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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,

Opposition No. 121,151

v.

TBC Corporation,

Applicant.



02-28-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #7:

**REQUEST FOR LEAVE TO FILE A REPLY TO APPLICANT'S BRIEF IN  
OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT TO PRODUCE  
DOCUMENTS RESPONSIVE TO OPPOSER'S DISCOVERY REQUESTS**

Opposer, American Honda Motor Co., Inc., ("Honda" or "Opposer"), requests leave to submit the following reply to Applicant's Brief in Opposition to Opposer's Motion to Compel ("Opp. Brief"). Opposer believes this response will assist the Board in arriving at a just conclusion on the motion. Cf. TBMP § 502.03.

**SUMMARY OF REPLY**

Honda through its counsel, moved for an Order pursuant to TBMP § 523 compelling Applicant, TBC Corporation ("TBC" or "Applicant"), to produce or make available for inspection documents that it agreed to produce in its Response to Opposer's First Request for

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

February 25, 2003

Date of Deposit

Signature

Irene Hudson

Typed or Printed Name of Person Signing Certificate

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Production of Documents. Instead of citing authority for its remarkable argument that a party's promise to produce or make available documents can be wholly ignored absent a motion to compel, TBC makes yet another attempt to bury the issue presently before the Board by resorting to name calling and drudging up of moot and irrelevant issues.

## **REPLY**

### ***I. The Issue of Delay***

TBC's allegations that Honda has had "sporadic interest in production of Applicant's documents" and that Honda has engaged in intentional delay of these proceedings are wholly unfounded. As is shown by the Declaration of Stacy J. Grossman filed in support of Honda's Motion to Compel, a copy of which is annexed hereto as Exhibit A, Honda's interest in obtaining the promised document production has been constant and continuing since before TBC's counsel's announcement that it did not have to make such production.

The delay, if there will be any, will be occasioned by TBC's obstinance. Honda is prepared to take testimony within the testimony period, but it is not prepared to defend against TBC's testimony without the discovery earlier promised by TBC.

Honda concedes that TBC's counsel has a talent for turning a nasty phrase. Unfortunately, their ability to predict Honda's intent going forward is on par with their propensity to honor their commitments.

### ***II. TBC's Objection to Demand for Production***

On October 9, 2001, TBC responded to requests for production of documents by agreeing to produce certain documents. Honda does not challenge TBC's objections to other requests, and, under the circumstances, is willing to accept the production in Memphis, Tennessee, where

the documents are kept, if the Board so directs.<sup>1</sup> What Honda does find issue with is TBC's recent assertion that it does not have to make the documents available anywhere, at any time, under any circumstances.

### ***III. Timeliness of Motion to Compel***

TBC's position is that Honda should have made a motion to compel by January 14, 2002, notwithstanding the facts that (i) TBC's written discovery response and its representation to Honda's counsel led Honda to believe that the parties would agree upon a mutually convenient date for such inspection to occur; and (ii) whatever significance January 14, 2002 may once have had, the Board had subsequently re-set the commencement of the discovery and first testimony periods.

TBMP § 523.03 (citing *Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974)) states that "[a] motion to compel does not necessarily have to be filed during the discovery period." The rules simply require that "the motion should be filed within a reasonable time after . . . service of the response believed to be inadequate." Filing a motion to compel after the close of discovery is permissible, and deemed timely, as long as the request for production of documents is served before the close of discovery since the motion to compel "relates back to the earlier timely request." *Johnson*, 183 USPQ at 617.

