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

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TRADEMARK TRIAL AND
APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.

Opposer,

v.

TBC CORPORATION,

Applicant.

EXHIBITS

Opposition No. 121,151

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57



04-18-2002

APPLICANT'S MOTION FOR JUDGMENT

COMES NOW the Applicant, TBC Corporation [hereinafter "TBC" or "Applicant"], through undersigned counsel, and pursuant to the Board's March 11, 2002 Order, 37 C.F.R. §2.120(g)(1), and TBMP §527, hereby moves for an Order from the Trademark Trial and Appeal Board (the "Board") entering judgment against Opposer. In support of this Motion, Applicant states as follows.

On January 14, 2002, Applicant filed its Motion to compel. Under the Rules, Opposer's opposition papers were due to be filed and served on February 3, 2002. See 37 C.F.R. §§2.127(a) and 2.119(c). Since no response was made, Applicant filed its Notice of Failure to Respond to Motion to compel on February 20, 2002. Opposer filed no response to this latter paper.

On March 11, 2002, the Trademark Trial and Appeal Board ("Board") issued an Order granting Applicant's Motion to compel ("Order"). Specifically, the Order stated:

opposer is hereby ordered to serve no later than **THIRTY DAYS** from the mailing date of this order to submit its responses, *without objection*, to applicant's first set of interrogatories and first request for production of document.

In the event that opposer fails to respond to applicant's discovery requests as ordered herein, applicant's remedy lies in a motion for judgment

See Order, p. 1 (*italics supplied, bold in original*). Thus, Opposer's responses were due to be properly served no later than April 10, 2002, under pain of default judgment.

Attached hereto as Exhibit A - C are Opposer's responses to Applicant's written discovery, *to wit*, Opposer's Response to Applicant's First Request for Admissions¹, Opposer's Response to Applicant's First Request for Production of Documents, and Opposer's Response to Applicant's First Set of Interrogatories. These responses are immediately remarkable for the absence of a dated and executed Certificate of Service. Rather, under the blank signature line for each Certificate, it simply states "To be signed by Charles J. Boudreau." Moreover, the only date on each Certificate is "April ___, 2002." This is improper under the Rules, and especially problematic in light of the Board's March 11, 2002 Order, which required service by April 10, 2002.

The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") states that the Board will accept, as prima facie proof, that a party "has served a copy of the paper upon every other party to the proceeding, a statement *signed by the filing party, or by its attorney* or other authorized representative, *clearly stating the date* and manner in which service was made." TBMP §113.03 (*emphasis supplied*). No such certificate has been supplied. Indeed, the Certificate is both undated and unsigned. The Order mandated that Opposer properly serve discovery responses by April 10, 2002. There is no indication from the record that Opposer complied with this requirement.²

¹ Since Opposer failed to timely served such responses, "the requests will stand admitted (automatically)" by operation of law. See Trademark Trial and Appeal Board Manual of Practice ("TBMP") §527.04 and §411.01.

² It is not for Applicant to have to prove the date of actual service – only that Opposer failed to comply with the requirements of the Order.

Moreover, the core of the remedy found in the Board's Order was that Opposer was "to submit its responses, *without objection*, to applicant's first set of interrogatories and first request for production of document." See Order, p.1 (emphasis supplied). Contrary to this unambiguous, stark admonition – in immediate textual proximity to the Board's suggested remedy of a default judgment – Opposer's responses are rife with objections. A most superficial review of these responses reveals that Opposer has interposed numerous objections, albeit without intoning the talisman of "objection."

For example, Opposer refuses to produce or disclose purportedly "confidential" documents and information until after the "entry of a suitable protective order in this proceeding³." This refusal is based on an objection ostensibly on the grounds of confidential information. In fact, Opposer's responses are *riddled* with this "objection." See Exhibit B, document response nos. 1, 2, 7, 9, 11, 12, 13, 14, 15, 18, 21, 22, 23, 24, 29, 30, 31, 34, 35, 36, 48 and 50. *cf.* document response no. 3; Exhibit C, interrogatory response nos. 2, 4, 5, 7, 15, 17, 23, 24.

Additionally, Opposer seeks to interpose a "privilege" objection in response to numerous requests⁴. See Exhibit B, document response nos.1, 2, 4, 5, 6, 7, 8, 9, 11, 14, 17, 18, 21, 22, 23, 26, 27, 28, 29, 31, 32, 34, 35, 36, 37, 42, 43, 48; *cf.* document response no. 3; Exhibit C, interrogatory response nos. 15, 20, and 21.

³ Any objection on the purported grounds of "confidentiality" is wholly improper under the Order. However – and only as an aside – Opposer's objection relates to the withholding of information until *after* a protective order is entered, yet it has not even supplied a proposed protective order.

⁴ The nature of the alleged privilege is not immediately clear – nor is it relevant in light of the Board's Order requiring responses be served without objection. Moreover, not only has Opposer improperly interposed these "privilege" objections contrary to the Board's Order, but has done so without providing the information required under Instruction CC.

Moreover, Opposer's responses have included an unwarranted limitation that it will only produce "available, non-privileged documents" or "any available, non-privileged documents" or "available documents." See Exhibit B, document response nos. 7, 8, 13, 16, 21, 22, and 28. The unwarranted limitation of producing only "available [] documents" is tantamount to an objection on the bases that the request is "overly broad" and/or "unduly burdensome." Interposition of such objection(s) is untenable under the clear and express terms of the Board's Order.

