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

Proceeding	91213597
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>CATERPILLAR INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align: center;">Applicant.</p>	<p style="text-align: center;">Opposition No. 91213597</p> <p style="text-align: center;">Application Serial No. 85/814,584 Mark: TIGERCAT Application date: January 3, 2013</p>
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**OPPOSER CATERPILLAR INC.'S BRIEF IN OPPOSITION TO APPLICANT  
TIGERCAT INTERNATIONAL INC.'S MOTION FOR SANCTIONS AND  
SUSPENSION OF PROCEEDINGS**

Opposer Caterpillar Inc. (“Opposer” or “Caterpillar”) submits the following response to Applicant Tigercat International Inc.’s (“Applicant” or “Tigercat”) Motion for Sanctions and Suspension of Proceedings regarding Caterpillar’s discovery responses (“Motion”).

Caterpillar has diligently complied with the Board’s February 4, 2015 Order which granted, in part, Tigercat’s Motion to Compel Opposer to supplement its discovery responses to Tigercat’s discovery requests (“Order”). In addition to serving supplemental discovery responses, Caterpillar produced documents responsive to each request addressed in the motion to compel, and has continued to look for and produce additional documents to further supplement its responses. To date, it has produced more than 11,000 pages of production documents in response to the Board’s Order, in addition to the more than 10,000 pages of documents it had previously produced. Caterpillar has also addressed Tigercat’s numerous objections regarding its discovery responses, and invited discussion on issues raised by Tigercat’s counsel.

Instead of cooperating with Caterpillar to address and clarify discovery issues, Tigercat has used the discovery process as a weapon in an unwarranted attempt to paint Caterpillar as

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non-compliant with the Board's Order. Tigercat has repeatedly mischaracterized Caterpillar's efforts to suggest that it is withholding relevant discovery; twisted Caterpillar's factual explanations regarding its collection and production of documents; and unreasonably demanded production of documents even after being told that such documents do not exist. Applicant's counsel even refuses to discuss discovery issues over the phone.

The instant Motion was filed directly after Caterpillar advised Tigercat that it had identified more documents addressing Tigercat's requests that it would be producing. Even though the discovery period was far from over, and it was appropriate under the Federal Rules to supplement prior responses with newly discovered information (as addressed in Section II.C), Tigercat filed this Motion claiming entitlement to sanctions. Furthermore, Tigercat seeks a draconian and wholly unwarranted result, as the sanctions it seeks would effectively preclude Caterpillar from presenting evidence related to the extraordinary level of fame the CAT mark has acquired in the United States since the 1940's, as acknowledged by the Board most recently in *Caterpillar Inc. v. Big Cat Energy Corp.*, Opposition No. 91193704, Dkt. No. 57 (T.T.A.B. Sept. 3, 2014); *see also*, *Caterpillar Inc. v. Pave Tech, Inc.*, Cancellation No. 92041776 (T.T.A.B. Mar. 12, 2007); *Caterpillar Inc. v. Telescan Techs., LLC*, 2002 WL 1301304 (C.D. Ill. Feb. 13, 2002)<sup>1</sup>; and *Caterpillar Tractor Co. v. Gehl Co.*, 177 U.S.P.Q. 343 (TTAB 1973).

Upon information and belief, Caterpillar has responded to Applicant's discovery requests, as modified by the Board. Accordingly, there has been no violation of the Board's Order and certainly no basis for sanctions of any sort. Therefore, Caterpillar respectfully requests that Tigercat's Motion be denied for the reasons addressed in greater detail below.

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<sup>1</sup> Attached hereto as Ex. H to Declaration of Laura K. Johnson in Support of Opposer's Brief in Opposition to Applicant's Motion for Sanctions ("Johnson Decl.")

**I. RELEVANT FACTUAL BACKGROUND**

**A. Caterpillar Complied with the Board's Prior Order**

On February 4, 2015, the Board granted Tigercat's motion to compel, in part, and ordered Caterpillar to supplement its responses to Tigercat's interrogatories and document requests in response to Interrogatory Nos. 1, 3, 8, 9, 11, 12, 16, and 18, and Request for Production Nos. 14, 19, 20, 21, 24, 26, 27, 28, and 29 ("Discovery Requests") and to provide responsive documents as indicated. For Request for Production Nos. 19, 20, 21, 24, 26, 27, and 28, Caterpillar was ordered to produce a representative sampling of responsive documents.

