

ESTTA Tracking number: **ESTTA542025**

Filing date: **06/06/2013**

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

Proceeding	92056035
Party	Plaintiff The Armor All/STP Product Company
Correspondence Address	CRAIG S MENDE FROSS ZELNICK LEHRMAN & ZISSU PC 866 UNITED NATIONS PLAZA NEW YORK, NY 10017 UNITED STATES jjones@fzlz.com, cmende@fzlz.com
Submission	Other Motions/Papers
Filer's Name	Jason D. Jones
Filer's e-mail	jjones@fzlz.com, cmende@fzlz.com, mortiz@fzlz.com
Signature	/Jason D. Jones/
Date	06/06/2013
Attachments	J. Jones Dec. in Supp. of SJ Motion with Exhibit A (F1239405).PDF(221508 bytes )

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

In the matter of Registration No. 4,137,345  
Mark: StP & Design

-----X	:	
THE ARMOR ALL/STP PRODUCTS	:	
COMPANY,	:	
	:	
Petitioner,	:	<b>Cancellation No. 92056035</b>
	:	
- against -	:	
	:	
LIMITED LIABILITY COMPANY;	:	
“AUTOPLASTIC,”	:	
	:	
Autoplastic.	:	
-----X	:	

**DECLARATION OF JASON D. JONES, ESQ.  
IN SUPPORT OF PETITIONER’S MOTION FOR SUMMARY JUDGMENT**

I, Jason D. Jones, hereby declare under penalty of perjury:

1. I am an attorney at Fross Zelnick Lehrman & Zissu, P.C., attorneys for Petitioner The Armor All/STP Products Company (“Petitioner”). I submit this declaration in support of Petitioner’s Motion for Summary Judgment. I make this declaration based on personal knowledge of the facts and circumstances set forth herein, my review of my firm’s records, and on the records of the Trademark Trial and Appeal Board (the “Board”) and the Patent and Trademark Office (the “PTO”).

**A. Procedural Background**

2. Petitioner filed its Petition to Cancel in this proceeding on August 10, 2012 and the Board instituted the proceeding as Cancellation No. 92056035 six days later and issued the governing scheduling order. (See TTABVUE Dkt. ##1-2).

3. Autoplastic, represented by U.S. counsel Mr. Sergei Orel, filed its Amended Answer to the Petition to Cancel on December 15, 2012. (TTABVUE Dkt. # 10).

**B. Autoplastic Fails to Respond to Petitioner's Discovery Requests**

4. Under the Board's governing scheduling order, discovery opened on December 24, 2012. (TTABVUE Dkt. ## 6-7).

5. On December 24, 2012, Petitioner served on Autoplastic's counsel Petitioner's First Set of Requests for Admission ("Petitioner's Requests for Admission"), Petitioner's First Set of Interrogatories ("Petitioner's Interrogatories"), and Petitioner's First Set of Requests for the Production of Documents and Things ("Petitioner's Document Requests" and, collectively with Petitioner's Interrogatories and Petitioner's Requests For Admission, "Petitioner's Discovery Requests"). At this same time, Petitioner served Autoplastic with Petitioner's Initial Disclosures. A true and correct copy of Petitioner's Requests for Admission are attached hereto as **Exhibit A**, along with the "Definitions" from Petitioner's Interrogatories which were incorporated by reference into Petitioner's Requests for Admission.

6. Under the applicable rules, Autoplastic's responses to Petitioner's Discovery Requests were due on or before January 23, 2013.

7. Autoplastic did not respond to Petitioner's Discovery Requests, or request an extension of the deadline from Petitioner or the Board, on or before January 23, 2013.

8. Following Autoplastic's failure to respond to Petitioner's Discovery Requests, Petitioner engaged in a lengthy meet and confer process with Autoplastic's counsel.

