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

Proceeding	91213597
Party	Defendant Tigercat International Inc.
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Attachments	APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MO- TION TO COMPEL (M1289484).pdf(473935 bytes )



Interrogatory Nos. 12 and 13 and Request for Production No. 17, directed at third-party use of “Cat”, are relevant to Caterpillar’s claim of likelihood of confusion under the DuPont factors and to the dilution claim. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); *Imagewear Apparel Corp.*, CANCELLATION 9204510, 2010 WL 302020 (Trademark Tr. & App. Bd. Jan. 15, 2010) (holding that third-party use of a term comprising a trademark, weakened the mark so that it was not entitled to a claim of dilution).

Applicant’s Requests for Production Nos. 15, and 18-21 which seek documents referring or relating to licenses, coexistence agreements, consent agreements, and inquires or objections by Caterpillar to any third-party bear on the likelihood of confusion as well, based on the number of permitted users of similar marks. *Id.*

Applicant’s Interrogatories Nos. 9-11 and Requests for Production Nos. 24-28, related to Caterpillar’s market research and consumer studies for the asserted CAT marks from 2000 to present are relevant not only to the alleged fame of Caterpillar’s marks for both the claims of likelihood of confusion and dilution; but are also relevant to how purchasers perceive the Opposer’s marks, what the significance of the mark(s) is to purchasers, what is recalled, what the associations are, and are not, and what motivates purchase decisions, all of which bear on whether or not such purchasers are likely to be confused as to source or sponsorship with Applicant’s different mark particularly in light of Applicant’s long use of TIGERCAT as a mark and as a trade name. *Sullivan v. CBS Corp.*, 385 F.3d 772, 779 (7th Cir. 2004). Since at least as early as 1992, Applicant has used its TIGERCAT mark and name and is the owner of an incontestable registration for the mark TIGERCAT, Registration No. 2,275,249 for “specialized power-operated forestry equipment, namely, purpose built four wheel drive-to-tree and track type log bunchers, log loading machines, skidders and other forestry industry equipment,

namely, bunching saws, bunching shears and component parts thereof” with a date of first use of April 1, 1992. *See Declaration of John Metzger, Exhibit A.* The goods listed in the subject application, “off road industrial vehicles, namely, skidders and purpose-built prime movers, carrying aerial devices, mulchers and sprayers”, are an extension of the goods listed in Applicant’s incontestable registration as evidenced by the overlap of the terms “skidders and purpose built four wheel and purpose built movers”. Given the long history of co-existence between Applicant and Opposer, Applicant’s discovery requests are relevant to matters at issue in this Opposition, particularly the alleged similarity of the marks and the relative strength and alleged fame of Caterpillar’s marks; both factors to be considered in analyzing the grounds of alleged likelihood of confusion and dilution. *Id.*

Information regarding consumer confusion between Caterpillar and any third-party is relevant because it has a tendency to show whether or not a purchaser is likely to confuse “Caterpillar” with another company’s marks in the fields of off road industrial vehicles and heavy equipment that contain or comprise the term “Cat” or “Kat”.

Applicant’s Request for Production Nos. 16, 22, and 23 related to Caterpillar’s knowledge of Tigercat prior to the date of Tigercat’s application is also relevant. Not only do these requests bear on the issue of Applicant’s equitable defenses, but Tigercat and Caterpillar have done business with and in competition against each other since 1992. *See Declaration of John Metzger, Exhibit B.* Caterpillar admits it has been aware of Tigercat’s forestry equipment since 2000. *See Declaration of John Metzger, Exhibit C, Response to Request For Admission No.7.* Since 2000, Tigercat has distributed all of its products, including the goods listed in its incontestable registration as well as goods listed in the subject application, through its dealer network and advertises such products through its catalog and website. For Caterpillar to admit it