What TBC fails to recognize is that Honda does not and cannot deem the responses themselves to be inadequate since the responses effectively state that documents will be made available for inspection and Honda is yet to see a single allegedly responsive document. Honda's motion to compel must be deemed to be timely since TBC did not make clear its refusal

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<sup>1</sup> The Board, it will be recalled, required Honda to produce 18,000 documents by delivering them to TBC's counsel.

to make its documents available for inspection until November 12, 2002,<sup>2</sup> and more forcefully on February 5, 2003.<sup>3</sup>

**IV. TBC's Equity Argument**

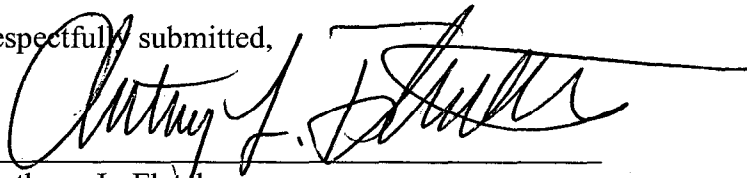
As the Board clearly set out in its December 13, 2002 Order relating to TBC's motion for reconsideration of the Board's reopening of discovery, the discovery period had been reopened in the Board's discretion after TBC's motion to compel and then reset after TBC's motion for sanctions. Discovery closed on December 15, 2002. Any discussion of the events leading to such resetting is now moot and lends very little to a timely resolution of the pending issue before the Board.

**V. Reasonable Timeliness of Motion of Compel**

Honda's motion to compel must be deemed to be timely since TBC did not make clear its refusal to make its documents available for inspection until November 12, 2002, and more forcefully on February 5, 2003.

Dated: New York, NY  
February 25, 2003

Respectfully submitted,



Anthony L. Fletcher  
Stacy J. Grossman  
FISH & RICHARDSON P.C.  
45 Rockefeller Plaza, Suite 2800  
New York, New York 10111  
Telephone: (212) 765-5070  
Facsimile: (212) 258-2291

Attorneys for Opposer,  
AMERICAN HONDA MOTOR CO., INC.

<sup>2</sup> In a brief filed in connection with its Request for Reconsideration of the Reopening of Discovery, ("TBC's Reconsideration Reply Brief"), TBC for the first time expressed its view that January 14, 2002 was Honda's deadline for the filing of a motion to compel. See TBC's Reconsideration Reply Brief, pp. 2-4.

<sup>3</sup> See Opp. Brief, p. 5.

**CERTIFICATE OF SERVICE**

I hereby certify that I have caused a true and correct copy of the foregoing REQUEST FOR LEAVE TO FILE A REPLY TO APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT TO PRODUCE to be served by first-class mail, postage prepaid, upon counsel for Applicant:

Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004

this 25th day of February 2003.



Irene Hudson



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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American Honda Motor Co., Inc.,

Opposer,

v.

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Applicant.

Opposition No. 121,151



02-28-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

**DECLARATION OF STACY GROSSMAN**

Stacy Grossman, hereby declares that the following is true and correct to the best of my knowledge, information and belief.

1. I am an associate of Fish & Richardson P.C., counsel for Opposer, American Honda Motor Co., Inc. ("Honda").
2. I make this Declaration in support of Honda's Motion to Compel Applicant to Produce Documents Responsive to Opposer's Discovery Requests.
3. Specifically, I want to bring to the Board's attention certain information regarding Honda's efforts to obtain the sought-after discovery, and a summary of the documents that were not produced for inspection and copying.
4. Honda has sought to proceed with discovery and attempted to procure the inspection and/or copying of TBC's documents since at least as early as May 2002.

5. On May 14, 2002, I wrote to TBC's counsel and asked whether TBC was "interested in proceeding with discovery before the Board ruled on [TBC's] motion." TBC never responded to my inquiry. A copy of my letter is annexed hereto as Exhibit A.

6. On September 24, 2002, I again wrote to TBC's counsel, and I inquired about their failure to produce any documents. A copy of this letter is annexed hereto as Exhibit B.

7. On October 4, 2002, I spoke with TBC's counsel. To the best of my recollection, I spoke with Matthew Cuccias, an attorney at Jacobson Holman, PLLC about my September 24<sup>th</sup> letter. Mr. Cuccias referred to TBC's objection to production of documents at a place other than where the documents are normally kept, and advised me that he would let me know when and where TBC's production would be available to Honda.