9. On February 27, 2013, when Autoplastic still had not served any responses, Petitioner filed a motion to compel Autoplastic to respond to Petitioner's Interrogatories and Document Requests without objection. (*See* TTABVUE Dkt. #12). In its motion, Petitioner also requested that the Board rule, pursuant to Fed. R. Civ. P. 36, that all of Petitioner's Requests for Admission were deemed admitted as a matter of law because Autoplastic had failed to respond to

Petitioner's Requests for Admission. (TTABVUE Dkt. # 12 at p. 11 & n.1; *see also* TTABVUE Dkt. # 16 at p. 5).

10. On May 21, 2013, the Board granted Petitioner's motion to compel in its entirety. (TTABVUE Dkt. # 17).

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 6<sup>th</sup> day of June, 2013.

  
\_\_\_\_\_  
Jason D. Jones

# EXHIBIT A

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

In the matter of Registration No. 4,137,345  
Mark: StP & Design

-----X	:	
THE ARMOR ALL/STP PRODUCTS	:	
COMPANY,	:	
	:	
Petitioner,	:	<b>Cancellation No. 92056035</b>
	:	
- against -	:	
	:	
LIMITED LIABILITY COMPANY;	:	
“AUTOPLASTIC”	:	
Registrant.	:	
-----X		

**PETITIONER’S FIRST SET OF REQUESTS FOR ADMISSION TO REGISTRANT**

Pursuant to Rule 2.120(h) of the Trademark Rules of Practice and Rule 36 of the Federal Rules of Civil Procedure, Petitioner The Armor All/STP Products Company (“Petitioner”) requests that Registrant Limited Liability Company “Autoplastic” (“Registrant” or “Autoplastic”) admit the truth of the following matters by serving written responses thereto to Fross Zelnick Lehrman & Zissu P.C., 866 United Nations Plaza, New York, New York 10017, Attn.: Jason D. Jones, within the time specified by the Trademark Rules of Practice and the Federal Rules of Civil Procedure.

## **DEFINITIONS**

The definitions set forth in Petitioner's First Set of Interrogatories to Registrant served on December 24, 2012 are incorporated by reference as if fully set forth herein.

## **INSTRUCTIONS**

1. If Registrant fails specifically to admit or deny any of the Requests for Admission ("Requests," and each, a "Request"), or to set forth with particularity the reasons why it cannot admit or deny the given Request, the Request will be deemed admitted.
2. These Requests seek responses from Registrant that are complete and fully responsive as of the date the responses are executed, and which reflect or embody all relevant information and documentation within the custody or control of Registrant as of that date. Should Registrant later learn that any response was incomplete or incorrect when made, or although correct when made is no longer accurate, Registrant should timely supplement the response as required by Rule 26 of the Federal Rules of Civil Procedure.
3. No part of a Request shall be left unanswered merely because an objection is interposed as to any part thereof. Where Registrant makes an objection to any Request, Registrant should make the objection in writing and state all grounds with specificity.
4. For the convenience of the Board and the parties, Registrant should quote each Request in full immediately preceding the response.

## **REQUESTS FOR ADMISSION**

### **Request 1**

Admit that Registrant was aware of Petitioner's STP mark used in connection with automotive products before adopting Registrant's Mark in connection with any goods in the U.S.

### **Request 2**

Admit that Registrant was aware of Petitioner's STP mark used in connection with automotive products before applying to register Registrant's Mark in connection with any goods in the U.S.

### **Request 3**

Admit that Registrant was aware of Petitioner's registrations for Petitioner's STP mark before applying to register Registrant's Mark in connection with any goods in the U.S.

### **Request 4**

Admit that Registrant was aware of Petitioner's registrations for Petitioner's STP mark before adopting Registrant's Mark in connection with any goods in the U.S.

### **Request 5**

Admit that Petitioner's STP mark is famous in the U.S. in connection with automotive products.

### **Request 6**

Admit that you have no evidence that Petitioner's STP mark is not famous in the U.S. in connection with automotive products.

Request 7

Admit that Registrant's Mark and Petitioner's STP mark are highly similar in appearance.

