

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

gcp/jk

Mailed: February 29, 2008

Opposition No. 91173105

HONDA MOTOR CO., LTD.

v.

MICHAEL DALTON

By the Board:

This case is now before the Board for consideration of opposer's motion to compel (filed February 28, 2007), and applicant's motion to dismiss, motion for sanctions, or in the alternative motion to strike (filed April 2, 2007).<sup>1</sup>

We turn first to opposer's motion to compel, by which opposer seeks discovery responses from applicant pursuant to

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<sup>1</sup> Applicant has failed to effectuate proper service of any papers it has filed in this proceeding thus far. Such filings include applicant's two motions for an extension of time to answer, applicant's answer, and the motions currently under consideration. All parties to proceedings before the Board are required to comply in full with the requirements of Trademark Rule 2.119, which governs the service of any papers filed with the Patent and Trademark Office. The Board will decline to give consideration to any future filings by applicant which do not bear proper proof of service. To expedite matters, the Board includes a copy of applicant's motion to dismiss, motion for sanctions, and motion to strike with opposer's copy of this order.

Trademark Rule 2.120(e).<sup>2</sup> Specifically, opposer seeks responses to its first set of interrogatories, and first set of requests for documents and things, both of which it served on applicant on November 21, 2006. A copy of the interrogatories and requests accompanies opposer's motion, as does a copy of a January 11, 2007 letter wherein opposer addressed applicant's failure to serve its responses and requested such responses within a time certain.<sup>3</sup>

As movant, opposer has the burden of demonstrating that it has made a good faith effort, by conference or correspondence, to resolve the issues presented in the motion to compel. Trademark Rule 2.120(e).<sup>4</sup> We find that opposer, through its explanatory written communication of January 11, 2007 with applicant, has met this burden.

Furthermore, where a party fails to respond to a request for discovery during the time allowed therefore, and is unable

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<sup>2</sup>Within the body of its own motion filed on April 2, 2007, applicant addresses opposer's discovery requests. By operation of Trademark Rule 2.127(a), applicant's response to the motion to compel was due fifteen days from the date of service thereof. Accordingly, the Board treats that portion of applicant's own motion which addresses opposer's motion to compel as an untimely response thereto, and gives it no consideration. However, the Board will address the merits of opposer's motion in lieu of treating it as merely conceded.

<sup>3</sup>Although the Board did not issue a suspension order following opposer's filing of its motion to compel, the Board has nonetheless deemed these proceedings to have been suspended since the filing of opposer's motion. See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998) (proceedings deemed suspended as of the filing of the motion).

<sup>4</sup> See also TBMP §523.02 (2d ed. rev. 2004).

to show that its failure was the result of excusable neglect, such party may be found to have forfeited its right to object to the discovery request on its merits. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000), TBMP §403.03 (2d ed. rev. 2004).

Applicant did not respond to opposer's January 11, 2007 letter, and provides no excusable reason for its failure to serve timely discovery responses on opposer. Under these circumstances, we find no excusable neglect in applicant's failure to respond to opposer's discovery requests.

Accordingly, opposer's motion to compel responses to its first set of interrogatories, and first set of requests for documents and things, is granted. Applicant is allowed thirty (30) days from the date of this order in which to serve upon opposer full and proper responses thereto without objection.

We next turn to applicant's motion to dismiss. When raised by means of a motion to dismiss, the defense of failure to state a claim upon which relief can be granted must be filed before, or concurrently with, the movant's answer. Fed. R. Civ. P. 12(b).<sup>5</sup> Applicant filed his answer to the notice of opposition on January 6, 2007, and filed the motion to dismiss on April 2, 2007. Accordingly, the motion is denied as untimely.

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<sup>5</sup> See also TBMP §503.01 (2d ed. rev. 2004).

With respect to applicant's motion for sanctions or to strike, applicant appears to predicate its plea for such remedy, in substantial part, on assertions that opposer's motion to compel is an abuse of process. Such assertions constitute an untimely response to opposer's motion to compel, and, as noted herein above, are given no consideration. Moreover, applicant's motion lacks merit. The Board may entertain a motion for sanctions, where appropriately warranted and properly pled, pursuant to Trademark Rule 2.120(g)(1), a governing provision that delineates limited circumstances in which the Board may enter sanctions. Inasmuch as applicant himself has been found to be noncompliant with respect to his own discovery obligations, and inasmuch as applicant's motion fails to set forth either the specific sanction(s) it seeks or facts that form legal grounds for such relief, applicant's motion is denied.<sup>6</sup>

Proceedings herein are resumed. Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **5/30/2008**

Testimony period for party in position of plaintiff **8/28/2008**  
to close: (opening thirty days prior thereto)

Testimony period for party in position of defendant **10/27/2008**  
to close: (opening thirty days prior thereto)

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<sup>6</sup> We further note that the record before us fails to indicate any actions or omissions on the part of opposer which are sanctionable.

Rebuttal testimony period to close:  
(opening fifteen days prior thereto)

12/11/2008

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Information regarding pro se representation:

In this proceeding, all parties are expected to comply with the applicable rules and Board practices. Trademark Rule 10.14 permits any person or legal entity to represent itself in a Board proceeding, though it is strongly advised that those unfamiliar with the applicable rules secure the services of an attorney familiar with such matters.

The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern various aspects of this proceeding. The Trademark Trial and Appeal Board Manual of Procedure (TBMP) is also helpful. Any party

not represented by counsel is charged to be familiar with and to adhere to the rules governing this proceeding. The Trademark Rules are codified in Part Two of Title 37 of the Code of Federal Regulations (CFR). Some of these materials are available free of charge at the USPTO website: <http://www.uspto.gov>.

The parties are directed to pay particular attention to Trademark Rule 2.119, which requires a party filing any motion or correspondence with the Board to serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. The party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to: (1) the nature of the paper being served; (2) the method of service (e.g., first class mail, email); (3) the person being served and the address used to effect service; and (4) the date of service.

All correspondence and motions must be received by the Patent and Trademark Office by the due date therefor, unless one of the filing procedures set forth in Trademark Rules 2.197 or 2.198 is utilized.

Files of TTAB proceedings can be examined using TTABVue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any

entry in the prosecution history to view that entry in PDF format.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>