer dashboard" reveals multiple third parties who use the term "dealer dashboard" to denote a tool for presenting information. A search for the even more general term of art "dashboard" yields over 100 million hits. The fact that there are so many third parties that use these same terms is a strong indicator that they lack distinctiveness. *See* 2 McCarthy on Trademarks and Unfair Competition § 11:85, at 11-170.1 (in a crowded field "each member of the crowd is relatively 'weak' in its ability to prevent use by others in the crowd" and cannot be very distinctive).

Equally as significant, as you may know, trademark law protects only against other uses that are likely to cause confusion. Honda is not aware of *any* actual confusion between your use of the terms "dealer dashboard" and "dashboard" and Honda's use of these terms, nor do you mention the existence of any actual confusion in your letter. Frankly, it is difficult to imagine that actual confusion could exist given that you are complaining about Honda's use of these terms on its own *internal* network available only to authorized Honda dealers. The individuals that have access to Honda's network are sophisticated automotive specialists who are accessing Honda's "dealer dashboard" to obtain information pertaining to their dealership and other dealerships. There is simply no chance that they would confuse Honda's dashboard with your website. In the absence of actual and likely confusion, there is no basis for your request that Honda cease using "dealer dashboard" or "dashboard" in its relationship with Honda dealers.

Your attempt to register "DealerDashboard" as a trademark does not change this analysis. Furthermore, it is not clear, based on the information available, that you are using this term as you have claimed on the application. Specifically, your application states, in part, that you are "providing automotive dealerships managerial information concerning their Sales, Service and Parts departments key financial indicators of how their dealership is performing via the Internet." The pages you attached from your website do not appear to support this description. If you have additional information that supports your use of the term "DealerDashboard" as claimed in your application, please forward it to me.

Even if you are ultimately successful in obtaining a trademark registration for the term "DealerDashboard," trademark law protects only against confusing uses. As set forth above, there is no likelihood of confusion between your public website use and Honda's use on its internal dealer network. Nevertheless, in order to protect its rights, Honda has filed for an extension of time to oppose your registration.

Finally, as you must be aware, Honda's internal network is proprietary to Honda and only authorized users are allowed access to it. Not only does this eliminate any likelihood of confusion, but you are not, according to information supplied by Honda, such an authorized person. Your unauthorized access is itself a trespass on Honda's internal network, a violation of Honda's confidentiality and contract rights, and a violation of Honda's intellectual property rights. Accordingly, I must insist that you immediately stop your unauthorized access of Honda's proprietary network and provide me with information regarding how you obtained

access to this proprietary network so that Honda can ensure that its confidential information is adequately protected from unauthorized access.

Please confirm that the information set forth above fully resolves this matter. Thank you for your cooperation.

Very truly yours,

Mark G. Matuschak

DEFENDANT'S EXHIBIT K

Cease and Desist

To:
Mark Matuschaki
WilmerHale
60 State Street
Boston, Massachusetts 02109

Mark Matuschaki:

We are in receipt of your letter dated June 30, 2006 on behalf of your claimed client Honda. We find it vague, inconsistent and without merit.

Our brand, dealerdashboard, has been established exclusively for over 5 years and your claim that a product offering with the same name, general functions, and claimed internal somehow shields your client is laughable at best.

Your unwarranted pursuit of this matter shall be viewed as frivolous conduct. Additionally, your accusations regarding my organization, dealerdashboard, and myself is libelous and places you, your firm and client at risk.

You are hereby instructed to cease and desist your libelous claims and your client is instructed to immediately cease and desist the usage of dealerdashboard or similar confusing terms both public and internally when referring to similar competing products within the automotive industry. That being: an automotive portal with password protected area for dealerships to monitor and improve their sales, service, parts, and financial operations. The usage of Dealer and dashboard within the same page to a product once identified as dealer dashboard, while clever, is infringing on our brand.

Compliance with this order does not constitute acceptance or wavier of claims against yourself, firm and / or client, but, may mitigate damages.

Govern yourself accordingly.

http://DealerDashboard.com

http://DealerHotSpot.com

http://AllThingsAutomotiveDirectory.com

Regards,

Michael Dalton
PO Box 18137
Cincinnati, Ohio 45218
(513) 557-2901
(309) 215-9770 efax
DALTONME@hotmail.com

cc: email - return receipt requested
Us mail - confirmed delivery