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

Proceeding	91204404
Party	Defendant Vincent Motors LLC
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Attachments	Applicant_s Motion to Strike Opposer_s Reply - Aug. 21, 2014 - final.PDF(250370 bytes )

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

DAVID M. HOLDER,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91204404
	)	
VINCENT MOTORS LLC/	)	
EICHER MOTORS LTD.	)	
	)	
Applicant.	)	

**APPLICANT VINCENT MOTORS LLC’S (AND EICHER MOTORS LTD.’S)<sup>1</sup>  
MOTION TO STRIKE OPPOSER DAVID M. HOLDER’S  
REPLY TO APPLICANT’S OPPOSITION TO OPPOSER’S MOTION FOR SUMMARY  
JUDGMENT**

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<sup>1</sup> This motion is filed by the currently named party, Vincent Motors LLC, on behalf of its successor-in-interest, Eicher Motors Ltd., who is the current applicant and proper party to this proceeding. *See* Mot. to Substitute Party, June 25, 2014, ECF No. 29. Together, Vincent and Eicher are collectively referred to herein as “Applicant.”

## INTRODUCTION

On August 12, 2014, Opposer David M. Holder filed a Reply brief in support of his Motion for Summary Judgment.<sup>2</sup> Attached to the Reply are two new declarations signed by alleged licensees of Opposer—John Healy and Patrick Godet—along with exhibits. The Board should strike the declarations for at least two reasons. First, they contain new testimonial evidence that Opposer failed to submit with his Motion for Summary Judgment, thereby denying Applicant the ability to respond to the evidence. Second, Opposer deliberately withheld the information contained in the declarations during discovery and should therefore be precluded from using the evidence in support of summary judgment. For the reasons set forth below, the Board should strike the Reply declarations and exhibits, and any portions of the Reply that refer thereto.

## ARGUMENT

### **I. Opposer’s Reply Brief Is an Improper Vehicle for Introducing Testimonial Evidence Contrived at the Eleventh Hour In Support of Summary Judgment.**

Opposer’s Reply brief is an inappropriate means of introducing new testimonial evidence. To the extent the declarations are permissible in the first place, *but see infra* Part II, Opposer should have submitted them with his motion for summary judgment. Instead, Opposer waited for Applicant to thoroughly respond to Opposer’s motion for summary judgment, only to then spring new evidence on Applicant and deny Applicant the opportunity to respond in its Opposition.<sup>3</sup> The Board should not permit this deliberate circumvention of the rules and the

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<sup>2</sup> Opposer’s Reply Brief, Aug, 12, 2014, ECF No. 40.

<sup>3</sup> Opposer’s declarations and exhibits do little to support its motion for summary judgment. Opposer purports to show that it has two oral licensees. One of these, Patrick Godet, suggests he has a “worldwide” oral license with Opposer but transacts with Opposer entirely in the European Union, not the United States. Sales from Europe to the United States do not necessarily signify

adversarial process and should strike the new declarations and exhibits, as well as any portions of the Reply brief that refer thereto (i.e., Parts II.C-E, and VI). *See, e.g., Florists' Transworld Delivery, Inc. v. Fresh Intellectual Props., Inc.*, Cancellation No. 29650, 2001 WL 245748, at \*2 (TTAB Feb. 9, 2001) (granting motion to strike affidavit exhibits because they were “submitted for the first time in reply to respondent’s response to the motion [for summary judgment and] were untimely submitted,” reasoning that, “[r]espondent did not have the opportunity to address them in its response to the summary judgment motion. If petitioner had wanted the Board to consider them, it should have submitted properly authenticated copies with its summary judgment motion”); *Acumed LLC v. Stryker Corp.*, 551 F.3d 1323, 1332 (Fed. Cir. 2008) (stating, “[g]enerally speaking, a court should not consider new evidence presented in a reply without giving the other party an opportunity to respond,” but finding no abuse of discretion by district court for denying motion to strike *only* because the nonmovant had an opportunity to respond to the new evidence at a hearing).

