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

AMERICAN HONDA MOTOR CO. INC., )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 TBC CORPORATION, )  
 )  
 Applicant. )

Opposition No. 121,151

02 DEC 26 AM 9:30  
TRADEMARK TRIAL AND APPEAL BOARD

**RESPONSE IN OPPOSITION TO OPPOSER'S  
MOTION TO EXTEND OPPOSER'S DISCOVERY PERIOD**

On December 15, 2002, the last day of discovery, Opposer filed a Motion to suspend, pending resolution of *Applicant's* Motion for reconsideration and Opposer's Request for a telephone conference, and for yet another extension of discovery. Applicant TBC Corporation ("TBC") hereby submits the following in opposition to Opposer's Motion to extend *Opposer's* discovery.<sup>1</sup> To grant Opposer yet another extension of discovery, and delay action on TBC's application further, would be nothing short of a travesty. Accordingly, the Motion should be denied.

Discovery in this opposition closed on November 14, 2001. Two months later, following Opposer's completely unexcused (to this day!) failure to respond to Applicant's discovery, Applicant timely filed a Motion to compel. In granting TBC's Motion to compel (by March 11, 2002 Order), the Board, *sua sponte*, reopened discovery – despite the fact that *neither* party requested discovery to be reopened, and there was no showing of good cause or excusable neglect for same.<sup>2</sup> In the

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<sup>1</sup> In view of the Board's December 13, 2002 Order, Opposer's Motion, insofar as it seeks a suspension of the proceedings, is moot.

<sup>2</sup> Applicant, respectfully, remains at a loss to understand why Opposer's completely  
(continued...)

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ensuing three months, until the June 9, 2002 close (of the second) discovery period, Opposer made no effort whatsoever to undertake or pursue any discovery.

Applicant TBC did file a Motion for judgment on April 18, 2002, but proceedings were not suspended until after the close of the second discovery period, on June 24, 2002, by the Board's Order of that date. Nevertheless, the Board once again reopened discovery on September 2, 2002 until December 15, 2002. In that three-plus month period, Opposer did not serve written discovery or *attempt* to take any depositions.<sup>3</sup> On October 3, 2002, *Applicant* filed a Motion for reconsideration of the Board's decision(s) to reopen discovery; on October 23, 2002, Opposer filed a response in opposition to that Motion, and requested a telephone conference. This latter request has been denied.

Opposer's Motion for extension of discovery requires a showing of good cause. The filing of Applicant's Motion for reconsideration (asking that the Board, in effect, reaffirm the November 14, 2001 close of discovery) in no way constitutes cause for *extending* discovery, let alone *good* cause. How could a Motion asking that discovery be considered closed (as it, indeed, was) possibly form a basis for extending discovery even further? Opposer's request for a telephone conference, made in response to Applicant's Motion for reconsideration, seven weeks after discovery

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<sup>2</sup>(...continued)  
unwarranted refusal to respond to discovery entitled Opposer to a second (and later, third) opportunity to take discovery of Applicant.

<sup>3</sup> Opposer claims that such would have been "futile," relying on Applicant's Motion for reconsideration, filed a month after the **third** discovery period opened, to demonstrate such futility. The Motion itself demonstrates that Applicant recognized discovery remained open in the absence of a Board Order to the contrary. Further, Applicant timely responded over one year ago to the only discovery Opposer ever served or attempted to serve in this action.

had reopened, forms no basis for extending discovery, either. Indeed, the Board has denied that request as without basis, noting that the Board would rarely grant such a request.

Opposer had a **full** six month discovery period in this action. It never sought to extend or reopen that initial period. *Opposer's* failure to respond, at all, to Applicant's discovery should not have entitled Opposer to additional discovery. Yet, Opposer had a second, and then third, "bite at the apple" – a total of six and a half months of additional discovery – for a total of over **one year of discovery!** There simply is no reason, let alone good cause, why Opposer could not have pursued and completed any discovery it required.

Well over a year ago, Applicant (timely) responded to Opposer's only effort at discovery. The only reason trial was not concluded long ago was Opposer's refusal to answer Applicant's discovery, requiring an Order compelling same. To allow Opposer to seize upon its own misconduct as a basis for obtaining yet another discovery opportunity (for only Opposer!) stands the Trademark Rules of Procedure and the Federal Rules of Procedure on their head. Any further delay in this action is completely unwarranted, and is greatly prejudicial to Applicant. Accordingly, the Motion for yet a fourth discovery period, should be denied. Further, Applicant respectfully requests that the Board issue an Order advising Opposer that no further extensions will be granted in the absence of extraordinary circumstances or Applicant's written consent.

TBC CORPORATION

By:



Marsha G. Gentner

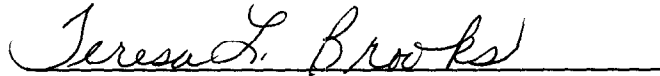
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Dated: December 20, 2002

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing RESPONSE TIN OPPOSITION TO OPPOSER'S MOTION TO EXTEND OPPOSER'S DISCOVERY PERIOD was served this 20<sup>th</sup> day of December, 2002, by mailing same, first class and postage prepaid, to the following counsel for Opposer:

Anthony L. Fletcher, Esquire  
Stacy J. Grossman, Esquire  
Fish & Richardson, P.C.  
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New York, New York 10111

A handwritten signature in cursive script, reading "Teresa L. Brooks", is written over a horizontal line.