Request 8

Admit that Registrant's Mark and Petitioner's STP mark are aurally indistinguishable.

Request 9

Admit that Registrant's Mark and Petitioner's STP mark create a highly similar commercial impression.

Request 10

Admit that the consumers for the goods offered or intended to be offered under Registrant's Mark may overlap with consumers of Petitioner's goods sold under Petitioner's Marks.

Request 11

Admit that the consumers for the goods offered or intended to be offered under Registrant's Mark will overlap with consumers of Petitioner's goods sold under Petitioner's Marks.

Request 12

Admit that Registrant has no evidence that the consumers for the goods offered or intended to be offered under Registrant's Mark would not overlap with consumers of Petitioner's goods sold under Petitioner's Marks.

Request 13

Admit that Registrant's goods offered or intended to be offered under Registrant's Mark will be advertised in the same channels as Petitioner's goods sold under Petitioner's Mark.

Request 14

Admit that Registrant's goods offered or intended to be offered under Registrant's Mark may be advertised in the same channels as Petitioner's goods sold under Petitioner's Mark.

Request 15

Admit that the Registration places no restrictions on the class of consumers to whom Registrant intends to market goods offered under Registrant's Mark.

Request 16

Admit that Registrant intends to market goods offered under Registrant's Mark to any and all consumers.

Request 17

Admit that both Registrant's goods offered under Registrant's Mark and Petitioner's goods offered under Petitioner's Marks are advertised or promoted over the Internet.

Request 18

Admit that Registrant or its licensee for Registrant's Mark sponsored the television program Outcast Kustoms.

Request 19

Admit that Petitioner has promoted its products on the television program Outcast Kustoms.

Request 20

Admit that Petitioner is well known for its sponsorship of professional race car driving.

Request 21

Admit that Registrant's Mark is used in connection with promotion of professional race car activities.

Request 22

Admit that Registrant's goods offered or intended to be offered under Registrant's Mark are similar to Petitioner's goods offered under Petitioner's Mark.

Request 23

Admit that Registrant's goods offered or intended to be offered under Registrant's Mark are related to Petitioner's goods offered under Petitioner's Mark.

Request 24

Admit that Registrant uses Registrant's Mark on automotive products.

Request 25

Admit that Registrant's goods offered or intended to be offered under Registrant's Mark are or will be sold through the same channels of trade as Petitioner's goods offered under Petitioner's Mark.

Request 26

Admit that the Registration places no restrictions on the channels of trade through which goods offered under Registrant's Mark will be marketed.

Request 27

Admit that Registrant does not intend to restrict the channels of trade through which goods offered under Registrant's Mark will be marketed.

Request 28

Admit that Petitioner did not consent to Registrant's application to register Registrant's Mark.

Request 29

Admit that you have no evidence that Petitioner acquiesced in Registrant's use of Registrant's Mark.

Request 30

Admit that you are not aware of any third party use of the STP mark in connection with automotive products.

Request 31

Admit that you have no evidence that consumers associate the mark STP with any entity other than Petitioner.

Request 32

Admit that you have no evidence that consumers associate goods or services offered under the mark STP with any entity other than Petitioner.

Request 33

Admit that Registrant does not use Registrant's Mark in the blue and white colors shown in the Registration in connection with the goods identified in the Registration.

Request 34

Admit that Registrant has no intention to use Registrant Mark in the blue and white colors shown in the Registration in connection with the goods identified in the Registration.

Request 35

Admit that Registrant has discontinued use of Registrant's Mark in the blue and white colors shown in the Registration in connection with Registrant's goods, with intent not to resume such use.

Request 36

Admit that Registrant's Mark is primarily displayed in red and white coloring on packaging and promotional materials.

Request 37

Admit that Registrant has no current plans to display Registrant's Mark primarily in blue and white coloring on packaging and promotional materials.

Request 38

Admit that Registrant claims no rights in or to Registrant's Mark in the U.S. prior to April 2010.

Request 39

Admit that Registrant does not challenge Petitioner's standing to bring the instant Cancellation proceeding.



