

ESTTA Tracking number: **ESTTA609136**

Filing date: **06/10/2014**

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

Proceeding	91203277
Party	Defendant Palm Beach Motoring Accessories, Inc.
Correspondence Address	LEO ZUCKER LAW OFFICE OF LEO ZUCKER 2591 DUNNING DRIVE, PO BOX 1177 YORKTOWN HEIGHTS, NY 10598-8177 UNITED STATES lzpatents@gmail.com
Submission	Motion to Dismiss 2.132
Filer's Name	Leo Zucker
Filer's e-mail	lzpatents@gmail.com
Signature	/Leo_Zucker/
Date	06/10/2014
Attachments	Brief.pdf(33027 bytes ) Zucker_Declaration.pdf(31420 bytes ) Exhibit_1.pdf(59390 bytes ) Exhibit_2.pdf(18257 bytes ) Exhibit_3.pdf(543712 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
Before the Trademark Trial and Appeal Board

3D International, LLC,	)	
a California Limited Liability Company,	)	
	)	Opposition Nos. <b>91203277 (parent)</b>
Opposer,	)	<b>91203279</b>
	)	
v.	)	Application No. 85-261,047
	)	Mark: AUTOPIA FORUM, in Class 38
Palm Beach Motoring Accessories, Inc.,	)	
a Florida Corporation,	)	Application No. 85-312,684
	)	Mark: AUTOPIAFORUMS, in Class 38
Applicant.	)	

**APPLICANT'S MOTION TO DISMISS PURSUANT TO 37 C.F.R. § 2.132(a)**

TO: Trademark Trial & Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Thomas W. Cook, Esq.,  
Thomas Cook Intellectual Properties  
3030 Bridgeway, Suite 425  
Sausalito, CA 94965

Law Office of Leo Zucker  
Attorney for Applicant  
P.O. Box 1177  
Yorktown Heights, NY 10598

Telephone: (914) 302-2460

June 10, 2014

Applicant, Palm Beach Motoring Accessories, Inc. (PBMA), by its undersigned attorney, hereby moves to dismiss the present opposition proceedings pursuant to 37 C.F.R. § 2.132(a). Annexed to and forming a part of this motion is a Declaration by Leo Zucker under 37 C.F.R. § 2.20 with Exhibits 1 to 3.

### FACTUAL BACKGROUND

The current trial schedule for these proceedings is as follows:<sup>1</sup>

Plaintiff's Pretrial Disclosures Due 4/11/2014  
Plaintiff's 30-day Trial Period Ends 5/26/2014  
Defendant's Pretrial Disclosures Due 6/10/2014  
Defendant's 30-day Trial Period Ends 7/25/2014  
Plaintiff's Rebuttal Disclosures Due 8/9/2014  
Plaintiff's 15-day Rebuttal Period Ends 9/8/2014.

On March 19, 2014, 3D filed a Motion to Extend Trial Dates, and PBMA filed a Response opposing the motion on March 25. Prior to any decision on the motion (which is still pending), 3D served its pretrial disclosures on PBMA four days after the above due date of April 11. 3D's pretrial disclosures are attached as Exhibit 1 to the accompanying Declaration. Apart from being untimely, PBMA submits the disclosures are deficient under 37 C.F.R. § 2.121(e).<sup>2</sup>

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<sup>1</sup> See Board Order of February 3, 2014, at p.3.

<sup>2</sup> See Zucker, par. 6.

In response to a proposal made by PBMA to 3D on May 20, 2014, for a settlement conference, 3D's attorney sent an email acknowledgment with an attached letter to PBMA's attorney on June 3. The email and the letter are annexed to the accompanying Declaration as Exhibits 2 and 3. The June 3 letter attempts to make an end run around 37 C.F.R. § 2.120(h)(1), by citing FRCP 33(b)(1) as authority for allowing 3D to obtain supplemental responses to its Requests for Admissions, Set Three. 3D's requests were served on PBMA one day before discovery closed on January 26.<sup>3</sup> PBMA served its responses and objections on 3D on March 3.<sup>4</sup>

Trademark rule 2.120(h) states that a party must move to determine the sufficiency of an answer or objection to a request for admission *prior* to the commencement of the first testimony period, however. Thus, 3D's opportunity to question the sufficiency of PBMA's responses or objections has long passed, and PBMA will not respond to the various requests set out in 3D's letter of June 3 unless ordered to do so by the Board.

Significantly, the 30-day period for 3D to take trial testimony ended on May 26, 2014, with no notification to PBMA of any trial testimony having been taken by

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<sup>3</sup> Zucker, at pars. 9-11.

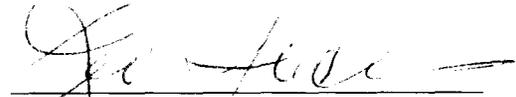
<sup>4</sup> *Id.*, at par. 10.

3D during its scheduled period.<sup>5</sup> While PBMA's pretrial disclosures are due today June 10, 2014, PBMA believes these proceedings should be dismissed now under 37 C.F.R. § 1.132(a) and has filed the present motion instead.

### CONCLUSION

In view of all the foregoing and the accompanying documents, 3D's present oppositions should be dismissed.

Respectfully submitted,



Leo Zucker, Attorney for Applicant  
Palm Beach Motoring Accessories, Inc.

