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

AMERICAN HONDA MOTOR CO., INC.

Opposer,

v.

Opposition No. 121,151

TBC CORPORATION,

Applicant.

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APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL

The present Motion appears to be nothing more than yet another tactic in Opposer's apparent strategy to delay trial. The deadline for filing a Motion to Compel in this case was **January 14, 2002**. Applicant timely filed such a Motion because Opposer did not even respond to Applicant's discovery. Opposer seeks to seize upon its own well documented failings in order to attempt to delay the ultimate resolution of this proceeding. It is respectfully submitted that Opposer should not be allowed to profit from its own (mis)conduct. Opposer's Motion is grossly out of time, and should be denied.

I. Delay for Delay's Sake, or "The Law's Delay"¹

This proceeding was initiated on November 15, 2000 – over two years ago. If the present Motion is granted, it will have the effect of turning back the clock to January 14, 2002 – the last time that a Motion to compel would have been timely. The present Motion is but the latest stratagem in a well worn pattern long trod by Opposer. The following incidents are illustrative of the mounting delays:

¹ See Hamlet. Act iii. Sc. 1

- Based upon Opposer's apparent interest in settlement, the proceedings were suspended while Opposer "considered" Applicant's settlement offer². However, it took Opposer over six (6) months to respond to Applicant's settlement proposal – after considerable prodding by Applicant's counsel – with the totality of said response being a flat refusal of the offer, with no counterproposal;³
- Having received Applicant's timely served responses to Opposer's discovery, Opposer failed to respond to Applicant's written discovery by the December 21, 2001 deadline, necessitating Applicant's filing of a Motion to compel (with its concomitant delay);
- Opposer failed to respond to Applicant's Motion to compel by the February 3, 2002 due date or thereafter (an Order compelling discovery from Opposer subsequently issued);
- On the last day of its third discovery period, Opposer filed a Motion to suspend and/or for extension of *its* discovery period *only* (the Motion was denied for the failure to show good cause); and
- The present Motion to compel (with its concomitant delay).

² Thus, Opposer's characterization that it served its requests for production of documents "almost two years ago – on January 18, 2001," *see* Applicant's Motion to compel, p. 3, is technically accurate but misleading in light of the extensions sought based upon Opposer's feigned interest in settlement discussions. The critical event is not when Opposer served its discovery requests, but when Applicant *timely* answered them – October 9, 2001, about fifteen months before Opposer's Motion to compel was filed.

³ Of course, it is well within Opposer's prerogative to reject Applicant's settlement proposal without counter-offer. In the context of Opposer's subsequent actions, however, this conduct is illustrative of a concerted intent and pattern of delay.

Notwithstanding Opposer's claimed interest in an indefinite discovery period, it is to be noted that for over two years, Opposer has failed to issue any new written discovery or to notice any discovery depositions, despite the fact that the Board, *sua sponte*, reset the discovery period twice, for a total of more than six (6) months (in addition to the original six month period). Indeed, Opposer never pursued production of documents from Applicant before the close of the initial discovery period in this action.⁴ Its sporadic interest in production of Applicant's documents dates back only to September 24, 2002 – nearly one year after the responses were served. See Exhibit B to Declaration of Stacy Grossman in support of Opposer's Motion to compel.⁵

If the present Motion is granted, it will only represent the beginning of a new series of discovery-related motions designed for but a single purpose – delay of the trial. It will provide an informal imprimatur of the gamesmanship long engaged in by Opposer, a party which needs no such encouragement. If the past be prologue, it can be surmised that Opposer would next file a Motion to compel as to certain documents. After that motion is fully briefed and decided, Opposer would then turn its gaze to Applicant's interrogatory answers – despite the fact that they have been in Opposer's possession for over fifteen months *sans* complaint. And another Motion to compel would be filed. And another year or more would be lost.

⁴ Hence, but for Opposer's failure to respond to Applicant's discovery, Opposer would not even have had the opportunity to pursue follow-up discovery.

⁵ Opposer continues to assert that it raised concerns about Applicant's discovery responses in a May 14, 2002 letter. As Applicant previously pointed out, however, that letter only addressed *Opposer's* outstanding discovery obligations to Applicant which was the subject of Applicant's January 14, 2002 Motion to compel (granted by the Board on March 11, 2002). Nowhere in the letter does Opposer raise any defects with Applicant's responses, or Applicant's position on its document production.