On March 6, 2015, Caterpillar complied with the Board's Order by serving supplemental responses to the Discovery Requests and produced more than 2,000 pages of documents. Johnson Decl., ¶ 3. This production covered Requests for Production Nos. 19, 20, 24, 26, 27, 28, and 29, including representative license agreements, coexistence agreements, sales reports, market research and consumer study documents, style guides, and a list of trademark application watch notices Caterpillar had received in the last four years. *Id.* Caterpillar also informed Tigercat that it believed no relevant documents existed for Request for Production Nos. 14 and 21, but that it would supplement its response to the extent that documents were located. *Id.* at Johnson Decl., Ex. B.

After submission of these responses Caterpillar continued its work to identify and produce representative documents, in accordance with its discovery obligations under Fed. R. Civ. P. 26(e)(1). *Id.* at ¶ 4. As part of these efforts, Caterpillar's undersigned representatives coordinated with a large number of individuals within Caterpillar's various groups and offices, including Legal, Global Sales, Customer Insights, Marketing, Global Brand Marketing, and Global Brand Management, to identify additional responsive documents. *Id.* at ¶¶ 3-4.

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On March 18, 2015, Tigercat sent a demand letter to Caterpillar requesting that it further supplement Interrogatory Nos. 8 and 12, and Request for Production Nos. 14, 19, 20, 24, 26, 27, and 28. *See* Bell Decl., Ex. A. If Caterpillar failed to comply with Tigercat's demands, Tigercat threatened in the letter that it would seek sanctions. *Id.*

In its March 23, 2015 response, Caterpillar addressed each of these requests, explaining the content of its responses to the Discovery Requests and confirmed that it would be producing additional responsive documents for Request for Production Nos. 24, 26, 27, and 28. *See* Bell Decl., Ex. B. In an effort to amicably resolve the dispute, Caterpillar informed Tigercat that to the extent it had questions about the existence of certain types of documents, Caterpillar was more than willing to discuss those specific questions or concerns through a telephone call at Tigercat's convenience. *Id.*

In its March 27, 2015 letter, Tigercat maintained its objection to Caterpillar's supplemental response to Interrogatory No. 12 and Request for Production Nos. 20, 24, 26, 27, and 28 and refused to discuss its alleged discovery deficiencies on a call with Caterpillar. *See* Bell Decl., Ex. C.

Caterpillar responded on April 1, 2015, providing additional information regarding its responses and detailing its ongoing efforts to produce documents. *See* Bell Decl., Ex. D. Caterpillar answered specific questions about the existence of certain types of documents and indicated that it was diligently working to produce additional documents. *Id.*

Dissatisfied with Caterpillar's commitment to provide additional discovery, Tigercat's April 2, 2015 letter gave Caterpillar one day to provide supplemental responses or threatened again to go to the Board for sanctions. *See* Bell Decl., Ex. E.

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In the spirit of cooperation, on April 2, 2015, Caterpillar responded to these demands informing Tigercat that it would be producing documents on April 3, 2015, and that it would be producing additional documents the following week. *See* Bell Decl., Ex. F. On April 3, 2015, Caterpillar supplemented its Interrogatory No. 12 (*see* Bell Decl., Ex. G) and produced another eight documents (consisting of more than 8,000 pages), including trademark dilution searches and market surveys and protocols. Johnson Decl., ¶ 5.

Without responding to this letter or waiting for Caterpillar's additional documents, Tigercat filed its Motion for Sanctions on April 7, 2015.

Maintaining its commitment to identify and produce the additional documents, on April 13, 2015 and April 21, 2015, Caterpillar produced 27 additional documents (consisting of 1,100 pages), largely comprised of market research and consumer studies. Johnson Decl., ¶ 6. This brings Caterpillar's production volume to 22,294 pages (in contrast Tigercat has produced less than 2,000 pages). *Id.* at ¶ 11. On April 21, 2015, Caterpillar also served its second supplemental interrogatory response to Interrogatory Nos. 9 and 11 with the new production numbers. *Id.* at ¶ 10.