Telephone: (914) 302-2460

June 10, 2014

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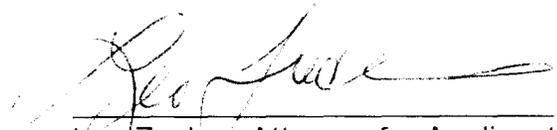
<sup>5</sup> Zucker, at par. 12.

CERTIFICATE OF SERVICE

I hereby certify that the within Applicant's Motion to Dismiss Pursuant to 37 C.F.R. § 2.132(a), together with a supporting Declaration of Leo Zucker with Exhibits 1-3, were served upon Opposer 3D International, LLC by depositing same with the U.S. Postal Service as first class mail in a sealed envelope, postage prepaid, and addressed to:

Thomas W. Cook, Esq.,  
Thomas Cook Intellectual Properties  
3030 Bridgeway, Suite 425  
Sausalito, CA 94965

on June 10, 2014.



Leo Zucker, Attorney for Applicant  
Palm Beach Motoring Accessories, Inc.

Dated: June 10, 2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
Before the Trademark Trial and Appeal Board

3D International, LLC,	)	
a California Limited Liability Company,	)	
	)	Opposition Nos. <b>91203277 (parent)</b>
Opposer,	)	<b>91203279</b>
	)	
v.	)	Application No. 85-261,047
	)	Mark: AUTOPIA FORUM, in Class 38
Palm Beach Motoring Accessories, Inc.,	)	
a Florida Corporation,	)	Application No. 85-312,684
	)	Mark: AUTOPIAFORUMS, in Class 38
Applicant.	)	

**DECLARATION OF LEO ZUCKER UNDER 37 C.F.R. § 2.20**

TO: Trademark Trial & Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Thomas W. Cook, Esq.,  
Thomas Cook Intellectual Properties  
3030 Bridgeway, Suite 425  
Sausalito, CA 94965

Law Office of Leo Zucker  
Attorney for Applicant  
P.O. Box 1177  
Yorktown Heights, NY 10598

Telephone: (914) 302-2460

June 10, 2014

LEO ZUCKER, hereby deposes and states as follows:

1. I am over 18 years of age, and I have personal knowledge of all matters set forth below.
  
2. I am an attorney at law, admitted to practice in the Courts of the State of New York and before the United States Patent and Trademark Office. I represent the applicant Palm Beach Motoring Accessories, Inc. (PBMA) in the present consolidated opposition proceedings.
  
3. I make this declaration in support of PBMA's present motion to dismiss these proceedings pursuant to 37 C.F.R. § 2.132(a).
  
4. In an Order dated February 3, 2014, the Board reset the trial schedule for these proceedings as follows:
  - Plaintiff's Pretrial Disclosures Due 4/11/2014
  - Plaintiff's 30-day Trial Period Ends 5/26/2014
  - Defendant's Pretrial Disclosures Due 6/10/2014
  - Defendant's 30-day Trial Period Ends 7/25/2014
  - Plaintiff's Rebuttal Disclosures Due 8/9/2014
  - Plaintiff's 15-day Rebuttal Period Ends 9/8/2014

5. To date, the schedule has not been further reset by the Board, and no stipulation concerning the schedule has been entered into by the parties.

6. 3D served its pretrial disclosures on PBMA on April 15, 2014. See annexed Exhibit 1. The disclosures were therefore untimely, and also deficient. For example, while naming two individuals who may present testimony on behalf of 3D, the disclosures failed to provide a summary or list of subjects on which each witness is expected to testify, together with a summary or list of the types of documents and things that may be introduced as exhibits during the testimony of each witness on such subjects. 37 C.F.R. § 2.121(e).

7. Annexed hereto as Exhibit 2 is an email I received from 3D's attorney on June 3, 2014. The email acknowledges receipt of a proposal PBMA sent to 3D on May 20 to hold a settlement conference among persons with authority to bind the parties, in hopes of resolving this dispute on mutually beneficial terms rather than going forward herein. To date, 3D has not agreed to participate in such a conference.

8. Annexed as Exhibit 3 is a letter from 3D's attorney dated June 3, 2014, which 3D's attorney attached to his email of Exhibit 2.

9. At page 1 of the June 3 letter and citing FRCP 33(b)(1), 3D requests

PBMA to supplement its responses to 3D's Requests for Admissions, Set Three, and asks "to meet and confer regarding supplemental responses." The remainder of the letter sets out 3D's alleged deficiencies in PBMA's responses including most if not all of PBMA's objections.

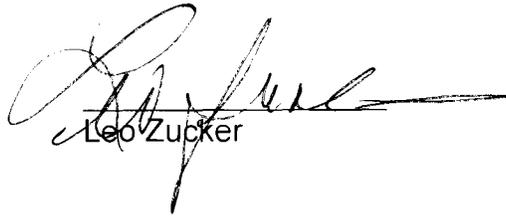
10. 3D first served its Requests for Admissions, Set Three, on January 25, 2014, *i.e.*, *one day* before the close of discovery in these proceedings. I received the requests on February 3 by first class mail and forwarded them promptly to PBMA. Individuals at PBMA and I worked many hours to ensure each of the 205 requests received a proper response or objection under the applicable rules. The responses and objections were served on 3D on March 3, 2014.

11. PBMA has chosen not to respond to 3D's email or letter of June 3, 2014, because 3D could have moved timely under 37 C.F.R. § 2.120(h)(1) to test the sufficiency of PBMA's responses to 3D's Third Set of Requests for Admissions, but it chose not to do so. 3D thus waived its right to the supplemental responses it now requests.