knew of Tigercat's forestry equipment, but not the off road industrial vehicles is improbable if not impossible, as the goods such as skidders, with and without mulchers, all have travelled and still travel in the same channels of trade. Caterpillar's objection to producing documents related to such knowledge is baseless. *See Declaration of John Metzger, Exhibit D.* This evidence clearly is probative of the absence of any likelihood of confusion. Caterpillar sells equipment for forestry and logging applications under its asserted "CAT" marks, including "tractors adapted to be employed in farming operations, road building, mining, **logging**, earth moving, hauling, and for other industrial and agricultural purposes" (Reg. No. 345499); "demolition machines and scrap material handlers for use therewith, namely, blades, buckets, crushers, grapples, hammers, hydraulic brooms, mobile shears, pallet forks; pulverizers, and rakes; **log loaders . . .**" (Reg. No. 2,421,077); "machines and machine tools for use in . . . **forestry . . .**" and "land vehicles for use in . . . forestry . . ." (Reg. No. 4,193,027); and "logging machinery, tools and equipment – namely, logging engines and the parts for all said goods" (Reg No. 277, 417)<sup>1</sup> Tigercat sells forestry equipment under its TIGERCAT mark which is the subject of incontestable Trademark Reg No. 2,275,249. The two companies have knowingly co-existed, and at one time worked together and have competed since 1992. There has been no prior issue. In these circumstances, it is not seen that there can be any valid issue if Tigercat sells the goods of the subject application under its TIGERCAT mark, concurrent with Caterpillar's sales of the goods identified in its registrations under its CAT mark.

Finally, Applicant's requests for information directed at the percentage of Opposer's products sold under the CAT and CATERPILLAR marks that are yellow are relevant to the extent that Caterpillar opposed the TIGERCAT mark based on a claim of likelihood of

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<sup>1</sup> Each of these registrations with the goods listed therein was pled in the Notice of Opposition.

confusion. While Tigercat submits that there is no likelihood of confusion, particularly granted the long concurrent use without issue and the differences in the marks, inter alia, the color of the products of the parties, and of heavy equipment and off road products of third parties, is a part of the market context in which potential purchasers view the products sold under the respective marks.

### **Opposer's Undue Burden Objections Are Ill-Founded**

Opposer's objections to Tigercat's Interrogatories and Requests for Production on grounds of undue burden ignore the scope of discovery established by the Federal Rules and this Board. It is settled that questions concerning specific goods on which an opposer uses its marks are proper to the extent that the scope of inquiry is directed to those goods identified in registrations relied on by Opposer. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

The scope of discovery in an opposition proceeding is based on what has been pled in the notice of opposition and what is in the application which is the subject of the opposition. *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975), see also TBMP §402. A discovery request is not unduly burdensome if the request is suitably tailored to the issues of the opposition. *Fort Howard Paper Co.*, 4 U.S.P.Q.2d 1552 (Trademark Tr. & App. Bd. 1987).

Caterpillar, at the very least, cannot simply refuse to respond but has at least to identify a reasonable representation of the requested information and documents, and must be precluded from offering any further evidence on those issues. *The J. B. Williams Co., Inc.*, 188 U.S.P.Q. (BNA) ¶ 577 (Trademark Tr. & App. Bd. Dec. 5, 1975). If requested documents do not exist, then Caterpillar must clearly state so. *En Fleur Corp.*, CANCELLATION 26,548, 1998 WL 197595 (Trademark Tr. & App. Bd. 1998).

Opposer's refusal to respond unless and until Tigercat specifies what it deems to be overlapping industries is simply improper. Tigercat has no duty to explicitly state as a prerequisite to receiving discovery responses what it views as overlapping industries. If Opposer poses a proper discovery request directed to matters in issue, Applicant will respond. It is noted in this regard that Opposer has raised no issues with respect to Applicant's discovery responses. There is no basis for any claim that responding to discovery about registrations and matters that Opposer has placed in issue creates any "immense discovery burden" on Opposer. Opposer has not even attempted to explain what the nature or extent of the burden is, the number of locations at which documents are maintained, the volume of materials that exist that have been requested, why electronic records cannot be produced or documents otherwise be made available for inspection and copying. Since this claim of undue burden is made baldly and with no basis, Opposer's request for a protective order has no basis, and should therefore be denied.