**B. Discovery Related to Interrogatory No. 12**

Tigercat Interrogatory No. 12 seeks information relating to "all third party uses of 'CAT' as a mark or name or component of a mark or name or domain name in connection with any goods or services identified in Opposer's Registrations." *See* Bell Decl., Ex. G. The Board's Order excluded the domain name portion of this request and limited this interrogatory to those third party uses actually known to Caterpillar.

Opposer produced two charts containing all trademark applications containing "cat" that have been filed in the last four years. Johnson Decl., ¶ 3. Caterpillar also produced its most

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recent dilution searches from 2012 referencing all pending applications and current or former registrations containing “cat.” *Id.* at ¶ 5. Caterpillar admitted to having actual knowledge of all 8,400+ of these third-party references. *See* Bell Decl, Ex. F.

In its Second Supplemental Response to Interrogatory No. 12, to the best of its knowledge, Caterpillar identified all third parties who use (or formerly used) marks or names similar to Opposer’s Marks, but who did not file trademark applications for that mark or name. *See* Bell Decl., Ex. D. Further, Caterpillar identified that it was aware of third-party websites that opposing parties had attached as exhibits in several opposition proceedings involving the CAT or CATERPILLAR marks. *See* Bell Decl., Ex. G.

**C. Discovery Related to Request for Production Nos. 24, 26, 27, and 28 and Interrogatory Nos. 9 and 11**

Tigercat Requests for Production Nos. 24 - 28 seek documents relating to market and brand research, namely:

REQUEST NO. 24:

All documents referring or relating to all market research and consumer studies done by or on behalf of Opposer or any third party related to Opposer’s Marks since 2000.

REQUEST NO. 26:

All documents referring or relating to purchaser recognition of Opposer’s Marks since 2000.

REQUEST NO. 27:

All documents referring or relating to all market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer’s Marks since 2000.

REQUEST NO. 28:

All documents referring or relating to consumer recognition of Opposer’s Marks since 2000.

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Johnson Decl., Ex. A. The Board's Order limited these requests to documents created within the last five years and required Caterpillar to produce a representative sampling of the information sought. Order at 10.

Interrogatory Nos. 9 and 11 seek similar evidence regarding market research and consumer studies done by Caterpillar related Opposer's Marks and the fame or recognition or awareness of Opposer's Marks since 2000. *See* Bell Decl., Ex. G. The Board limited these interrogatories to research or studies conducted in the last five years. Order at 4.

Caterpillar conducts a variety of market research and consumers studies related to the CATERPILLAR and CAT brands and products sold under the marks. Johnson Decl., Ex. C. Caterpillar produced a number of representative documents in its March 6, 2015 production and has continued its supplementation of these documents based on its ongoing investigations and Tigercat's specific inquiries. *Id.* at ¶¶ 3-5, 7. To date, Caterpillar has produced all representative documents falling within the above requests (*id.* at ¶ 11), including the following exemplary categories of documents:

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a. Caterpillar State of the Brand reports evaluating use and importance of the CAT and CATERPILLAR brands. Following is an excerpt from CAT010965-11022<sup>2</sup>:

REDACTED

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<sup>2</sup> Excerpts from Caterpillar production documents are designated as “Trade Secret/Commercially Sensitive.”

REDACTED

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b. Survey reports evaluating CAT and CATERPILLAR brand perception amongst customers and non-customers. Following is an excerpt from CAT021451-21480:

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c. Industry-level brand research and reports evaluating market perceptions for the CAT and CATERPILLAR brands, particularly in relation to competitive brands. These reports contain a consumer recognition and brand awareness component. Following is an excerpt from CAT021234-21275:

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d. Customer loyalty and use survey protocol and questionnaire. Part of these loyalty surveys include the tracking of competing brands purchased or considered by Caterpillar customers. Following is an excerpt from CAT011031-CAT011045:

REDACTED

e. Customer loyalty and use raw survey data identifying responses regarding (amongst other things) competitive brands. Following is an excerpt from CAT011089:

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f. Customer loyalty and use survey report containing a competitive comparison.  
Following is an excerpt from CAT021396-21423:

REDACTED

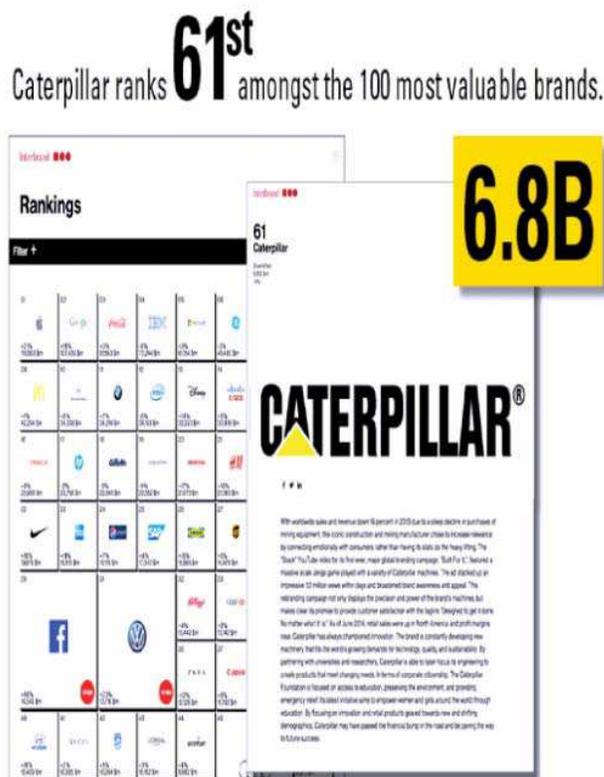
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g. Product specific surveys for skidders, wheel loaders, excavators, and skid steers, containing a competitive analysis component. Following is an excerpt from CAT021081-21106:

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h. Third-party market research studies and reports evaluating customer perception and brand performance for the world's leading brands. Following is an excerpt from CAT011090:



See *id.* at ¶ 7. Caterpillar has also supplemented its Interrogatory response Nos. 9 and 11 to provide corresponding information. *Id.* at ¶ 10.

In its March 27, 2015 letter, Tigercat requested production of market research and consumer studies similar to those produced in the European Union Community Trademark Opposition between the parties. See Bell Decl, Ex. C. These studies, undertaken at the instruction of European counsel, evaluated consumers' familiarity with the CAT brand in Finland and Sweden in particular. See Johnson Decl., ¶ 12.

In its April 1, 2015 response, Caterpillar informed Tigercat that it had not requisitioned or performed similar studies (or any studies at all) for this proceeding. See Bell Decl., Ex. D.

**D. Discovery in this Matter Remains Ongoing**

The Board's Order reset dates with discovery closing on March 14, 2015. The parties agreed to a sixty-day extension of this deadline and Tigercat filed the Motion for an Extension with the Board. On April 21, 2015, the parties agreed to another thirty-day extension. Discovery is now set to close on June 12, 2015. Further to the discussions regarding its production of relevant materials in Section I.A, Caterpillar remains committed to produce any additional relevant materials to the extent that these materials become available through its investigations with its client and the individuals within its clients' numerous departments. Johnson Decl., ¶¶ 4, 11.

As further evidence of the ongoing nature of discovery, on April 10, 2015, Tigercat produced approximately 1,300 pages of discovery, nearly tripling its production volume to date. *Id.* at ¶ 8. All but twenty of its production documents are publicly-available materials, despite Caterpillar's requests for market research and surveys and sales and advertising figures. *Id.*

On April 13, 2015, Tigercat also served Caterpillar with additional Requests for Production and Requests for Admissions. *Id.* at ¶ 9. Evidencing that Tigercat has not been hindered by Caterpillar's production to date, the majority of these requests seek further information about documents produced in response to Interrogatory No. 12 and Request for Production Nos. 24, 26, 27, and 28.