8. I did not hear back from Mr. Cuccias. On November 12, 2002, when TBC filed its Brief in Reply to Opposer's Response to Applicant's Request for Reconsideration of the Reopening of Discovery and Opposer's Request for Telephone Conference, I learned for the first time that TBC's position was that it was not required to produce documents at all.

9. Below is a summary of Honda's document requests:<sup>1</sup>

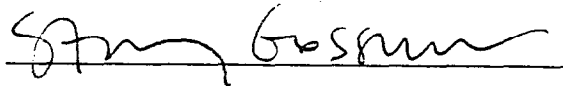
- The person(s) who conceived or created TBC's trademark;
- The origination, creation and invention of TBC's trademark;
- TBC's initial decision to manufacture, sell and/or license products using TBC's trademark;
- The names, addresses, or telephone numbers of TBC's sales representatives, manufacturers, suppliers, dealers or distributors;
- Government or customer complaints about TBC's products and/or services;

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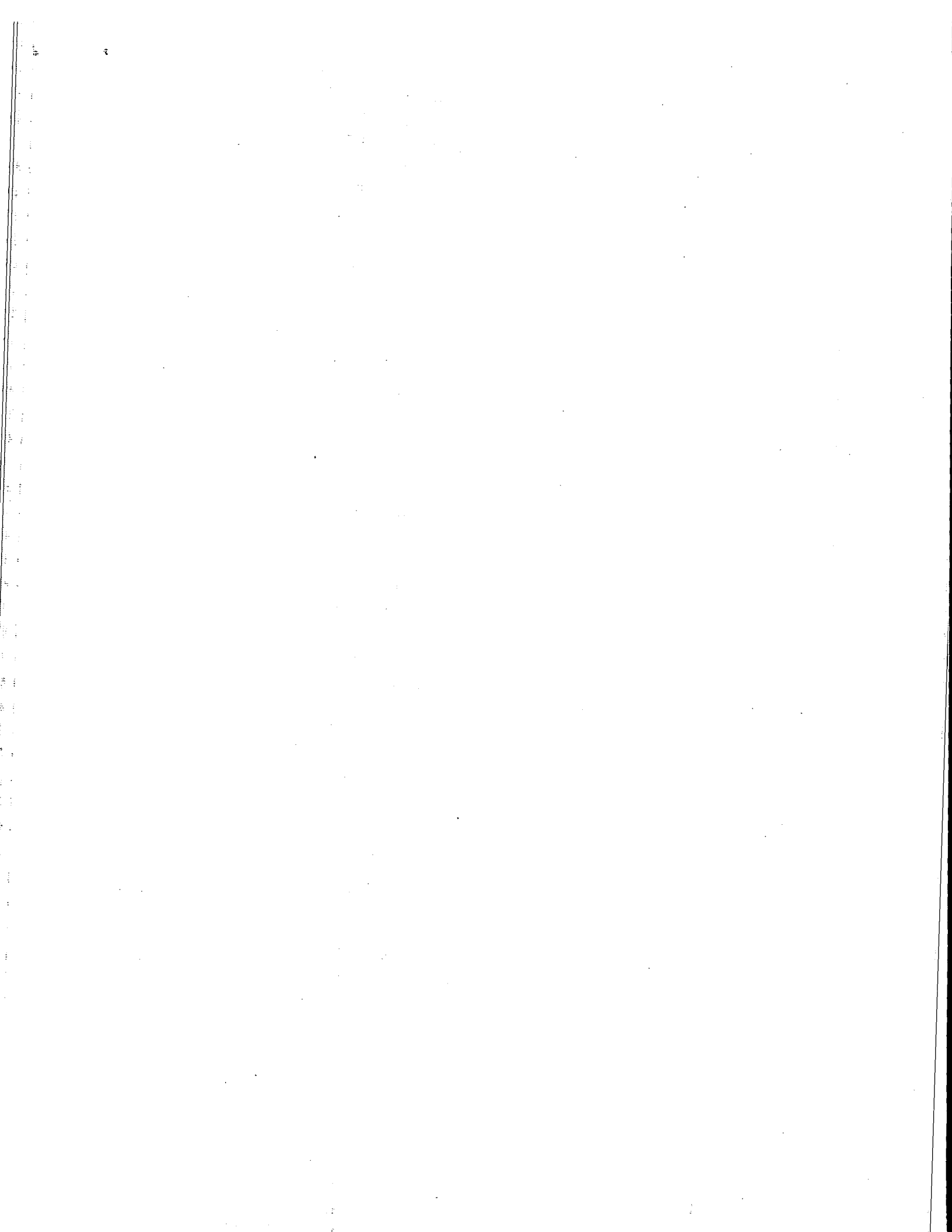
<sup>1</sup> Honda's discovery requests are submitted as Exhibit A to Honda's Motion to Compel filed contemporaneously herewith.