12. The 30-day period for 3D to take trial testimony ended on May 26, 2014. PBMA was not notified by 3D or otherwise made aware that 3D took any trial testimony during the scheduled period.

13. Under the present schedule, PBMA's pretrial disclosures are due today, June 10, 2014. Because PBMA believes these proceedings should now be dismissed on account of 3D's failure to take testimony, and in the interests of judicial economy, PBMA has instead filed the present motion to dismiss.

14. I further declare that all statements made of my own knowledge are true, and all statements made on information and belief are believed to be true, and that I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the opposed applications or documents or any registrations resulting therefrom.



Leo Zucker

Dated: June 10, 2014

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

3 In the Matter of Trademark Application Serial No. 85261047

4 Mark:           AUTOPIA FORUM

5 \_\_\_\_\_ )  
6 3D International, LLC )  
7                                   Opposer. )  
8                                   v. )                                   Opposition No. 91203277  
9 Palm Beach Motoring Accessories, Inc. )                                   OPPOSER'S PRETRIAL  
10                                   Applicant. )                                   DISCLOSURES  
11 \_\_\_\_\_ )

12  
13                   Opposer 3D International, LLC ("3D") hereby makes its pretrial disclosures pursuant to  
14 37 C.F.R. § 2.121(e).

- 15  
16 1.       The following individuals may present testimony to support 3D's claims or defenses:  
17  
18       a.       Serra Goren, 3D International, LLC, 20724 Centre Pointe Parkway, Unit 1,  
19               Santa Clarita, California 91350; and  
20  
21       b.       Tunch Goren, 3D International, LLC, 20724 Centre Pointe Parkway, Unit 1,  
22               Santa Clarita, California 91350.  
23  
24 2.       The following documents and tangible things may be introduced as exhibits during  
25 testimony, which documents are generally located at the offices of Opposer's counsel or  
26 at 3D's primary business address at 20724 Centre Pointe Parkway, Unit 1, Santa Clarita,  
27 California, and/or have been produced in this opposition action in response to Applicant's  
28 discovery requests:

- 1 a. Copies of all correspondence between representatives of Palm Beach Motoring  
2 Accessories, Inc. and representatives of Opposer.  
3
- 4 b. The applications filed with the United States Patent and Trademark Office, serial  
5 numbers 85261047 and 85312684.  
6
- 7 c. Screen shots of web pages for autopia.org and (Internet Archive) The Wayback  
8 Machine screenshots for this domain name.  
9
- 10 d. Copies of any or all responses served by Applicant on discovery propounded by  
11 Opposer, and any and all responses served by Opposer on discovery propounded  
12 by Applicant in this matter, including but not limited to the following:  
13
- 14 1. Applicant's Responses to Opposer's Requests for Admission, Set One,  
15 served by Applicant on May 16, 2013.  
16
  - 17 2. Applicant's Responses to Opposer's Requests for Production of  
18 Documents and Things, Sets One and Two, served by Applicant on May  
19 28, 2013.  
20
  - 21 3. Applicant's Responses to Opposer's Interrogatories, Sets One and Two,  
22 served by Applicant on May 28, 2013.  
23
  - 24 4. Applicant's Responses to Opposer's Requests for Admissions, Set Two,  
25 served by Applicant on May 17, 2013.  
26
  - 27 5. Applicant's Responses to Opposer's Requests for Admissions, Set Three,  
28 served by Applicant on March 3, 2014.



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**PROOF OF SERVICE BY U.S. MAIL**

I hereby declare:

I am over the age of 18 years and am not a party to the within cause. I am employed in Sausalito, California. My business address is 3030 Bridgeway, Suite 425, Sausalito, California. My mailing address is P.O. Box 1989, Sausalito, California 94966.

On the date first written below, I served a true copy of the attached document entitled:

**OPPOSERS'S PRETRIAL DISCLOSURES**

by placing it in a sealed envelope and depositing it in the United States mail, first class postage fully prepaid, addressed to the following:

Law Office of Leo Zucker  
P. O. Box 1177  
Yorktown Heights, NY 10598-8177  
Attention: Leo Zucker

Date: April 15, 2014

  
\_\_\_\_\_  
Kay Home

## Leo Zucker

---

**From:** Thomas Cook [tom@thomascooklaw.com]  
**Sent:** Tuesday, June 03, 2014 9:06 PM  
**To:** Leo Zucker  
**Subject:** Re: 3D v. PBMA "Autopia" oppositions  
**Attachments:** 2014 06 03 - LT Zucker - Meet and Confer.pdf

Dear Leo:

We are still considering the proposal outlined in your email of May 20; it is not lost. I will get back to you as soon as possible with a response.

In the meantime, I have finally begun to catch up after my recent absence, and I have had an opportunity to review APPLICANT'S RESPONSES TO OPPOSER'S REQUESTS FOR ADMISSIONS, SET THREE (the "Responses"), served March 3, 2014. I attach a courtesy copy of our "meet and confer" letter, which outlines our thoughts and requests for supplemental responses (also posted today).

Regards,

Thomas.