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**II. DISCUSSION<sup>3</sup>****A. Caterpillar Has Complied with the Board's Order in Relation to Interrogatory No. 12**

Interrogatory No. 12 requests identification of “all third party uses of ‘CAT’ as a mark or name or component of a mark or name or domain name” actually known to Caterpillar. Order at 5-6. Tigercat’s Motion objects to Caterpillar’s construction of “uses.” Motion at 3-4. Nowhere in its interrogatory request does Tigercat define “uses” or indicate that third-party uses should be limited to uses in commerce. And, as such, Caterpillar expansively identified “uses” to include both uses in commerce, as well other trademark uses, such as the filing of a trademark application. *See* Bell Decl., Ex. B.

As Caterpillar informed Tigercat in its April 1, 2015 letter, Caterpillar becomes aware of third-party “uses” of marks containing “cat” in essentially three ways: 1) receipt of a watch notice from the filing of a trademark application or the publication of a trademark application; 2) identification in a dilution trademark search that Caterpillar routinely conducts; or 3) parties separately identified through Caterpillar’s business (or litigation) activities. *See* Bell Decl., Ex. D.

For the first two categories, Tigercat produced dilution searches and a chart containing its trademark watch notices, and admitted to having actual knowledge to all 8,400 references. *See* Bell Decl. Exs. D, F. Tigercat appears to argue that Caterpillar’s response is deficient as it identified too many references. Given Tigercat’s ambiguous reference to “use,” this discovery is relevant and in compliance with the Board’s Order.

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<sup>3</sup> Tigercat’s Motion identifies that Caterpillar has not complied with the Board’s Order regarding Interrogatory No. 19. Motion at. 3. No further reference to Interrogatory No. 19 is raised. Accordingly, Caterpillar will presume that Tigercat identified this interrogatory in error.

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Tigercat cannot now complain as it has received more discovery than it wanted. Moreover, no discovery rule requires Caterpillar to identify the most relevant references supporting Tigercat's position. Tigercat must undertake this task, and its April 13, 2015 Requests for Production, seeking documents regarding twenty of these parties, indicates that it may have already done so. *See* Johnson Decl., ¶ 9.

For the third category of information, Tigercat accuses Caterpillar of withholding third-party names from its list. As Caterpillar informed Tigercat in its April 1, 2015 letter, Caterpillar's list contains all third parties who use (or formerly used) marks or names similar to Opposer's Marks, but who did not file trademark applications for that mark or name. *See* Bell, Ex. D. Further, Caterpillar identified that it was aware of third-party websites that opposing parties had attached as exhibits in several opposition proceedings involving the CAT or CATERPILLAR marks. *See* Bell, Ex. G. This identification scheme was not done to avoid fully responding to Tigercat's request, but to avoid renaming 8,400+ third-party references. *See* Bell Decl., Ex. D.

Through its document production and the list in its interrogatory response, to the best of its knowledge, Caterpillar has identified all third-party uses of a mark or name containing "cat" known to it. As Caterpillar has complied with the Board's Order, Tigercat's request for sanctions regarding Interrogatory No. 12 should be denied.

**B. Caterpillar Has Complied with the Board's Order in Relation to Request for Production Nos. 24, 26, 27, and 28 and Interrogatory Nos. 9 and 11.**

To date, Caterpillar has produced more than forty documents containing marketing research and consumer study protocols, questionnaires, raw data, and finalized reports. As detailed in the summary and snapshots shown in Section I.C, these documents contain details

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regarding competitive market analyses, brand awareness and recognition. In whole, they are a representative sample of all documents identified in Request Nos. 24, 26, 27, and 28. Further, Caterpillar has supplemented its responses to Interrogatory Nos. 9 and 11 to reflect the specific requests to which each of these production documents are responsive. *See* Johnson Decl., Ex. C.

Tigercat is incorrect regarding the responsiveness of Caterpillar's purchaser satisfaction and product use surveys. *See* subparts d, e, f, and g in Section 1.3.

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These documents are market research and consumer studies responsive to Request No. 24. And as Caterpillar has produced a representative sampling of these documents, it has complied with its discovery obligations.