Despite the Order's unambiguous mandate for Opposer "to submit its responses, *without objection*, to applicant's first set of interrogatories and first request for production of document," Opposer's discovery responses are littered with such objections. Indeed, nearly half of the fifty document requests were responded to by Opposer with an objection on grounds of confidentiality alone. In sum, Opposer has interposed seventy (70) objections in its responses to Applicant's discovery requests. Such blatant disregard for the Board's Order – articulated in unambiguous terms – is untenable and worthy of entry of default judgment as contemplated by the Order.

Further, Opposer failed to execute the responses to Applicant's interrogatories. Indeed, there is not even a signature block identifying the person expected to execute the responses. See Exhibit C. Thus, it appears Opposer has no intention of executing these long overdue, and Board-ordered, responses. The Rules are quite clear that interrogatory responses are to be signed. Rule 33 of the Federal Rules of Civil Procedure states, in relevant part: "The answers are to be signed [under oath] by the person making them, and the objections signed by the attorney making them") See also TBMP §407.02 ("If an interrogatory is answered, the answer must be made separately and fully, in writing *under oath*.")) (emphasis supplied). Thus, under Rule 33, the only reason for counsel to sign the interrogatory responses is to verify the objections are made pursuant to Rule 11. However, in this

case, since no objections may be interposed by Order of the Board, then counsel's signature is not required⁵. As such, the document is virtually unexecuted⁶.

Finally, Opposer has failed to produce any documents in response to Applicant's written discovery, which was served over five (5) months ago. The Order compelled Opposer to respond to Applicant's written discovery – which includes producing documents. Moreover, Opposer may not withhold any of its document production on the basis of an “objection,” in light of the Board's Order. Thus, Opposer's continuing failure to produce documents is not only baffling, but, in any case, violative of the Board's Order.

The consequence of a failure to comply with a Board's order relating to discovery is clearly set forth in the Trademark Rules, *see* 37 CFR §2.120(g), and all who practice before the Board are charged with such knowledge. However, the Board took the extraordinary step of expressly stating the consequence in the body of the Order – immediately succeeding the core of the Order. The Order stated, in relevant part:

In the event that opposer fails to respond to applicant's discovery requests as ordered herein, *applicant's remedy lies in a motion for judgment* pursuant to Trademark Rule 2.120(g)

See Order, p. 1 (Emphasis supplied). This stark warning was even more extraordinary in that the Board carefully crafted the admonition in terms of a “Motion for judgment.” *Id.* It is evident that Rule 1.120(g) adopts the sanctions found in Rule 37(b) of the Federal Rules of Civil Procedure; and that one of the numerous sanctions expressly stated in that rule is “rendering a judgment by default

⁵ Alternatively, this evidences the imposition of the above-referenced objections.

⁶ There are other defects in Opposer's discovery responses, however, a recitation of such is unnecessary in the present Motion.

against the disobedient party.” *See Fed.R.Civ.Pro. 37(b)(2)(C)*. Thus, instead of using the language of a “Motion for Sanctions” or a “Motion under Rule 1.120”, the Board presaged the sanction it would levy in consequence of Opposer’s failure to comply with the Board’s rules and Order by using the term “Motion for Judgment.”

Moreover, the Board should not countenance any complaint about the merits of its Order – that horse has long left the stable. By failing to timely respond to Applicant’s written discovery, by failing to respond – or even acknowledge – Applicant’s written inquiries regarding such responses, by failing to respond to Applicant’s Motion to compel, by failing to respond to Applicant’s Notice of Failure to Respond said Motion, and by failing to timely⁷ seek reconsideration, modification and/or clarification of the Board’s Order, Opposer is woefully without any ability to contest the terms of the Order. Indeed, it is respectfully submitted that, to allow Opposer to now begin to negotiate the terms under which it will comply with the Board’s Order at this late date and in light of the above-referenced failures, would be to reduce the Board’s Orders and rules to meaningless guidelines, which can be violated with impunity.

Applicant has expended considerable sums in attempting to get Opposer – the very party whom initiated this proceeding that has delayed registration of Applicant’s mark – to comply with the most basic of discovery obligations (*e.g.*, letters, filing Motion to compel and related papers, the present Motion). These good faith efforts have been wholly ignored by Opposer, who has not even deigned to acknowledge them! Indeed, before the Order issued, the last action taken by Opposer to further either the settlement discussions or the inter partes proceeding was to issue written discovery on January 18, 2001 – fifteen months ago. Since the issuance of Applicant’s written discovery, it

⁷ In any event, Opposer is out of time to file any such Motion. *See* 37 C.F.R. §2.127(b).


has taken several letters, two Motions and an Order from this Board to compel Opposer to even acknowledge its duty to respond. Moreover, as detailed above, Opposer has plainly failed to comply with the express terms of the Board's Order. Default Judgment is warranted.

WHEREFORE all of the foregoing reasons, Applicant respectfully requests that the Board follow through on its express admonition and grant Applicant's Motion for Default Judgment.

Respectfully submitted,

TBC CORPORATION

By:



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April 18, 2002

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I have caused a true and correct copy of the foregoing Applicant's Motion for Judgment was served on Opposer by first-class mail, postage prepaid, upon the following:

Mina Hamilton, Esquire
David N. Makous, Esquire
Lewis, D'Amato, Brisbois & Bisgaard LLP
221 North Figueroa Street
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and

Anthony L. Fletcher, Esquire
Fish & Richardson, P.C.
45 Rockefeller Plaza
Suite 2800
New York, New York 10111

this 18th day of April, 2002.



⁸ While Applicant's counsel received written notice on February 7, 2002 that this firm no longer represented Opposer, no substitution of counsel has been received.