-  
--  
---

\*Thomas Cook Intellectual Property Attorneys\* P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989  
Telephone: 415-339-8550

---

On 5/23/2014 5:27 PM, Thomas Cook wrote:

> Dear Leo:  
>  
> Received, with thanks, and sorry about the delay in this response. I  
> (strangely) found your email in a "trash" folder. I will attempt to "filter" your messages to inbox.  
>  
> I will contact Mr. Goren about the suggested arrangement, and return shortly.  
>  
> Thomas.  
> -  
> --  
> ---  
> \*Thomas Cook Intellectual Property Attorneys\* P.O. Box 1989, 3030  
> Bridgeway, Suite 425-430 Sausalito, California 94965-1989  
> Telephone: 415-339-8550  
>  
> \_\_\_\_\_  
>

> On 5/20/2014 3:03 PM, Leo Zucker wrote:

>>  
>> Dear Thomas,  
>>

EXHIBIT 2- 1/2-

>> In an attempt to avoid having our clients incur much additional time  
>> and expense to litigate these proceedings to a final hearing, would  
>> 3D consider participating in a settlement conference call with PBMA  
>> during the next two weeks? I think you would agree that, as it now  
>> stands, there is little to be gained ultimately by either party if the proceedings are allowed to continue.  
>>

>> PBMA is open to resolving this matter on mutually beneficial terms,  
>> including, /for example/, having each party consent to and not  
>> challenge the other party's usage of "Autopia" in their domain names  
>> and on their web pages, withdrawing each party's pending "Autopia"  
>> applications, and agreeing not to register any marks including  
>> "Autopia" (alone or combined) for either party's business as long as the other party remains actively in  
business.

>>  
>> If 3D agrees to confer, it would of course facilitate things if Mr.  
>> Goren and/or others with binding authority participate for 3D. Mr.  
>> McKee and/or others with like authority will be available to participate for PBMA.  
>>

>> Thank you for your consideration.

>>  
>> Regards,

>> Leo

>> /Law Office of Leo Zucker /

>>  
>> /Patent & Trademark Law /

>>  
>> PO Box 1177

>>  
>> Yorktown Heights, NY 10598

>>  
>> Tel (914) 302-2460

>>  
>> Fax (914) 302-2459

>>  
>> /This e-mail and any attached files or items are proprietary and  
>> subject to attorney-client or work product privileges. The use or  
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>>  
>

T H O M A S C O O K

---

INTELLECTUAL PROPERTY ATTORNEYS

June 3, 2014

Leo Zucker, Esq.  
Law Office of Leo Zucker  
PO Box 1177  
Yorktown Heights, NY 10598-8177

Re: Opposition - 91203277 (Parent) - AUTOPIA FORUM  
3D International LLC v. Palm Beach Motoring Accessories, Inc. -

Dear Leo:

I refer to OPPOSER'S REQUESTS FOR ADMISSIONS, SET THREE, served January 25, 2014 (the "Requests") by Opposer 3D International LLC ("3DIN") on Applicant Palm Beach Motoring Accessories, Inc. ("PBMA"), and PBMA'S responses thereto, served March 3, 2014.

This letter comes, pursuant to the federal rules governing discovery, as a request for a conference to meet and confer regarding supplemental responses. Specifically, we request:

- I. PBMA supplement its responses under FRCP 33(b)(1), that is, supplement APPLICANT'S RESPONSES TO OPPOSER'S REQUESTS FOR ADMISSIONS, SET THREE (the "Responses"), and
- II. PBMA's supplemental responses should be prepared in the appropriate form, i.e., as to each individual request:
  - a. each request of the Requests, as initially posed,
  - b. immediately followed by PBMA's initial response thereto, stated fully as served on March 3, 2014, without deletions, changes, or interlineations, and
  - c. immediately followed by PBMA's response as supplemented.

Applicant PBMA's Responses to Opposer 3DIN's Requests are deficient in the following ways:

A. Objection That Requests Are "Vague and Ambiguous"

In a number of instances, PBMA's Responses object to the Requests of 3DIN "on the ground that the request is vague and ambiguous." These objections arise in a number of contexts within the Requests (see below), however we can refer to them generally here, and ask for supplemental responses as to them all. PBMA is obligated to respond to discovery and, as responding party, it is PBMA's burden to justify its objections or failure to provide a complete answer. Further, to avoid the conclusion that PBMA's response is evasive, PBMA may reasonably qualify its response to enable an answer. However, PBMA has not "reasonably qualified" its lack of answers in these cases. We refer specifically to PBMA's objections on this ground to the following language in the following numbered Requests:

1. the phrase "some contact information": Requests 184, 185.
2. the phrase "the company": Requests 184, 188, 189, 190, 193, 194, 201, 202, 205, 206 (first request, with correct number), 222, 223, 320, 323, 325, 326, 333, 334, 343, 347, 349, 351, 367, 370, 371, 372, 373.
3. the word "maintained": Requests 198, 199, 203.
4. the word "autopia": Requests 206 (second request, with incorrect number).
5. the phrase "the Autopia forums": Requests 207.
6. the phrase "the announcement": Requests 223.
7. the phrase "are links which will be found: Request 227.
8. the phrase "are associated with Opposer's web site": Request 228.
9. the phrase "are links at which the company....placed advertisements": Request 229.
10. the phrase "are links at which the Applicant placed advertisements": Request 230.
11. the phrase "the web site at which the word 'autopia' appears": Request 267.