Tigercat's suggestion that Caterpillar is withholding documents responsive to Requests Nos. 24, 26, 27, and 28 because "it suited its interests" is false. Caterpillar's marketing and survey documents support the fame of the CAT mark. For example, Caterpillar has produced representative documents (*see* subpart c in Section I.3) identifying a 96% consumer awareness for the CAT mark in the United States. Johnson Decl., ¶ 7. Further, Caterpillar has produced representative documents (*see* subpart b in Section I.3) identifying that more than 80% of relevant consumers and purchasers in the United States perceive the CAT brand to be associated with Caterpillar. *Id.* In order to be able to rely upon such evidence, it is in Caterpillar's best

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interest to produce these documents to the extent that they exist after a reasonable search, and it has done so.

At the heart of Tigercat's concerns appears to be a couple of market surveys conducted in Finland and Poland that have been asserted by Caterpillar's European counsel as evidence of the fame of the CAT mark in the European Union. In response to a question regarding these surveys, Caterpillar informed Tigercat that its counsel in the United States had neither requisitioned nor performed similar studies (or any study at all) for this proceeding. *See* Bell Decl., Ex. D.

Tigercat's discussion regarding this response and documents is disingenuous, at best. Opposer did not state that it was withholding brand awareness documents (nor has done so), merely that no counterpart market surveys were conducted in United States, which is the reason none were produced. *See Converse Inc. v. Worldwide Kids Assocs., Ltd.*, 2004 WL 950919, at \*4 n.8 (T.T.A.B. Apr. 29, 2004) (non-precedential) ("where documents responsive to a request for production do not exist, applicant is not obligated to create them.") (attached as Ex. D to Johnson Decl.); *Jewelers Vigilance Comm. v. Piper Mgmt., Inc.*, 2004 WL 882090, \*3 n.11 (T.T.A.B. Apr. 20, 2004) (non-precedential) ("Applicant is not obligated to create responsive documents solely to satisfy opposer's discovery requests.") (citing *Wash. v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993)) (attached as Ex. E to Johnson Decl.). Tigercat, however, will not accept this to be the case.

Tigercat's misinterpretation of Opposer's statement from Interrogatory No. 11 goes to this same point. Neither Caterpillar nor its counsel has conducted a survey specifically measuring the fame of the CAT mark in the United States in the last five years. Caterpillar often relies upon third-party market reports, such as the Interbrand study, (*see* subpart h in Section I.3)

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and the numerous TTAB decisions finding the CAT mark famous for likelihood of confusion and dilution purposes for this proposition. Caterpillar's response to Interrogatory No. 11 does not state that it refuses to produce customer recognition or awareness documents to the extent that they exist, nor has its production reflected such a limitation (*see* subparts b and c in Section I.3).

As Caterpillar has complied with the Board's Order, Tigercat's request for sanctions regarding Request for Production Nos. 24, 26, 27, and 28, and Interrogatory Nos. 9 and 11 should be denied.

**C. Caterpillar Timely Supplemented its Discovery Responses As Required Under Fed. R. Civ. P. 26(e)(1)(A)**

A party has an ongoing obligation to supplement its discovery responses and documents under the Federal Rules. Fed. R. Civ. P. 26(e)(1) provides:

A party who has made a disclosure under Rule 26(a) — or who has responded to an interrogatory, request for production, or request for admission — must supplement or correct its disclosure or response:

(A) in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing; or

This obligation not only encompasses information and documents that were not available at the time the original responses were made, but also information and documents that were in the responding party's possession, custody or control at that time.<sup>4</sup>

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<sup>4</sup> *See* Fed. R. Civ. P. 26(e) Notes of Advisory Committee on 2007 amendments to Rule 26(e) (Former Rule 26(e) “stated the duty to supplement or correct a disclosure or discovery response ‘to include information thereafter acquired.’ This apparent limit is not reflected in practice; parties recognize the duty to supplement or correct by providing information that was not originally provided although it was available at the time of the initial disclosure or response. These words are deleted to reflect the actual meaning of the present rule.”) (emphasis added).

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Since the issuance of the Board's Order, Caterpillar diligently worked to identify and produce responsive documents. *See* Johnson Decl., ¶¶ 2, 4, 11. It investigated and collected a wide-variety of information from numerous departments within the company, working with individuals within those departments, as well as coordinating with Caterpillar's in-house legal staff and outside counsel. *Id.* at ¶¶ 2, 4. To date, Caterpillar has produced more than 11,000 pages of documents in response to the Board's Order. *Id.* at ¶ 11.