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use of a mark in the United States. *See I.C.E. Mktg. Corp. v. Neutrogena Corp.*, Cancellation No. 92043193, 2009 WL 1896062, at \*10 (TTAB Mar. 4, 2009) (“Although Congress can regulate all importation of goods from foreign states, importation by itself does not constitute use in commerce.” (citing *In re Silenus Wines, Inc.*, 557 F.2d 806, 807-08, 194 U.S.P.Q. 261, 263 (CCPA 1977))). The other alleged licensee, John Healy, offers on his company’s website “Vincent” parts manufactured by retailers *other than* Opposer, suggesting the terms of the alleged oral licensing agreement are unenforced. *See Applicant Vincent Motors LLC’s (and Eicher Motors LTD’s) Br. in Opp’n to Opposer David M. Holder’s Mot. for Summ. J. at 14-23, ECF No. 38.* Notwithstanding the limited value of these declarations, the Board should not countenance Opposer’s continued tactical abuses and disregard of Board rules. *See, e.g., Board’s Communication, ECF No. 13 (admonishing Opposer for filing interrogatories and production requests with the Board and advising Opposer not to file any further initial disclosures with the Board).*

**II. The Declarations and Exhibits Would Have Been Improper Even if Timely Submitted with the Summary Judgment Motion Because the Declarations Contain Inadmissible Evidence.**

Even if Opposer had timely submitted the Healy and Godet declarations with his summary judgment motion—rather than generating them after Applicant filed its Opposition—the declarations would be improper because they contain inadmissible evidence. Affidavits and declarations may be submitted in support of a motion for summary judgment only if they “set forth such facts as would be *admissible* in evidence.” TBMP § 528.05(b) (emphasis added). Under Rule 527.01(e), “[a] party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial unless the failure to disclose was substantially justified or is harmless.” TBMP § 527.01(e). Because Opposer failed to provide the information contained in the declarations during the discovery period, the evidence in the declarations is inadmissible at trial and cannot be used to support summary judgment.

Opposer refused to provide information during discovery about the alleged oral licensing agreements, which information he now seeks to rely upon. For instance, when asked to “[i]dentify and describe the facts concerning any agreements between Opposer and any person . . . including without limitation, all licenses, assignments . . . or agreements referencing the VINCENT Marks,” Opposer named only Coventry as a licensee—not Godet—and failed to disclose any terms of the alleged Coventry licensing agreement. Indeed, Opposer responded:

There are agreements between Opposer and others relating to the licensing of sales in the U.S. The main licensee is Coventry Spares, Ltd. . . ., but includes Dunhill, Ltd., who was a licensee in the 1990’s. The Interrogatory is objected to the extent that it includes licenses for use of the mark outside of the United States. However, Guards of Fashion in the U.K. is one such licensee. Others have been

licensed to sell clothing under the marks for periods of time. Most agreements are oral.<sup>4</sup>

Opposer's deliberate failure to disclose the alleged licensing agreement with Godet was far from harmless. As a result of the omission, Applicant was unaware of the alleged agreement and could not inquire about it during Opposer's deposition or seek to depose Godet about the agreement. Opposer effectively seeks to insulate his allegations of the agreement from any meaningful review or attack. This is why Rule 528.05(b) precludes Opposer from introducing the evidence at trial. TBMP § 528.05(b). Similarly, Opposer merely noted the existence of an alleged oral licensing agreement with Coventry, but failed to provide any facts about the terms or other details of the agreement, despite Applicant's request for the information. This omission was also far from harmless. Had Opposer responded in good faith and disclosed the basic terms of the agreement—which the Healy declaration now purports to describe in paragraph 4 and elsewhere—Applicant could have inquired about the terms during Holder's deposition or sought to depose Healy about the agreement. Again, Opposer sought to insulate allegations about the terms of the alleged agreement from Applicant's review and attack. Thus, Rule 528.05(b) precludes Opposer from introducing the evidence at trial. TBMP § 528.05(b). Because both declarations contain inadmissible evidence, Opposer could not have submitted them even with a timely summary judgment motion, and the Board should strike them. TBMP § 528.05(b).

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<sup>4</sup> See Opposer's Resps. to Applicant's First Set of Interrogs. at 9-10 (Ex. A).

**CONCLUSION**

For the foregoing reasons, Applicant requests that the Board strike Opposer's Reply to Applicant's Opposition to Plaintiff's Motion for Summary Judgment.

Date: August 21, 2014

Respectfully submitted,

VINCENT MOTORS LLC /  
EICHER MOTORS LTD.