- Product endorsements and licensing agreements;
- Market analysis and projected sales;
- Agreements for the manufacture and supply of products using TBC's trademark;
- Application to register TBC's trademark;
- Investigations, searches and surveys relating to the use, application, or availability of TBC's trademark;
- TBC's assertions against third parties regarding its trademark;
- Samples of different usages of TBC's trademark;
- TBC's advertising and promotion of its products;
- Honda's products and/or services; and
- Communications with Honda or its employees.

A handwritten signature in cursive script, appearing to read "Stacy Grossman", written over a horizontal line.

Stacy Grossman



# FISH RICHARDSON P.C.

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May 14, 2002

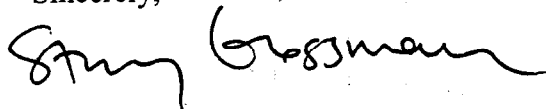
Marsha G. Gentner, Esq.  
Matthew J. Cuccinas  
JACOBSON HOLMAN PLLC  
400 Seventh Street, NW  
Washington, DC 20004

Dear Marsha and Matthew:

As promised in our opposition to your motion for a judgment, enclosed please find a proposed protective order and confidentiality agreement, together with a copy of the verification to the Interrogatories, signed by William Herten of American Honda Motor Co., Inc. on May 3, 2002.

I apologize that we've gotten off to a rocky start and hope that we are able to proceed amicably. To that end, if you are interested in proceeding with discovery before the Board rules on your motion, please give either me or Tony Fletcher a call. We'd be happy to talk through some of the issues raised in your motion (and our opposition), execute the protective order, and move things along.