Caterpillar complied with the Board's Order by producing documents on the March 6, 2015 deadline related to each category of production requests and has been continuously producing additional relevant documents as soon as those become available. *See Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 U.S.P.Q.2d 1389, 1392 (T.T.A.B. 2007) ("A party is required to respond completely to discovery to the best of its ability and to supplement discovery responses as soon as it becomes aware of new information [pursuant to] Fed. R. Civ. P. 26(e)."). Such production efforts are now complete (to the extent currently known to Caterpillar). *See* Johnson Decl., ¶ 11. Therefore, Caterpillar's production of relevant discovery is in full compliance with Fed. R. Civ. P. 26(e), and does not constitute a discovery violation.

Furthermore, Tigercat has not and cannot show any prejudice as a result of Caterpillar's supplementation of its discovery responses after the March 6, 2015 deadline. Caterpillar's discovery was produced weeks before the close of discovery and prior to the scheduling of any testimony depositions of Caterpillar's witnesses. *See, e.g., Starbucks U.S. Brands, LLC v. Ruben*, 78 U.S.P.Q.2d 1741, 1747 (T.T.A.B. 2006) ("As to any prejudice claimed by applicant, we note that all of Starbucks' extensive production took place well in advance of opposers' testimony deposition of Colleen Chapman, when many of these documents were introduced.");

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*Gen. Motors Corp. v. Integrated Concepts & Research Corp.*, 2005 TTAB LEXIS 125 , \*9-10 (T.T.A.B. Mar. 9, 2005) (non-precedential) (“Applicant has not provided any basis for us to conclude that opposer deliberately refrained from serving these supplemental responses earlier, nor has applicant demonstrated any prejudice to it as a result of opposer’s discovery responses not being produced earlier.”) (attached as Ex. F to Johnson Decl.).

Moreover, Caterpillar has offered to extend the current discovery period, if needed. Johnson Decl., ¶ 13. It is worth noting that Tigercat, itself, just produced more than 1,300 pages of new production documents and served new follow-up discovery requests seeking further information regarding third-parties identified in Caterpillar’s response to Interrogatory No. 12 and documents produced in response to Request for Production Nos. 24, 26, 27, and 28. *Id.* at ¶ 8.

### **III. Sanctions Are a Drastic Remedy Not Warranted in this Case**

Contrary to Tigercat’s contentions, Caterpillar has taken extensive steps to timely and fully comply with the Board’s Order, and it is continuing to do so.

First, Tigercat requests an order that “Opposer may not rely at trial on discovery materials disclosed only after entry of sanctions against it.”<sup>5</sup> Motion at 8. While Tigercat does not specify, Caterpillar presumes that its requested sanctions are limited to documents related to

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<sup>5</sup> The *Highbeam Marketing* case cited by Applicant is distinguishable. Unlike *Highbeam Marketing*, Caterpillar’s productions after March 6, 2015 did not violate any Board Order. Further, in *Highbeam Marketing*, it was clear based on the volume of the applicant’s supplemental production (1,100 pages of documents) attached to its opposition to the motion for sanctions, that its earlier production (300 pages of documents) had been woefully deficient. Here, Caterpillar produced more than 21,000 pages of documents before Applicant’s filed the motion for sanctions, and its post-motion production, which had already been identified to Tigercat, consisted of approximately 1,100 pages. Accordingly, the situation here is nothing like in *Highbeam Marketing*.

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Interrogatory Nos. 9, 11, and 12 and Request for Production Nos. 24, 26, 27 and 28. Tigercat has no basis to prevent Caterpillar's production of other documents during the discovery period.

As it indicated it would in its April 2, 2015 letter to Tigercat (prior to Tigercat filing the Motion for Sanctions), Caterpillar has completed its production of market research and consumer survey documents and knows of no additional representative documents responsive to these document requests. *See* Johnson Decl., ¶ 11. In the event that additional relevant materials are discovered during the discovery period, no limitation should be placed on production of these materials, as Fed. R. Civ. P. 26(e) expressly contemplates supplementation of this nature.

