ESTTA Tracking number: **ESTTA136613**
Filing date: **04/20/2007**

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

Proceeding	91173105
Party	Plaintiff Honda Motor Co., Ltd. Honda Motor Co., Ltd. ,
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Date	04/20/2007
Attachments	Opposer's Response to Motion to Dismiss.pdf (6 pages)(53513 bytes)

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

In the Matter of Application Serial No. 78/339,571
Published in the Official Gazette of May 30, 2006 at TM 674
MARK: DEALERDASHBOARD
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Honda Motor Co., Ltd.,

Opposition No. 91173105

Opposer,

v.

Michael Dalton,

Applicant.

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OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS, MOTION FOR SANCTIONS OR, IN THE ALTERNATIVE, MOTION TO STRIKE

Opposer Honda Motor Co., Ltd. ("Opposer" or "Honda") hereby responds to Applicant Michael Dalton's ("Applicant's") Motion to Dismiss, Motion for Sanctions or, in the Alternative, Motion to Strike in the above-captioned matter. Applicant's filing is untimely and, in any event, without merit.

On November 21, 2006, Honda served the following discovery requests on Applicant by first class mail: Opposer's First Set of Interrogatories to Applicant and Opposer's First Set of Requests for Documents and Things. Applicant did not provide any response to these discovery requests. After making a good faith effort to resolve this issue with Applicant, Honda filed a motion to compel on February 28, 2007. Applicant failed to provide any timely response to this motion. On April 5, 2007, Applicant emailed Honda the instant motion. Applicant suggests that this motion should also serve as an opposition to Honda's Motion to Compel Discovery. Although Opposer is uncertain as to how the Board will treat this paper, Opposer addresses each of Applicant's arguments below.

1. Applicant's Motion to Dismiss is Untimely.

As an initial matter, Applicant's Motion to Dismiss is untimely. Pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP") 503.01, "[w]hen the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer." Applicant filed his Answer in this proceeding on January 6, 2007, approximately three months before filing the instant motion. Accordingly, Applicant's Motion to Dismiss should be denied as untimely.

2. Applicant's Motion to Dismiss is Without Merit.

In any event, Applicant's Motion to Dismiss is meritless. Applicant appears to argue that the Board should dismiss Honda's Opposition because (1) the Board lacks jurisdiction over Honda, a Japanese corporation and (2) Honda has waived its right to oppose Applicant's registration by failing to file an opposition to another party's earlier attempt to register the term "Dealer Dashboard." *See* Defendant's Motion to Dismiss, Motion for Sanctions, or in the Alternative, Motion to Strike at 1-3. Both of these arguments should be rejected.

First, Honda is entitled to oppose Applicant's registration, and the Board has jurisdiction over this proceeding, regardless of Honda's status as a foreign corporation. Pursuant to Rule 2.101(b) of the Trademark Rules of Practice, "[a]ny person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board." *See also* TBMP 303.01 (same.) As Honda alleged in its Opposition, Honda uses and/or has used the terms DEALER DASHBOARD and DASHBOARD to describe a tool that presents information to its authorized automotive dealers in the United States and believes that it will be damaged by Applicant's registration of the mark DEALERDASHBOARD. Accordingly, Honda is

entitled to oppose Applicant's registration and Honda's status as a Japanese corporation is irrelevant to this conclusion.

Honda's failure to file an opposition to a third party's application to register the term "Dealer Dashboard" several years ago (which application was later abandoned) is also irrelevant to its current Opposition. Where, as here, Applicant was not in privity with this third party, Honda's failure to oppose this third party's prior registration does not result in estoppel or waiver. *See Magnavox Co. v. Multivox Corporation of America*, 52 C.C.P.A. 1025, 1029-30, 341 F.2d 139, 142 (1965) (opposer's failure to oppose prior registration for identical mark for a different product did not result in estoppel).[1]

3. <u>Applicant is Not Entitled to Sanctions.</u>

Applicant's assertion that Honda should be sanctioned for pursuing an Opposition that is supposedly meritless because the Board lacks jurisdiction over Honda and because the Opposition is intended to harass Applicant should also be summarily rejected. As discussed above, the Board does have jurisdiction over Honda and this proceeding. Moreover, Honda's Opposition – the merits of which Applicant does not address – is not intended to harass Applicant, but instead constitutes a legitimate challenge to Applicant's claim of exclusive rights in the generic (or, at most, descriptive) term DEALERDASHBOARD.

4. <u>Honda's Discovery Requests are Relevant to its Opposition.</u>

Finally, Applicant's motion to strike Honda's discovery requests and motion to compel should also be denied.[2] Contrary to Applicant's assertions, Honda's discovery

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[1] Moreover, as a general matter, laches is not available as a defense to an opposition that is based, as this one is, on the ground that the mark is generic or merely descriptive. *See Care Corporation v. Nursecare Int'l, Inc.*, 216 U.S.P.Q. 993, 995-96 (TTAB 1982); *Yankee, Inc. v. Geiger*, 216 U.S.P.Q. 996, 1000 (TTAB 1982); 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 20:36 at 20-80.6 (2007).

[2] Applicant also states that "[t]hese motions shall additionally serve as memorandum in opposition to opposers motion to compel discovery." Applicant's Motion to Dismiss, Motion for Sanctions or, in the Alternative, Motion to Strike at 5. However, pursuant to Rules 2.119(c) and 2.127(a) of the Trademark Rules of Practice, Applicant's response to Honda's Motion to Compel was due on March 20, 2007.

requests are relevant to its claim that Applicant's DEALERDASHBOARD mark is a generic term, or, at best, a merely descriptive term. The determination of "whether an alleged mark is generic involves a two-step factual analysis: First, what is the genus of goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?" *In re Gould Paper Corporation*, 834 F.2d 1017, 1018 (Fed. Cir. 1987) (internal citations and quotations omitted). The determination of whether or not an alleged mark is merely descriptive requires consideration of "the context in which the mark is used or intended to be used in connection with those goods or services [for which registration is sought], and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace." Jerome Gilson and Anne Gilson LaLonde, Trademark Protection and Practice § 1209.01(b) at 1200-149 (2005). Honda's discovery requests are relevant to both of these inquiries.

Moreover, Honda also alleged in its Opposition that Applicant failed to use the mark DEALERDASHBOARD on all of the good for which he seeks registration and that, as a result, his application contains false statements. Specifically, Honda alleged on information and belief that Applicant is not using the mark DEALERDASHBOARD in connection with "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet" as he has claimed in his application. Honda's discovery requests, including its requests for sales information, are also relevant to this inquiry.

Conclusion

For the reasons set forth above, Honda requests that the Board deny Defendant's Motion to Dismiss, Motion for Sanctions, or in the Alternative, Motion to Strike and grant Honda's Motion to Compel Discovery.

Dated: April 20, 2007

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposer's Response to Applicant Michael Dalton's ("Applicant's") Motion to Dismiss, Motion for Sanctions or, in the Alternative, Motion to Strike has been served on April 20, 2007 by First Class Mail to:

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By: /s/ Cora Tung Han
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