Through its determined inaction in prosecuting this proceeding, Opposer has succeeded in securing another year of delay, for a grand total of nearly one and one half years delay – and counting. Now it has filed what promises to be the first in a string of discovery motions. Applicant respectfully requests that the Board put an end to this delay and put Opposer to its proofs.

II. Applicant Properly Objected to the Improper Demand for Document Production

Opposer's belated complaint with respect to Applicant's position on its document production is devoid of merit. Opposer's document requests, as served, called for production of Applicant's documents at the law offices of Opposer's counsel, in Los Angeles, California.⁶ This demand was clearly improper. *See* 37 C.F.R. §2.120(d)(2) ("The production of documents and things under the provision of Rule 34 of the Federal Rules of Civil Procedure will be made at the place *where the documents and things are usually kept*, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.") (emphasis supplied). In fact, Opposer's counsel no longer is even located in Los Angeles!

Accordingly, *over fifteen months prior to the filing* of Opposer's Motion, Applicant properly objected to such production at a place other than where the documents are kept. *See* Applicant's Response to First Request for Production of Documents and Things, General Objection B, attached as Exhibit B to Opposer's Motion to compel⁷. For a period of over eleven months, Opposer never

⁶ *See* Opposer's First Request for Production of Documents and Things, page 5, Instruction Number 6 attached to Opposer's Motion to compel as Exhibit A.

⁷ Moreover, the objection was not "buried" in a long laundry list of objections – it was one of three General Objections. Certainly, it should not have taken Opposer almost a year to "find" this objection.

raised any issue as to this (eminently proper) objection to document production in Los Angeles. Indeed, there is none. There is nothing to compel, because Applicant's objection patently is supported by the Trademark Rules of Practices and was appropriately interposed. Applicant fully, and timely, complied with its discovery obligations.

III. Opposer's Motion to Compel Is Untimely

The Trademark Rules are quite clear on the deadline for filing a Motion to compel – “[t]he motion must be filed prior to the commencement of the first testimony period *as originally set* or as reset.” 37 CFR §2.120(e)(1) (emphasis supplied). That date was January 14, 2002. Applicant filed its Motion to Compel on this date. *Applicant met this deadline.* It is also clear that Opposer failed to file any motion to compel by that date. Thus, Opposer's present Motion to compel (filed on January 16, 2003) is out of time by more than one year.

It is true that, as a consequence of Opposer's utter and completely inexcused failure to respond, *at all*, to Applicant's discovery (this was after Applicant's discovery responses had been served), an Order compelling such responses was issued, and testimony periods herein reset.⁹ This (Opposer's improper conduct) did not operate to provide Opposer with a new opportunity to meet the January 14, 2002 deadline for filing a motion to compel, which Opposer missed, however.

⁸ See Stipulation for Extension of Time, approved by the Board on October 16, 2001.

⁹ To this day, Opposer has never even attempted to offer any justification for its failure to respond to Applicant's discovery requests prior to the Board's Order compelling same, some thirteen months after such responses were due.

To understand the phrase “as originally set” in 37 CFR §2.120(e)(1), reference to the procedure for filing a Motion for summary judgment, which contains an **identical** provision on the timeliness of such a motion, is instructive:¹⁰

If testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion for summary judgment filed before a first trial period commences is timely. *Once the first trial period commences, however, any summary judgment motion filed thereafter is untimely, even if it is filed prior to the opening of a rescheduled testimony period-in-chief for plaintiff, and/or even if no trial evidence has actually been adduced by the plaintiff.*

See TBMP §528.02 (emphasis supplied). In other words, once the first testimony period begins, the option of filing a motion is foreclosed. There is no reason to interpret this identical language any differently in the context of a motion to compel.¹¹ Such a motion must be filed before the first trial period.

The first testimony period was scheduled to open – and, indeed, did open – on January 15, 2002¹². This proceeding was not suspended for consideration of Applicant's (timely filed) Motion to Compel until January 17, 2002, when the Board issued its Order. See January 17, 2002 Order (“Proceedings herein are suspended pending disposition of the motion to compel . . .”). Accordingly, Opposer's present Motion to compel is grossly out of time. Indeed, it would make absolutely no sense to allow a party which has missed the deadline for filing a motion to compel to

¹⁰ See 37 C.F.R. §2.127(e)(1): “A motion for summary judgment should be filed prior to the commencement of the first testimony period *as originally set* or reset. . .” (emphasis added).