/Randall A. Brater/

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**CERTIFICATE OF SERVICE**

It is hereby certified that the foregoing Motion to Strike Opposer David M. Holder's Reply to Applicant's Opposition to Opposer's Motion for Summary Judgment was served upon the following attorney of record for Opposer by email (as agreed by the parties), this 21st day of August 2014:

GREGOR N NEFF  
LAW OFFICE OF GREGOR N NEFF  
489 FIFTH AVENUE  
NEW YORK, NY 10017

/Randall A. Brater/

Randall Brater

**HOLDER V. VINCENT MOTORS LLC  
OPPOSITION NO. 91204404**

**EXHIBIT A**

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

DAVID M. HOLDER,	)	
	)	
Opposer/Petitioner	)	
	)	
v.	)	Opposition No. 91204404
	)	Cancellation No. 92055541
	)	
VINCENT MOTORS LLC,	)	
	)	
Applicant/Respondent	)	

**OPPOSER’S RESPONSES TO  
APPLICANT’S FIRST SET OF INTERROGATORIES**

Pursuant to 37 C.F.R § 2.120 and Federal Rules of Civil Procedure 26 and 33, Opposer David M. Holder hereby responds and objects to Applicant’s First Set of Interrogatories as follows:

Opposer hereby adopts and repeats Paragraphs 1 through 4 of the preamble to the General Objections, and Paragraphs 1 through 9 of the General Objections, in Applicant’s Response to Opposer’s First Set of Interrogatories.

**INTERROGATORIES**

**INTERROGATORY NO. 1**

Identify all persons who have the best knowledge concerning the facts at issue in the Proceedings, including without limitation the facts related to adoption of the VINCENT Marks; the date of adoption and date of first use of the VINCENT Marks in connection with Opposer’s Goods; the marketing, test marketing and sale or offer of Opposer’s Goods; and the nature, and development, advertising and promotion of Opposer’s Goods. For each person identified, briefly summarize their areas of knowledge.

considered by the witness(es) in forming the opinions; any exhibits to be used as a summary of or support for the opinions; the qualifications of the witness(es), including a list of all publications authored by the witness(es) within the preceding ten years; the compensation to be paid for the study or testimony of such witness(es); and, a listing of any other cases in which the witness(es) has testified as an expert at trial or by deposition within the preceding four years.

**RESPONSE NO. 14**

Opposer has not retained or specially employed an expert witness in this case.

**INTERROGATORY NO. 15**

Identify the persons most knowledgeable concerning Opposer's use or proposed use of the VINCENT Marks in the United States in connection with each good and service identified in response to these Interrogatories.

**RESPONSE NO. 15**

See the response to Interrogatory No. 1.

**INTERROGATORY NO. 16**

Identify and describe the facts concerning any agreements between Opposer and any person referring to or relating to the ownership, acquisition, use or planned use of the VINCENT Marks, or any variation thereof, including without limitation, all licenses, assignments, co-existence agreements, or agreements referencing the VINCENT Marks.

**RESPONSE NO. 16**

There are agreements between Opposer and others relating to the licensing of sales in the U.S. The main licensee is Coventry Spares, Ltd. (see response to Interrogatory No. 1), but

includes Dunhill, Ltd. who was a licensee in the 1990's. The Interrogatory is objected to the extent that it includes licenses for use of the mark outside of the United States. However, Guards of Fashion in the U.K. is one such licensee. Others have been licensed to sell clothing under the marks for periods of time. Most agreements are oral.

#### **INTERROGATORY NO. 17**

Identify and describe the facts concerning each instance in which Opposer objected to or in which Opposer received an object to the use or registration of any mark including the name VINCENT or any similar word or phrase, including but not limited to, cease and desist letters and any civil, criminal or administrative action before the United States Patent and Trademark Office or any state for federal court, or the National Advertising Division of the Council of Better Business Bureaus.

#### **RESPONSE NO. 17**

Mr. Holder discussed with Mr. Bernard Li his activities in using "Vincent" some years ago, but there was no final resolution of the matter between them.

#### **INTERROGATORY NO. 18**

From the date of first use in commerce in the United States to the present, provide the following:

- a. Total sales, by year, of all products bearing the VINCENT Marks, separated by product.
- b. Total number of product sold, by year, bearing the VINCENT Marks.