**CERTIFICATE OF SERVICE**

I hereby certify that on this 24th day of December, 2012, I caused a true and correct copy of **PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSION TO REGISTRANT** to be emailed per the agreement of counsel to Applicant's counsel of record at the following email addresses:

Sergei Orel, Esq.  
Miskin & Tsui-Yip, LLP  
[sergei@mt-iplaw.com](mailto:sergei@mt-iplaw.com)  
[sorel@sergei-orel.com](mailto:sorel@sergei-orel.com)

\_\_\_\_\_  
/s/ Jason D. Jones  
Jason Jones



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

In the matter of Registration No. 4,137,345

Mark: StP & Design

-----X	:	
THE ARMOR ALL/STP PRODUCTS	:	
COMPANY,	:	
	:	
Petitioner,	:	<b>Cancellation No. 92056035</b>
	:	
- against -	:	
	:	
LIMITED LIABILITY COMPANY;	:	
“AUTOPLASTIC,”	:	
	:	
Registrant.	:	
-----X		

**PETITIONER’S FIRST SET OF INTERROGATORIES TO REGISTRANT**

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rules 26 and 33 of the Federal Rules of Civil Procedure, Petitioner The Armor All/STP Products Company (“Petitioner”) requests that Registrant Limited Liability Company “Autoplastic” (“Registrant” or “Autoplastic”) answer the following interrogatories by serving written responses thereto at the offices of Petitioner’s attorneys, Fross Zelnick Lehrman & Zissu, P.C., 866 United Nations Plaza, New York, New York 10017, Attention: Jason D. Jones, within the time specified by the Federal Rules of Civil Procedure as incorporated by the Trademark Rules of Practice.

**DEFINITIONS**

A. “Agreement” means any written or oral contract, understanding, agreement or agreement in principle, all schedules, exhibits or other documents ancillary thereto or referred to therein, and all drafts of and amendments to the foregoing.

B. “All” and “each” shall each be construed as “all and each.”

C. “And” and “or” shall each be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside of its scope.

D. “Amended Answer” means the Amended Answer to Petition for Cancellation and Affirmative Defenses dated December 14, 2012 filed by Registrant in this proceeding.

E. “Affirmative Defenses” means the Affirmative Defenses asserted by Registrant in paragraphs 1-13 on pages 7 through 10 of the Amended Answer.

F. “Communication” means, without limitation, the transmittal of information (in the form of facts, ideas, inquiries or otherwise), including, but not limited to, meetings, discussions, conversations, telephone calls, recordings, photographs, notes, memoranda, letters, facsimiles, email and the transmittal of information in the form of agreements.

G. “Concerning” means relating to, referring to, describing, evidencing or constituting.

H. “Describe,” with respect to oral communications, means to state or identify the date, time of day, duration, location, persons involved, witnesses, physical occurrences, and a summary of the substance of any conversations. With respect to documents, “describe” means to identify the type of document, its date, its author, its recipients, and to offer a summary of the substance thereof.

I. “Document” is used in the broadest sense possible consistent with the Federal Rules of Civil Procedure as adopted by the Trademark Rules of Practice and includes, without limitation, non-identical copies (whether different from the original because of underlining, editing marks, notes made on or attached to such copy, or otherwise), and drafts, whether printed or recorded (through a sound, video or other electronic, magnetic or digital recording system) or reproduced by hand, including but not limited to writings, recordings, photographs, letters,

correspondence, purchase orders, invoices, facsimiles, telegrams, telexes, memoranda, records, summaries, minutes, records or notes of personal conversations, interviews, meetings and/or conferences, note pads, notebooks, postcards, “Post-It” notes, stenographic or other notes, opinions or reports of consultants, opinions or reports of experts, projections, financial or statistical statements or compilations, checks (front and back), contracts, agreements, appraisals, analyses, confirmations, publications, articles, books, pamphlets, circulars, microfilms, microfiche, reports, studies, logs, surveys, diaries, calendars, appointment books, maps, charts, graphs, bulletins, tape recordings, videotapes, disks, diskettes, compact discs (CDs), data tapes or readable computer-produced interpretations or transcriptions thereof, electronically-transmitted messages (email), voicemail messages, inter-office communications, advertising, packaging and promotional materials, and any other writings, papers and tangible things of whatever description whatsoever, including but not limited to all information contained in any computer or electronic data processing system, or on any tape, whether or not already printed out or transcribed.