¹¹ If anything, the deadline for a motion to compel is even more rigid. Compare Rule 2.120(e)(1) (“[t]he motion *must* be filed...”) with Rule 2.127(e)(1) (“[a] motion for summary judgment *should* be filed...”).

¹² See Stipulation for Extension of Time, approved by the Board on October 16, 2001 .

use its own discovery recalcitrance to obtain, in effect, leave to exceed that deadline. Certainly, Opposer cannot in good faith assert that as of the January 14, 2002 deadline for filing a motion to compel, it had any basis for expecting that this deadline would be reset.

To the extent that Opposer argues that the filing of Applicant's Motion to compel effectively suspended the proceeding as of the January 14, 2002 date it was filed, such contention is contradicted by the Board's January 17, 2002 Order and the Trademark Rules. In explaining various amendments to the Trademark Rules, the Board explained that the mere filing of a motion to compel does not itself suspend the proceedings. In fact this very argument was advanced to, considered and ultimately rejected by the Board:

Comments:

One organization suggested that *the filing of a motion to compel* (or a motion to test the sufficiency of an answer or an objection to a request for admission) *should automatically suspend proceedings, so that the parties would not have to wait to receive the Board's suspension order.* Two comments suggested that the rule should be more specific as to the manner of suspension, and explicitly state that, when the motion is resolved, discovery will be resumed and the moving party will be given more time for discovery if the motion is granted. A law firm commented that the proposed change "would be unnecessary if we keep the discovery at 270 days" and suggested that suspension should occur only if the motion is not decided within 45 days of filing the motion so that there would be pressure on the Board to decide discovery matters promptly.

Response:

The suggestion that the rule should be modified to provide that the filing of a motion to compel will automatically suspend proceedings has not been adopted. The Board must review the motion to ascertain, for example, whether it is timely and meets the minimal requirements for a motion to compel. Proceedings should not be suspended when a motion to compel is not timely or does not meet the minimal requirements for such a motion. Further, if the mere filing of a motion to compel resulted in an automatic suspension of proceedings, **parties might be encouraged thereby to file such a motion merely as a strategic move to gain time and/or delay proceedings.**

The PTO believes that the better practice is for the Board to retain control over the running of the suspension period.

See Notice of Final Rulemaking published in the *Federal Register* on September 9, 1998 at 63 FR 48081 and in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145 (emphasis supplied).

The Trademark Rules are also quite clear on the consequences of failing to timely file a motion to compel:

If a party which served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof.

See TBMP §523.04. Opposer failed to file a motion to compel on or before January 14, 2002 *i.e.* before Opposer's testimony, as originally set, commenced. Applicant's timely Motion to Compel did not serve to extend that deadline which Opposer missed. Thus, Opposer "may not thereafter be heard to complain about the sufficiency" of Applicant's discovery responses. Rather, Opposer should be required to get on with trial. The present motion to compel is untimely.

IV. Equity Demands Denial of the Motion to Compel

Not only do the Rules clearly prohibit the present Motion, equity would not contemplate it. Ironically, Opposer's (misguided) argument for the timeliness of its Motion centers on an event which arose from Opposer's own determined refusal to comply with the Board's rules, namely, Applicant's filing of a Motion to compel on January 14, 2002 (which the Board granted *as conceded*). But for this filing *by Applicant* – required by Opposer's recalcitrance – Opposer would not even be in a position to *assert* it is entitled to file the present Motion. It is axiomatic that equity

abhors allowing a party to obtain through its own misconduct a benefit to which it would not have otherwise been entitled.

V. Opposer's Motion Was Not Filed in a Reasonable Time Frame

Not only is Opposer's Motion untimely under the Trademark Rules, but even if considered technically timely (and equitably considered), it certainly was not filed within a reasonable time frame. The Trademark Rules state that a Motion to compel "should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate." *See* TBMP §523.03. It is obvious that waiting over fifteen months after service of discovery responses which explicitly (and properly) object to production at the offices of Opposer's prior counsel, in Los Angeles, California, is not reasonable.¹³

In this regard, Applicant refers to the Board's January 17, 2002 Order. The Board expressly stated that the Order did not suspend or place on hold any other discovery obligations or issues: "This suspension order does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel, nor does it toll the time for a party to appear for a deposition which had been duly noticed prior the filing of the motion to compel." (emphasis in original). Hence, Opposer clearly was placed on notice that any discovery issues other than those which were the subject of Applicant's timely filed Motion to Compel must be pursued without delay.

