

TTAB



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

THE PEP BOYS MANNY, MOE & JACK)
OF CALIFORNIA,)
)
Opposer,)
)
v.)
)
JET-PEP, INC.,)
)
Applicant.)



03-29-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

Opposition No. 150,819

**OPPOSER'S BRIEF IN REPLY TO
APPLICANT'S MEMORANDUM OF LAW IN OPPOSITION TO
OPPOSER'S MOTION FOR EXTENSION OF
DISCOVERY PERIOD FOR OPPOSER ALONE
AND FOR ALL OUTSTANDING TRIAL DATES**

The purpose of "follow up" discovery is, as the name suggests, to follow up on previously served discovery, to which complete responses were properly made. However, Applicant's deficient responses and failure to address (or even acknowledge) Opposer's efforts to obtain documents and complete discovery responses have defeated that purpose. Applicant should not be allowed to so curtail Opposer's ability to engage in discovery and prepare for trial.

Applicant has delayed responding to Opposer's written discovery for over one (1) year on the basis of Applicant's promise to engage in settlement discussions (by, at least, responding to the offer it invited). Moreover, as discussed more fully below, Applicant's responses were untimely – as measured not just against the Board's Order but by the earlier deadlines established by the parties themselves. A brief review of Opposer's efforts to obtain a response to its settlement proposal and/or responses to its written discovery follows:

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- On September 9, 2002, Opposer served written discovery on Applicant, namely, interrogatories, document requests and request for admissions. Responses were due on October 14, 2002.
- One week prior to the deadline for responding to the discovery, Applicant's counsel called Opposer's counsel claiming an interest in discussing an amicable resolution to the proceeding.
- On October 10, 2002, Opposer's counsel verbally conveyed the core terms of a proposed settlement to Applicant's counsel. Additionally, the parties agreed to extend the deadline for Applicant to respond to Opposer's written discovery and the discovery/trial dates by three (3) months. See October 11, 2002 letter of James M. Pacious ("Counsel Pacious"), attached hereto as Exhibit A. Accordingly, Applicant's responses to Opposer's written discovery were due on January 14, 2003.
- On October 11, Counsel Pacious promised to speak with his client about the proposal and "get back to [Opposer's counsel] as quickly as possible." *Id.*
- However, over two weeks later, Applicant still failed to file the extension request with the Board or respond to the proposal. On October 24, 2002, Opposer's counsel's assistant called Counsel Pacious to inquire about same. The Stipulation was not filed until October 31, 2002.
- On October 24, 2002, Applicant's counsel claimed to have had a conversation with his client regarding Opposer's settlement proposal and they planned to further discuss

it early the following week. See October 24 facsimile cover sheet from Counsel Pacious, attached hereto as Exhibit B.

- However, three months came and went without any further word from Applicant's counsel regarding settlement or service of Applicant's discovery responses. On January 23, 2003 – *nearly ten (10) days after the discovery responses were due* – Opposer's counsel left a voice mail message with Applicant's counsel indicating that the responses were overdue and that Applicant had not served discovery responses or responded to Opposer's settlement proposal. Applicant called back that same day and advised that his client was experiencing corporate changes but was interested in settling along lines proposed by Opposer. Based on this representation, counsel agreed to a two (2) month extension.
- On January 21, 2003, Applicant filed an extension request, which “was agreed to in an effort to settle the opposition to the ‘JET PEP’ mark.”
- By March 3, 2003, Applicant having still failed to respond to the discovery or to Opposer's settlement proposal, Opposer's counsel called and left another voicemail message for Applicant's counsel reiterating the offer. Additionally, Opposer's counsel suggested that the matter either be suspended or Applicant serve its (overdue) discovery responses.
- Ten days later, on March 13, 2003, Applicant's counsel forwarded a prepared Request for Suspension to Opposer's counsel, who signed it that day. The Request states “The Suspension was agreed to in an effort to settle the opposition to the “JET

PEP” mark.” However, no word on settlement was forthcoming from Applicant’s counsel.