Second, Tigercat requests that Caterpillar be "precluded from denying that there are third party users of the term 'Cat' for the goods and services identified in Opposer's relied upon registrations." Motion at 8. In identifying more than 8,400 references containing the term "cat," Caterpillar has already admitted just what this sanction would require.

Third, Tigercat requests that Caterpillar be precluded from relying on any market research or consumer studies done by or on behalf of Caterpillar of any third party related to Caterpillar's marks. Motion at 8. Exclusion of evidence is an extreme remedy that should be exercised with caution. *See, e.g., Johnston Pump/Gen. Valve, Inc. v. Chromalloy Am. Corp.*, 13 U.S.P.Q.2d 1719, 1720 (T.T.A.B. 1989) ("Emphasized throughout the Federal Rules of Civil Procedure is the importance of resolving actions on the merits whenever possible."). That should be particularly true in this case where the discovery period is far from over and Caterpillar has progressively sought to supplement its production with responsive documents.

Notably, Tigercat's request would exclude all marketing research and consumer survey documents currently in the production, including documents produced prior to the Board's

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March 6, 2015 date. Tigercat points to no case law supporting these demands demonstrating that this request wholly lacks foundation or rationale basis.

Fourth, Tigercat requests an adverse inference against Caterpillar, namely that

Opposer has no market research conducted prior to the filing of the application for registration herein opposed that establishes:

(1) that the asserted marks of Opposer are famous among the general public in the United States; and

(2) that the term “CAT” as used by Opposer is associated with anything other than “CATERPILLAR” in the relevant markets.

Motion at 8-9.

The basis for Tigercat’s request is that Caterpillar has failed to produce market research and consumer studies. As detailed above, no such failure has occurred. Moreover, the submitted evidence directly contradicts Tigercat’s requested inference.

In any event, an adverse inference is an “extreme sanction” that “should not be given lightly.” *Zubulake v. UBS Warburg LLC*, 220 F.R.D. 212, 220 (S.D.N.Y. 2003). Failure to timely produce documents, in and of itself, is insufficient for an adverse interference without evidence that the delay in producing documents was “motivated by bad faith or any other impermissible motive.” *Pall Corp. v. 3M Purification, Inc.*, 279 F.R.D. 209, 213 (E.D.N.Y. 2011); *see also, e.g., Chesapeake Bank v. Chesapeake Bank of Maryland*, 2004 WL 240313, at \*4 (T.T.A.B. Feb. 5, 2004) (non-precedential) (“an adverse inference may be drawn against a party who destroys relevant evidence.”) (attached as Ex. G to Johnson Decl.).

At every turn, Caterpillar has sought to comply with Board’s Order and supplement its responses to provide the requested discovery. Nothing about Caterpillar’s actions suggest bad faith, dishonesty, or that it was intentionally withholding documents. To the contrary, Caterpillar

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has diligently worked to identify responsive documents and address Tigercat's questions regarding the existence of additional materials. Tigercat provides no evidence or arguments that bad faith exists, and it is well settled that Caterpillar is not required to manufacture documents that simply do not exist in order to comply with the Board's Order. *See Converse Inc.*, 2004 WL 950919, at \*4, n.8.

Finally, as discussed in Section II.C, Tigercat can point to no prejudice that it has suffered from Caterpillar's completed production of marketing and consumer documents. In stark contrast, if the Board imposes the disproportionately harsh sanction of exclusion of evidence or an adverse inference, "Opposer will not be able to prove one prong of the test for dilution, the second ground for Opposition." Motion at 9. Such a statement is telling in Tigercat's motivations for filing its sanctions motion, as well as emphasizing the extreme prejudice that Caterpillar will suffer if this motion is granted.

### III. CONCLUSION

In view of the above, Caterpillar respectfully requests that Applicant's Motion be denied in its entirety.

Dated: April 22, 2015

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing OPPOSER CATERPILLAR INC.'S BRIEF IN OPPOSITION TO APPLICANT TIGERCAT INTERNATIONAL INC.'S MOTION FOR SANCTIONS AND SUSPENSION OF PROCEEDINGS was served via electronic mail and first-class mail, postage prepaid, on April 22, 2015 upon counsel for Applicant:

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