12. the phrase “the web site at which the word ‘autopia’ appears as a service mark”: Request 268.
13. the phrase “the web site at which the word ‘autopia’ appears at the top left corner”: Request 269.
14. the phrase “the web site at which the design appears at the top left corner, within which design the word ‘autopia’ may be read”: Request 270.
15. the phrase “presenting”: Request 304.
16. the phrase “appear to be”: Requests 325, 326, 327.
17. the phrase “at the web site at which appears at the web site”: Request 327.
18. the phrase “information about”: Requests 329, 330, 331, 332, 333, 334.
19. the phrase “is associated with”: Request 343.
20. the phrase “contains information”: Requests 348, 349.
21. the phrase “the information”: Request 346, 347.
22. the phrase “some of the documents”: Requests 357, 361, 362, 363.
23. the phrase “and others”: Request 357.

PBMA has responded to these Requests with the objection that the referenced phrases and words are “vague and ambiguous.”

We can of course discuss the vagueness and ambiguousness of these Requests, however for your present guidance when responding to these Requests, PBMA has in most cases objected to these phrases and words as they are used by 3DIN to refer to materials found in specific numbered documents. In this context, the meaning of the phrases and words to which PBMA has objected are clear, and neither vague nor ambiguous.

In the event some use of the phrases and words 3DIN has used in these Requests may be considered either vague or ambiguous, PBMA has an obligation to respond to these Requests as best it can. In some cases, this may require PBMA assume or state a meaning for these phrases and words it considers vague or ambiguous, and provide a response which contains an answer (and not just an objection).

We will advise on the meaning of these phrases and words if we must. However, we should also note that the phrases and words to which PBMA has objected are not complex or arcane. We invite you PBMA to use any dictionary of its choosing to determine the meaning of these words, and respond with full and complete answers with those meanings in mind.

3D will provide additional time for PBMA to provide its supplemental responses to these Requests.

B. Response That Documents Or Information “Purport to Be”

We secondly note that PBMA has in many of its Responses to these Requests merely evaded a direct response. We see this primarily in its use of the phrases “purport to be” and “purport to” and “appears to be” when referring to a specific document, under circumstances where PBMA must be in a position to have knowledge about the document, or about information which appears on that document.

In these cases, PBMA is in a position to say whether the document is, or is not, and whether the information is, or is not. PBMA need not look at the document on its face, and conclude it cannot say whether the information on that document is accurate. Similarly, it need not so conclude merely because it does not recognize the formatting of that document, or the source of information on that document, or for other reasons. Instead, PBMA can say whether the information which appears on that document is accurate, and admit or deny, or otherwise respond with a substantive answer.

We believe the phrases “purport to be” and “purport to” and “appears to be” are used improperly in this way in the following Responses: 183, 196, 243, 242, 244, 245, 246, 247, 248, 249, 250, 253, 288, 292, 293, 341, 342, 366, 368, 369, and 379.

Similarly, we believe the phrase “contains a reference to” is used improperly in this way in the following Responses: 292 and 293. Again, PBMA is in a position to know if the reference PBMA acknowledges is so contained does in fact relates to PBMA. PBMA therefore cannot merely say that document “contains a reference to” the requested information (about PBMA).

C. Objection That Documents Were Not Received

Finally, we note PBMA has objected to some of 3DIN’s Requests on the basis that PBMA did not received the documents to which 3DIN refers in those Requests. PBMA has concluded that non-receipt of documents results in Requests which are (a special form of) “vague and ambiguous” (rather thank for instance, request copies of such documents).

Leo Zucker, Esq.

June 3, 2014

Page 5

We refer here specifically to Requests 380 through 387, which refer to documents numbered 3D-0241 through 3D-0252, documents numbered 3D-0260 through 3D-0262, and documents numbered 3D-0260 through 3D-0262.

Our records show 3DIN served the Requests on January 25, 2014, as stated above, and that the Requests included documents numbered 3D-0241 through 3D-0252, documents numbered 3D-0260 through 3D-0262, and documents numbered 3D-0260 through 3D-0262. However, it is of course possible these documents were not received, or they were misplaced, or for some other reason PBMA thought it could not respond to Requests 380 through 387.

3DIN believes it is still entitled to responses to Requests 380 through 387, however, and in the interest of advancing these cases, 3DIN now supplies additional copies of:

1. documents numbered 3D-0241 through 3D-0252, for PBMA's responses to Requests 380 and 381.
2. documents numbered 3D-0260 through 3D-0262, for PBMA's responses to Requests 382 and 383.
3. documents numbered 3D-0265 through 3D-0267, for PBMA's responses to Requests 384, 385, 386 and 387.

We require PBMA to now respond to 3DIN's Requests which are enumerated above, as posed, with supplemental responses in the form set forth above.

Kindly call me when you receive this letter to discuss how and when PBMA will go about fulfilling its discovery obligations.

Sincerely,

A handwritten signature in blue ink that reads "Thomas W. Cook". The signature is fluid and cursive, with the first name "Thomas" being the most prominent.

