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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.)

11-04-2003

U.S. Patent & TMOic/TM Mail Rpt Dt. #22

Opposition No. 121,151

**RESPONSE TO OPPOSER'S MOTION TO SUSPEND PROCEEDINGS
AND MOTION TO EXTEND OPPOSER'S TESTIMONY PERIOD**

Applicant TBC Corporation ("TBC") hereby submits the following Response to Opposer's Motion to suspend proceedings pending a ruling on Opposer's Motion to Test the Sufficiency of Applicant's Responses to Opposer's Requests to Admit (hereafter, "Opposer's Motion to Test"), or, alternatively, for an additional thirty (30) day testimony period following the Board's ruling on the Motion to Test. For the reasons set forth below, Applicant does not oppose a suspension as of the point in the proceedings when Opposer's Motion for same was filed – i.e., the 29th day of Opposer's testimony period; Applicant emphatically opposes the extension Opposer seeks or any grant to Opposer of an additional thirty day testimony period.

The sole basis given for the extension sought by Opposer American Honda Motor Co., Inc. ("Honda") is the pendency of Opposer's Motion to Test. As set forth in TBC's Response in opposition to Opposer's Motion to Test, however, that Motion was not timely filed. Pursuant to 37 C.F.R. §2.120(h), any motion by Honda to test the sufficiency of responses to requests for admission was required to be filed on or before **September 15, 2003** – i.e. "prior to the

commencement of the first testimony period, as set originally or reset” in this opposition.¹ By the Board’s Order of May 2, 2003, Honda’s testimony period was reset to commence September 16, 2003 (and to end October 16, 2003). Yet, Honda’s Motion to Test was not filed until September 26, 2003, well after the deadline for same. Patently, therefore, Honda’s Motion to Test should be given no consideration; it should have no effect. Certainly, Opposer’s Motion to Test having been filed well after the deadline for same, it should not operate to extend to Opposer a whole new thirty day testimony period, and further delay these proceedings.

The denial of Opposer’s Motion for extension will work no hardship on Honda, or at least no unfair or inequitable hardship. Honda already has had one complete thirty day testimony period (from February 13 through March 15, 2003). During that first period, Honda took, and subsequently submitted, the testimony of a representative of Opposer, and filed a Notice of reliance with exhibits. Honda was given yet another thirty day testimony period (and an extended discovery period) to follow up on documents produced by TBC. Yet, Honda allowed this *second*, full testimony period to pass without *any effort* whatsoever to take any testimony or submit any Notice of reliance. Honda’s present Motion to suspend and for extension was filed on **October 15, 2003, one day** before the close of its second, thirty-day testimony period. More importantly, Honda’s Motion to Test was not simply untimely – it was filed eleven days **after** Honda’s testimony period had commenced, well

¹ Further, Honda’s Motion for extension was not filed until **October 15, 2003**, one month after the deadline for filing a motion to test the sufficiency of requests for admission. Therefore, as of the September 15, 2003 deadline for a motion to test the sufficiency of responses to requests for admissions, Honda had no reasonable basis for believing that deadline was not operative.

into this second, full testimony period. *See also* Applicant's Response in Opposition to Opposer's Motion to Test the Sufficiency of Applicant's Responses to Opposer's Requests to Admit, pp.1-2.

The failure to meet a deadline should not work an advantage on a party, conferring upon it additional testimony days beyond those it would have had if the motion timely was filed. Indeed, had Honda waited until the last day of its (second) testimony period to file its untimely Motion to Test, would that have entitled Opposer to yet another full thirty day testimony period? And assuming the answer is "no," why should the fact that the Motion to Test was filed about midway in Honda's (second) testimony period demand any different result? Again, it bears repeating that trial in this matter long ago would have concluded but for Honda's un-excused failure to respond to TBC's discovery; this necessitated *TBC's* motion to compel, which, in turn, resulted in the Board, *sua sponte*, reopening discovery, for *both* Honda and TBC, instead of only the successful movant, TBC.² *Id.*, p.2 n.2.

In short, there is no good cause for giving Opposer yet another full thirty day testimony period. The sole basis for *any* extension is a motion which was grossly, and inexcusably, out of time. Moreover, Opposer has had more than sufficient time (sixty days) and opportunity to present its trial evidence. Accordingly, the Motion for extension should be denied; certainly, granting Opposer a full, additional thirty day period is completely unwarranted. TBC submits that, instead, upon the

² By contrast, the Board's May 2, 2003 Order re-opened discovery only for Honda.

Board's ruling on Honda's untimely Motion to Test, the testimony dates herein should be reset, commencing with the 29th day of Opposer's testimony period.

Respectfully submitted,

TBC CORPORATION

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Date: November 4, 2003

ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that on the 4th day of November, 2003, the foregoing Response in Opposition to Opposer's Motion for Extension of Opposer's Testimony Period was served on Opposer by mailing same, first class and postage pre-paid, to the following counsel:

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