Sincerely,



Stacy J. Grossman

Enclosures

cc: Laura K. Cuddy, Esq., Honda North America

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BOSTON

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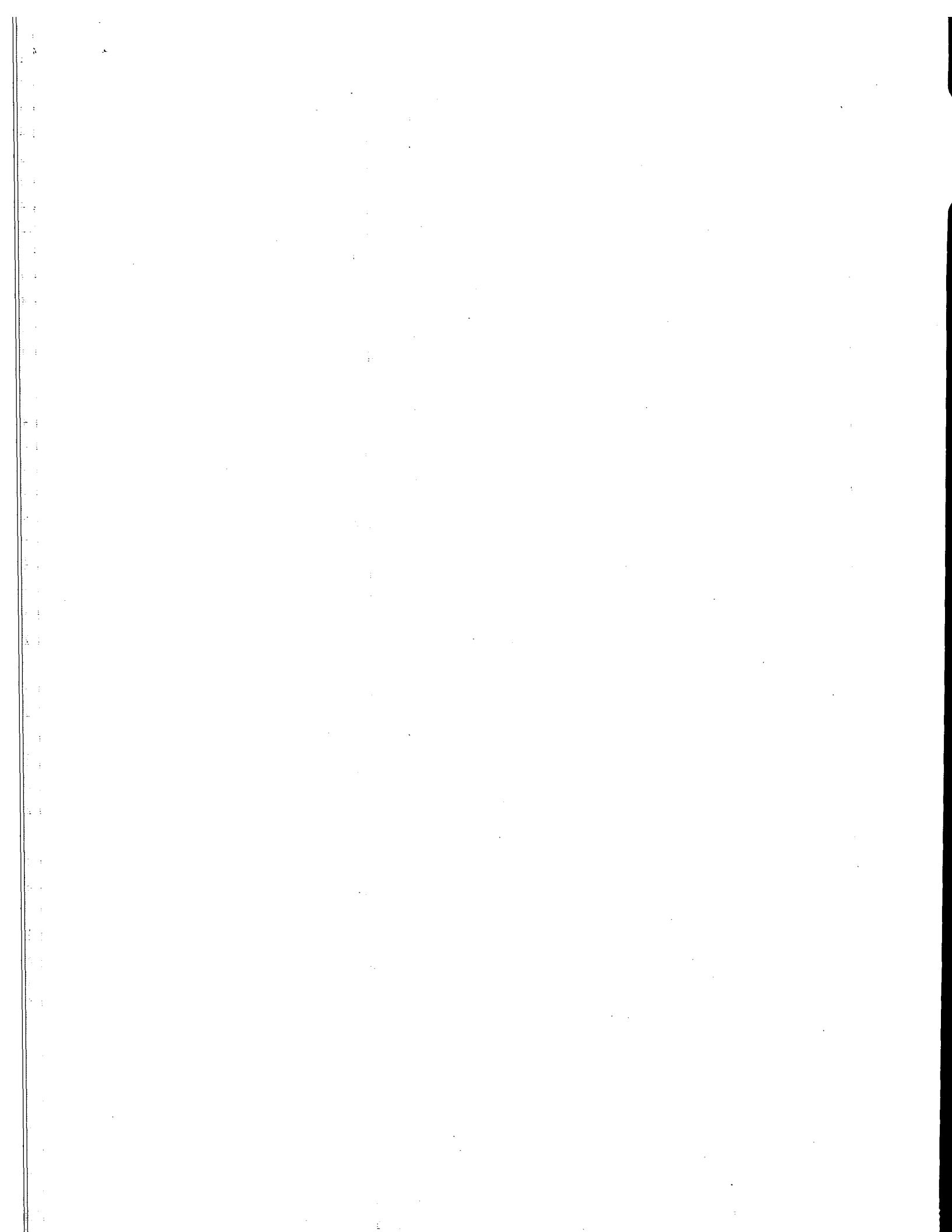
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**BY FACSIMILE**

September 24, 2002

Marsha G. Gentner, Esq.  
Matthew J. Cuccinas, Esq.  
Jacoson Holman PLLC  
400 Seventh Street, NW  
Washington, DC 20004

Re: American Honda Motor Co. v. TBC  
Our Ref: 10691-054PP1



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NEW YORK

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TWIN CITIES

WASHINGTON, DC

Dear Marsha and Matthew:

We assume that you received a copy of the TTAB's order which, among other things, requires us to serve our document production on you on October 4, 2002 and resets the discovery, testimony and trial dates in this action.

In May of this year, we sent you a proposed protective order and confidentiality agreement. We have not heard from you since then, and wonder if you have had an opportunity to review that document. There are a number of documents that we intend to mark confidential, and if there is not a signed order by October 4th, we intend to withhold those documents from our production.

On a separate but related note, we would like to remind you that you did not make a document production when you served TBC's written responses to our discovery demands. We ask that you serve those documents on us, or otherwise make them available in accordance with the TBMP and Federal Rules.

Sincerely,

Stacy J. Grossman

cc: Laura K. Cuddy, Esq., Honda North America