Thomas Cook.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
Before the Trademark Trial and Appeal Board

3D International, LLC, )  
a California Limited Liability Company, )  
 )  
Opposer, )  
 )  
v. )  
 )  
Palm Beach Motoring Accessories, Inc., )  
a Florida Corporation, )  
 )  
Applicant. )

Opposition Nos. **91203277 (parent)**  
**91203279**

Application No. 85-261,047  
Mark: AUTOPIA FORUM, in Class 38

Application No. 85-312,684  
Mark: AUTOPIAFORUMS, in Class 38

**APPLICANT'S MOTION FOR SUMMARY JUDGMENT  
WITH BRIEF, DECLARATIONS, AND EXHIBITS**

TO: Trademark Trial & Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Thomas W. Cook, Esq.,  
Thomas Cook Intellectual Properties  
3030 Bridgeway, Suite 425  
Sausalito, CA 94965

Law Office of Leo Zucker  
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October 13, 2012

3D-0241

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## INTRODUCTION

Applicant Palm Beach Motoring Accessories, Inc. (PBMA), by its undersigned attorney, hereby moves for summary judgment in both of the above consolidated opposition proceedings under Rule 56(a) of the Federal Rules of Civil Procedure. PBMA submits that there is no genuine dispute concerning any material fact with respect to the lawful right of PBMA to register AUTOPIAFORUMS and AUTOPIA FORUM as presently applied for in Class 38, and that both opposition proceedings should be dismissed. An order suspending the proceedings pending disposition of the motion is also requested per 37 C.F.R. § 2.127(d). The motion is based on the within brief, and the annexed Declarations of Jason Sierra, Robert McKee, and Leo Zucker, with associated Exhibits.

## FACTUAL BACKGROUND

These proceedings were commenced by 3D International, LLC (3D) by Notices of Opposition both dated January 6, 2012. On January 13, proceedings on an application by 3D to register AUTOPIA<sup>1</sup> in classes 35, 38, and 41 were suspended until PBMA's presently opposed applications to register AUTOPIAFORUMS<sup>2</sup> and AUTOPIA

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<sup>1</sup> Application No. 85-338,384 filed June 6, 2011.

<sup>2</sup> Application No. 85-312,684 filed May 4, 2011.

FORUM,<sup>3</sup> and a third application by PBMA to register AUTOPIA CAR CARE<sup>4</sup> in classes 35 and 41, were either granted or abandoned.<sup>5</sup> The parties made their initial disclosures and, with PBMA's consent, 3D filed a motion with the Board on May 24, 2012, to consolidate the present proceedings. The motion was granted on August 24, 2012.

### The Parties

#### *Applicant PBMA*

Applicant PBMA is a Florida corporation which since 1999 has provided "exceptional customer service, educational information, and automotive detailing products for professional detailers, show car owners, and people who simply love their car."<sup>6</sup> PBMA's services have always been and continue to be rendered exclusively on-line via the Internet. Presently, customers can purchase car care products and obtain detailing information through PBMA's website at *autopia-carcare.com*.<sup>7</sup> The home page of *autopia-carcare.com* is headed with the AUTOPIA CAR CARE mark which is now

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<sup>3</sup> Application No. 85-261,047 filed March 8, 2011.

<sup>4</sup> Application No. 85-264,259 filed March 11, 2011.

<sup>5</sup> Zucker, par. 4, Exhibit 1.

<sup>6</sup> McKee, par 3.

<sup>7</sup> McKee, par. 4, Exhibit 1.

pending.<sup>8</sup> Several site navigation tabs are displayed beneath the home page heading, including a “Forum” tab that links users to an associated detailing forum the home page of which is headed by PBMA’s presently opposed mark AUTOPIAFORUMS.<sup>9</sup> There, users can exchange messages among one another relating to the cleaning, polishing, and detailing of their vehicles.

The *autopia-carcare.com* domain name and all property rights including trademark rights related to the AUTOPIA CAR CARE website, were transferred to PBMA by way of a Purchase Agreement dated February 10, 2011 (the PBMA Agreement).<sup>10</sup> According to Section 1 of the Agreement, PBMA acquired from the then current owners:

“their entire right, title and interest in and to the Domain Name *www.Autopia-Carecare.com*, . . . , trademark rights, copyrights to pages designed for the website, page layouts for the website, all graphics used in the website, all data bases generated for the website, on-line forms and search engines created and currently used for the website, all banner advertisements for the website, the banner advertisement network for the website, and all internet traffic to the Domain Name . . . .”, including an

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<sup>8</sup> See note 4, *supra*.

<sup>9</sup> McKee, par. 5.

<sup>10</sup> McKee, par 6, Exhibit 2.

End User Email List.<sup>11</sup>

Further, in Section 4 of the PBMA Agreement, the sellers agreed they would “not create a website similar to the website currently at *www.Autopia-Carcare.com*,” and that the Agreement would “be deemed to prohibit Seller’s creation of any such similar website or the use of the Domain Name and Internet traffic to the Domain Name set forth in Section 1.”<sup>12</sup>

Section 8 of the PBMA Agreement sets forth another non-compete provision wherein the sellers agreed, *inter alia*, that they “shall not use the name ‘Autopia’ in connection with any car care product sales or otherwise.”<sup>13</sup>

The Internet domain name *autopia-carcare.com* was first created March 12, 1999,<sup>14</sup> and the associated website has used the mark AUTOPIA CAR CARE continuously on the home page.<sup>15</sup> Attached as Exhibit 2 to the Declaration of Jason Sierra are 14 specimens of the website home page for each year from 1999 to 2012.

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<sup>11</sup> McKee Exhibit 2, page 1, Section 1.

<sup>12</sup> McKee Exhibit 2, page 2, Section 4.

<sup>13</sup> McKee Exhibit 2, page 3, Section 8.

<sup>14</sup> Sierra, par. 3, Exhibit 1.

<sup>15</sup> Sierra, par. 4, Exhibit 2.