J. “Identify” when used in reference to:

i) a current officer or employee of Registrant means to state the person’s full name and title or position;

ii) a former officer or employee of Registrant means to state, to the extent known, the person’s full name, last title or position with Registrant, and the person’s present business affiliation, and business addresses and telephone number or residential address and telephone number;

iii) any other person means to state, to the extent known, the person’s full name, present or last known address, and the current or last known place of employment and business addresses and telephone number;

iv) an oral communication means to describe the date and time of the communication, the place where the communication occurred, the persons involved in the communication, any other person present, and the substance of the communication;

v) a business entity or institution means to state, to the extent known, its full name, address and telephone number;

vi) a document means to describe the document with specificity, including, where applicable, the subject matter of the document, its date, the name, title and address of each writer or sender and each recipient, its present location and custodian, and, if any such document is not in Registrant's possession or subject to its control, state what disposition was made of it, by whom, and the date thereof. Registrant may furnish a copy of the document in lieu of identifying it, provided: (a) the document contains the above information or Registrant separately furnishes such information when furnishing the document, (b) Registrant identifies the production number of such document in its response; and (c) Registrant follows the Instructions set forth in Petitioner's First Set of Requests for the Production of Document and Things to Registrant.

K. "Market Research" includes all surveys, polls, focus groups, trademark and/or any other searches, market research studies and other investigations, whether or not such investigations were completed, discontinued or fully carried out, and whether or not they were preformed in connection with this Opposition.

L. "Petitioner," means Petitioner The Armor All/STP Products Company.

M. "Petition to Cancel" means the Petition to Cancel filed in this proceeding.

N. "Petitioner's Marks" means the STP Marks as set forth in paragraphs 1 and 6 of the Petition to Cancel.

O. "Person" means any natural person or any business, legal or governmental entity

or association.

P. “Registrant,” “you,” or “your” means Autoplastic and any company controlled by or affiliated with it; any division, parent, subsidiary, licensee, franchisee, successor, predecessor-in-interest, assign or other related business entity; and every officer, employee, agent, attorney or other person acting or purporting to act on its behalf or through whom it acts or has acted, and the predecessors or successors of any of them.

Q. “Registrant’s Mark” means the mark that is the subject of Registrant’s U.S. Registration No. 4,137,345.

R. “Registration” means U.S. Registration No. 4,137,345.

S. “Set Forth the Basis” with respect to an allegation or contention, or denial of an allegation or contention, means to state all facts and bases on which Registrant is relying in support of such allegation, contention, or denial and to identify all documents concerning such allegation, contention, or denial (including both those supporting and those tending to negate the allegation, contention, or denial).

T. When not capitalized, “mark,” “trademark” and “trade name” each incorporate trademarks, service marks, trade names and service names.

U. “Thing” means any tangible object.

V. The use of the singular form of any word includes the plural and vice versa.

W. References to the masculine gender shall apply equally to the feminine gender.

**CERTIFICATE OF SERVICE**

I hereby certify that on June 6, 2013, a copy of the foregoing **DECLARATION OF JASON D. JONES IN SUPPORT OF PETITIONER'S MOTION FOR SUMMARY JUDGMENT (with exhibits)** was sent by First Class mail, postage pre-paid, to Autoplastic's counsel of record at the following addresses:

Sergei Orel, Esq.  
Miskin & Tsui-Yip, LLP  
1350 Broadway, Suite 802  
New York, NY 10018

  
\_\_\_\_\_  
Jason D. Jones