#### **Opposer's Equal Availability Objections Are Ill-Founded**

"A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. With regard to document production requests, a proper written response to each request requires the responding party to state that there are responsive documents and that either they will be produced or will be withheld on a claim of privilege; to state an objection with appropriate reasons; or to state that no responsive documents exist." TBMP §408.02.

Opposer's objections to Tigercat's Interrogatories and Requests for Production on grounds of information being equally available to Tigercat is baseless. It is settled that each party and its attorney or other authorized representative has a duty to make a good faith effort to

satisfy the discovery requests made. TBMP §408.01; see also *Panda Travel Inc., v Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009).

Opposer's objections are unfounded as a matter of fact as well. Such information as Caterpillar's U.S. sales figures for particular categories of goods identified in the registrations it relies on (Interrogatory No. 18 and Request for Production No. 12, attached as Exhibits A and C respectively to the Declaration of C. Bell in support of Applicant's Motion to Compel), third-party use of the term "Cat" for goods and services pleaded registrations and in connection with off-road vehicles or parts or attachments, or in connection to Caterpillar's goods and services (Interrogatory Nos. 12 and 13 and Request for Production Nos. 15 and 17, attached as Exhibits A and C respectively to the Declaration of C. Bell in support of Applicant's Motion to Compel), and documents referring or relating to Caterpillar's licenses, coexistence agreements, consent agreements, and inquires or objections by Caterpillar to any third-party use (Interrogatory Nos. 12 and 13 and Request for Production Nos. 15, 17, 19, 20 and 21, attached as Exhibits A and C respectively to the Declaration of C. Bell in support of Applicant's Motion to Compel) are not "readily available", if available at all, to Tigercat. What was readily available to Tigercat is the vast majority of the documents Caterpillar produced – a dump of old SEC filings (Bates Nos, CAT0003070-CAT0004060; CAT0005302-CAT0006662; CAT0007188-CAT0007265) and out of date publicly distributed catalogues (Bates Nos. CAT0002549-0002618, CAT0004397-0004447, CAT0007354-0007901 and CAT0008834-0009388). Obviously, Caterpillar had no objection to producing outdated paper that is publicly available. It has no basis on such alleged ground to evade making proper discovery in response to Applicant's discovery requests. Caterpillar cannot pick and choose which types of documents it wishes to turn over and produce only those.

### **Opposer's Alleged Response to Interrogatory No. 8 is Inadequate**

Opposer's alleged response to interrogatory No. 8 is inadequate. Tigercat seeks information regarding who the representative purchasers of Caterpillar's products are. As Caterpillar stated in its response to Applicant's Motion To Compel, Tigercat was satisfied with Caterpillar's response to Interrogatory No. 7 regarding classes of consumers. Tigercat is not, however, satisfied with the response to Interrogatory No. 8, which asks Caterpillar to identify representative purchasers. Purchasers are not necessarily consumers. Those who purchase a product and particularly heavy equipment and/or off road industrial vehicles, may not be and are not likely to be the ones who use the products. Stating generally that the products are sold to individuals, businesses and governments through its various websites is improperly vague and inadequate. "Businesses" does not identify representative purchasers of the goods identified in the registrations Caterpillar has placed in issue. Applicant is entitled to this information.

### **Opposer's Contention That Tigercat Has Not Sufficiently Identified Its Goods is Ill-Founded**

Opposer's contention that Applicant has not sufficiently identified its goods is ill-founded. Applicant's goods are identified in its application. The application establishes the scope of the issue to be determined by this Board. There is no need for Applicant to further define or limit its goods.

**CONCLUSION**

For these reasons, Tigercat respectfully requests that the Board grant Tigercat's motion to compel in its entirety and deny Caterpillar's request for a protective order.

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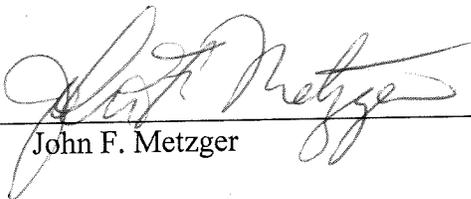
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the attached Applicant's Reply to Opposer's Opposition to Applicant's Motion to Compel was served on counsel for the Opposer at the location and on the dated listed below via electronic and U.S. Mail:

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By:   
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