As seen, for example, at pages 2 and 10 of Exhibit 2, the home page has over the years enabled access to an on-line forum by way of a tab or link provided on the page. Activity at the AUTOPIA CAR CARE website is represented graphically at the top of each page of Exhibit 2. The first customer orders made through the website occurred on April 21, 22, and 23, 1999, and are documented in Sierra Exhibit 3.<sup>16</sup>

Before purchasing the domain name *autopia-carcare.com* and related property rights, PBMA created and continues to operate a popular on-line forum for automotive detailing enthusiasts.<sup>17</sup> Consistent with the trademark rights it acquired with the AUTOPIA CAR CARE website, PBMA renamed its forum to AUTOPIAFORUMS, provided a link to the forum on the website home page,<sup>18</sup> and applied to register AUTOPIAFORUMS in Class 38 on May 4, 2011. Earlier, on March 8, 2011, PBMA applied to register AUTOPIA FORUM also in Class 38. Both marks were published for opposition on November 8, 2011, and 3D commenced the present proceedings on January 6, 2012.

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<sup>16</sup> See Sierra, par. 5, Exhibit 3.

<sup>17</sup> The forum was originally named "Detail City". See McKee, par. 5.

<sup>18</sup> See McKee Exhibit 1.

*Opposer 3D*

Through its present website at *autopia.org*, 3D describes itself as a source of high quality car care products including car care chemicals and auto detailing accessories. Products are sold on-line and distributed by 3D stores.<sup>19</sup> The domain name for 3D's current website, *autopia.org*, was acquired by 3D by way of a Website Sales Agreement dated May 11, 2009 (the 3D Agreement) between the then owner and seller of the domain name, David W. Bynon, and 3D<sup>20</sup>. By the Agreement, 3D purchased:

- “(a) The *autopia.org* domain name (URL);
- (b) Member accounts [excised];
- (c) Website contents, including all community posts, articles, images and other electronic files;
- (d) All transferable software licenses in use to support website operations;
- (e) All software components created by the Seller to integrate (the ‘site’).”<sup>21</sup>

Notably, the 3D Agreement did not assign or transfer to 3D any trademark

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<sup>19</sup> See *www.autopia.org*, link to Store > Our Company > About Us.

<sup>20</sup> Sierra, par. 6, Exhibit 4.

<sup>21</sup> Sierra Exhibit 4, page 1, clause 1.

rights that may have accrued to Bynon in relation to any websites located at *www.autopia.org* during his ownership of the domain name. Nor did the 3D Agreement include any non-compete provisions as were provided in Sections 4 and 8 of PBMA's Agreement. That is, Bynon did not agree he would not create a website similar to one then located at *www.autopia.org*, or that he would not use the name "Autopia" in connection with any car care product sales or otherwise.

On June 6, 2011, 3D filed an application<sup>22</sup> to register AUTOPIA in classes 35, 38, and 41 for various on-line services relating to auto detailing, including a forum. In its application, 3D alleges a date of first use in all three classes of October 17, 1999. As mentioned earlier, proceedings on 3D's application to register AUTOPIA have been suspended since January 13, 2012.

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<sup>22</sup> No. 85-338,384. See Zucker, par. 5, Exhibit 2.

ARGUMENT

I. The 3D Agreement to Purchase the Domain Name *www.autopia.org* Did Not Convey Any Related Trademark Rights That May Have Accrued to the Seller

Without the benefit of any trademark rights related to the associated website, 3D's acquisition of the domain name *autopia.org* alone would not entitle 3D to claim the benefit of any use of AUTOPIA as a trademark before the date of the 3D Agreement.<sup>23</sup> See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 U.S.P.Q.2d 1545, 1556 (9<sup>th</sup> Cir. 1999). See also, *interState Net Bank v. NetB@nk Inc.*, 348 F.Supp.2d 340, 77 U.S.P.Q.2d 1015, 1022-24 (D.N.J. 2004)(trademark registration for NETBANK held not validly assigned without transfer of the accompanying goodwill).

As noted above, the prior owner of the *autopia.org* domain name is free to start up and to operate a competing detailing forum called "Autopia" or a confusingly similar name on the Web, using any other available domain name without violating any of the terms of the 3D Agreement. No clause in the 3D Agreement precludes Mr. Bynon from creating a website similar to the one he maintained at *www.autopia.org*, or from using AUTOPIA in connection with car care products, forums, or otherwise.

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<sup>23</sup> May 11, 2009.

Inasmuch as 3D did not acquire exclusive rights to AUTOPIA as a trademark via the 3D Agreement, 3D can not properly claim the benefit of any prior use of AUTOPIA in its present application to register the mark.<sup>24</sup>

II. PBMA Has Priority Over 3D With Respect to the Use of AUTOPIA Alone or Combined With FORUM for On-Line Detailing Forums

By way of the accompanying Declarations and documentary exhibits, PBMA has demonstrated that in addition to acquiring the *autopia-carcare.com* domain name, PBMA is clearly entitled to the benefit of its predecessors' continuous use of AUTOPIA CAR CARE as a service mark dating back to the first order placed via that website on April 21, 1999, *i.e.*, almost six months *prior* to 3D's currently alleged date of first use of AUTOPIA. Moreover, PBMA's effective first use date of April 21, 1999, for AUTOPIA CAR CARE is over ten years prior to May 11, 2009, when 3D acquired the *autopia.org* domain name.

Further, 3D has conceded that the name AUTOPIA "is highly distinctive,

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<sup>24</sup> No. 85-338,384 for AUTOPIA in classes 35, 38, and 41, which alleges a first date of first use of October 17, 1999, for all three classes.