Opposer argues that: "it cannot determine if follow-up discovery or depositions are necessary" until it views Applicant's document production. Opposer's Motion to compel, p. 6. This

¹³ Applicant is located in Memphis, Tennessee.

very assertion demonstrates why Opposer's inordinate delay in filing the present Motion is patently unreasonable.

Now more than fifteen months after Applicant's discovery responses timely were served, and after two additional discovery periods totalling more than six (6) months, Opposer wants yet another discovery period and delay of trial. Such a further delay is highly prejudicial to Applicant and is wholly unwarranted, since the delay thus far has been the result solely of Opposer's refusal to respond to Applicant's discovery absent a Board Order compelling same.

Further, placed in context, the unreasonableness of Opposer's delay is even more apparent. Opposer's present Motion concerns only Applicant's *proper* objection to production of documents in Los Angeles, pursuant to express regulatory authority which Opposer chose to ignore in making its improper production demand. Applicant having undertaken the necessary preparation to respond to Opposer's request for documents fifteen months ago should not have to repeat this process because Opposer finally (and nearly one year later) determined to pursue and correct its defective production request.

In sum, it simply cannot be that a party can rely on its own determined failure to comply with the Trademark Rules to re-open and extend – by over one year – its ability to file a Motion to compel on a matter that it failed to prosecute. Such a delay is unreasonable, and dictates denial of the present motion to compel. *See, e.g., Brandt v. Vulcan, Inc.*, 30 F.3d 752, 756 (7th Cir. 1994) (unreasonable delay may render motion for sanctions untimely), and *Butler v. Pettigrew*, 409 F.2d 1205, 1207 (7th Cir. 1969) (plaintiffs, “by their own inaction waived the[ir] rights” when they failed to request court, prior to trial, to require defendants to fully answer interrogatories or sanction defendants). *See also, Bullard v. Universal Millwork Corp.* 26 F.R.D. 144 (E.D.N.Y. 1960) (no just basis for granting

plaintiff's request to strike defendant's answer for failure of defendant's president to appear for deposition when plaintiff waited almost one year from return date of notice of deposition before seeking relief), *Dynamic Movers, Inc. v. Paul Arpin Van Lines, Inc.*, 956 F. Supp. 836, 839-40 (E.D. Wis. 1997) (four and one-half months after allegedly insufficient responses served, and only weeks before trial, motion to compel filed; denied because "time has passed for discovery motions"); *American Motorists Insurance Company v. General Host Corporation*, 162 F.R.D. 646, 648 (D.Kan. 1995) (defendant provided no excuse for waiting two years after the deadline for discovery to compel information sought long before discovery deadline); and *Anco Engineering Co. v. Bud Radio, Inc.*, 8 Fed. R. Serv. 2d (Callaghan) 37A (D.Ohio 1963) (motion denied because of nine-month delay after interrogatories answered and before inquiring party sought to compel better answers).¹⁴

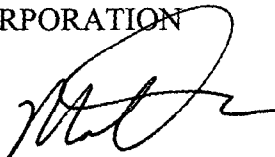
Applicant timely responded to Opposer's request for production, asserting an objection fully grounded in express regulatory language. Applicant has complied with the deadlines in this case. Opposer decidedly, and repeatedly, has not. It is time to proceed with trial, and for Applicant, finally, to obtain a resolution of its (long) pending application. Accordingly, and for all of

¹⁴ The citation of authority are quoted directly from a Board Order in Opposition No. 78, 343.

the foregoing reasons, Applicant respectfully submits that the Motion to compel should be DENIED.

Respectfully submitted,

TBC CORPORATION



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February 5, 2003

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I have caused a true and correct copy of the foregoing Applicant's Brief in Opposition to Opposer's Motion to Compel to be served by first-class mail, postage prepaid, upon counsel for Opposer:

Anthony L. Fletcher, Esquire
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this 5th day of February, 2003.