CERTIFICATE OF SERVICE

I hereby certify that the within Motion for Summary Judgment with annexed Declarations and Exhibits were served upon Opposer 3D International, LLC, by depositing same with the U.S. Postal Service as first class mail, postage prepaid, in an envelope addressed to:

Thomas W. Cook, Esq.,  
Attorney for 3D International, LLC  
Thomas Cook Intellectual Properties  
3030 Bridgeway, Suite 425  
Sausalito, CA 94965

on October 13, 2012.

  
Leo Zucker, Attorney for Applicant  
Palm Beach Motoring Accessories, Inc.

Date: October 13, 2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
Before the Trademark Trial and Appeal Board

3D International, LLC, )  
a California Limited Liability Company, )  
 )  
Opposer, )  
 )  
v. )  
 )  
Palm Beach Motoring Accessories, Inc., )  
a Florida Corporation, )  
 )  
Applicant. )

Opposition Nos. **91203277 (parent)**  
**91203279**

Application No. 85-261,047  
Mark: AUTOPIA FORUM, in Class 38

Application No. 85-312,684  
Mark: AUTOPIAFORUMS, in Class 38

**DECLARATION OF ROBERT McKEE WITH EXHIBITS**

TO: Trademark Trial & Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Thomas W. Cook, Esq.,  
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P.O. Box 1177  
Yorktown Heights, NY 10598

Telephone: (914) 302-2460

3D-0260

ROBERT McKEE, hereby deposes and states:

1. I am over 18 years of age, and I have personal knowledge of all matters set forth below.
  
2. I am the President of Palm Beach Motoring Accessories, Inc. (PBMA), the applicant in the present opposition proceedings.
  
3. Since at least as early as 1999, PBMA has provided exceptional customer service, educational information, and automotive detailing products for professional detailers, show car owners, and people who simply love their car.
  
4. PBMA's services are rendered exclusively on-line via our website at *www.autopia-carcare.com*. Exhibit 1 hereto is a specimen of our current website home page which is headed AUTOPIA CAR CARE. Customers can purchase various products for cleaning, polishing, and detailing their vehicles through the home page, obtain newsletters on the subject of automotive detailing, and be directed to PBMA's on-line detailing forum by clicking on a "Forum" tab beneath the heading.
  
5. PBMA's detailing forum, originally named "Detail City", was renamed

AUTOPIAFORUMS after PBMA acquired the domain name *www.autopia-carcare.com* together with all related trademark and other property rights by way of a Purchase Agreement dated February 10, 2011. The forum now resides on the Web at *autopiaforums.com*.

6. A copy of the Purchase Agreement referred to in paragraph 5 above is attached to this Declaration as Exhibit 2.

7. I further declare that all statements made of my own knowledge are true, and all statements made on information and belief are believed to be true, and that I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the opposed applications or documents or any registrations resulting therefrom.

  
Robert McKee

Date: 06/12/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Trademark Trial and Appeal Board

3D International, LLC, )  
a California Limited Liability Company, )  
 )  
Opposer, )  
 )  
v. )  
 )  
Palm Beach Motoring Accessories, Inc., )  
a Florida Corporation, )  
 )  
Applicant. )

Opposition Nos. **91203277 (parent)**  
**91203279**

Application No. 85-261,047  
Mark: AUTOPIA FORUM, in Class 38

Application No. 85-312,684  
Mark: AUTOPIAFORUMS, in Class 38

**DECLARATION OF JASON SIERRA WITH EXHIBITS**

TO: Trademark Trial & Appeal Board  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

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Thomas Cook Intellectual Properties  
3030 Bridgeway, Suite 425  
Sausalito, CA 94965

Law Office of Leo Zucker  
Attorney for Applicant  
2591 Dunning Drive  
P.O. Box 1177  
Yorktown Heights, NY 10598

Telephone: (914) 302-2460

3D-0265

JASON SIERRA, hereby deposes and states:

1. I am over 18 years of age, and I have personal knowledge of all matters set forth below.

2. I have been employed by Palm Beach Motoring Accessories, Inc., the applicant in the present opposition proceedings, for 14 years. My present position is General Manager, and my responsibilities include overseeing daily operations, matters concerning information technology (IT), and website management.

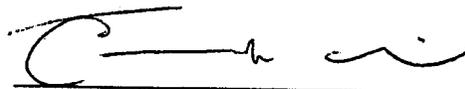
3. Exhibit 1 (two pages), attached, is domain name registration information that I obtained from Network Solutions. The exhibit shows that the domain name *autopia-carcare.com* was created March 12, 1999.

4. Exhibit 2 (14 pages) are screenshots of the home page at *autopia-carcare.com* for each of the years 1999 to 2012. I obtained the screenshots by use of the known "WaybackMachine" on-line archival service.

5. Exhibit 3 (three pages) are records of orders placed April 21, 22, and 23, 1999, by customers on-line through the website at *autopia-carcare.com*.

6. Exhibit 4 (2 pages) is an Agreement dated May 11, 2009, for the sale of the *autopia.org* domain name from David W. Bynon as seller, to 3D International, LLC as buyer. The Agreement was forwarded to me by 3D on January 21, 2010, in response to my inquiry concerning their alleged ownership of the domain name.

6. I further declare that all statements made herein of my own knowledge are true, and all statements made on information and belief are believed to be true, and that I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the opposed applications or documents or any registrations resulting therefrom.

  
\_\_\_\_\_  
Jason Sierra

Date: 10/11/12