- On April 9, 2003, the Board issued an Order suspending further proceedings on the basis of settlement negotiations. However, the six month suspension period expired without any word from Applicant’s counsel on settlement.
- By the time that the Board issued its November 18, 2003 Order resuming the opposition proceeding, Applicant still failed to formally respond to Opposer’s October 10, 2002 settlement proposal.
- Finally, on November 21, 2003, Applicant’s counsel advised Opposer’s counsel that Applicant had determined, simply, to withdraw the opposed application instead of pursuing settlement under consideration by Applicant for over a year. Despite this, Applicant’s counsel demanded Opposer’s consent to the withdrawal (actually, he said he “assumed” Opposer would consent). Opposer declined.
- Later that same day, Applicant’s counsel advised that Applicant would not pursue settlement. *See* November 21, 2003 letter from Marsha G. Gentner (Counsel Gentner), attached hereto as Exhibit C. Counsel Gentner demanded service of Applicant’s “(long) outstanding responses.” *Id.*
- Applicant’s counsel belatedly served discovery responses on Friday, December 19, 2003.
- On February 18, 2003, Opposer’s counsel sent by facsimile and regular mail a letter setting forth numerous deficiencies in Applicant’s responses and requesting either

production of documents by mail or the location where such documents are normally kept. No response has been received from Applicant's counsel.

Applicant delayed responding to Opposer's settlement proposal (which Applicant invited) and Opposer's written discovery by over one year. To date, Applicant has not responded to Opposer's correspondence requesting complete discovery responses and either production of Applicant's documents or agreeing to arrange for their inspection.

Had Applicant served complete responses when the deadline – as extended by consent of the parties on the basis of Applicant's apparent interest in settlement– *expired* on January 14, 2002, then Opposer would have had nearly one (1) year to evaluate the responses, try to obtain access to Applicant's documents and discuss the discovery deficiencies with Applicant, as well as three (3) months in which to engage in follow up discovery.

Indeed, Applicant's stonewalling continues unabated – not only have Applicant's responses been grossly inadequate but, to date, Applicant has not supplemented its responses as requested in Opposer's correspondence, nor even extended the courtesy of responding to such efforts. By failing to product documents or arrange for inspection of said documents at Opposer's request, by failing to remedy the inadequacies in its discovery responses and by failing to address the issues raised in Opposer's correspondence (or to even acknowledge same), Applicant is impeding Opposer's ability to engage in follow up discovery in this extended period and to prepare for trial.

For the foregoing reasons and for those raised in Opposer's Motion, Opposer respectfully requests the Board to grant the present Motion and extend the discovery period for Opposer alone by forty-five (45) days and to extend all outstanding trial dates by forty-five (45) days.

Respectfully submitted,

THE PEP BOYS MANNY, MOE & JACK OF
CALIFORNIA

By: Marsha G. Gentner
Marsha G. Gentner
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
(202)638-6666
Attorneys for Opposer

Dated: March 29, 2004
Attorney Docket No. I-4565

CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of March, 2004, a true copy of the Opposer's Brief in Reply to Applicant's Memorandum of Law in Opposition to Opposer's Motion for Extension of Discovery Period for Opposer Alone and for All Outstanding Trial Dates was served by first-class mail, postage prepaid, upon counsel for Applicant:

James M. Pacious
Collier Shannon Scott, PLLC
3050 K Street, N.W.
Washington, DC 20007

Sheryl S. Harris

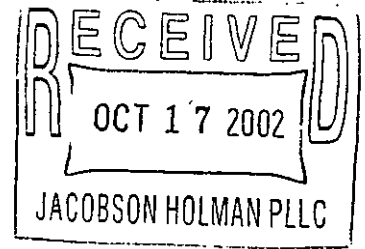
Q 10-22-02
TC 10-23-02

MGG

I 4565

Collier Shannon Scott, PLLC
Washington Harbour, Suite 400
3050 K Street, NW
Washington, DC 20007
202.342.8400 TEL
202.342.8451 FAX

Collier Shannon Scott



(202) 342-8497

October 11, 2002

VIA FIRST-CLASS MAIL

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

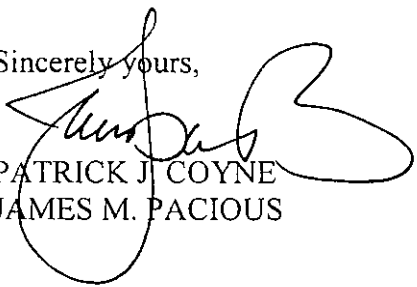
Re: Opposition to Serial No.: 76/158,291; Our Reference No.: 42110-00601

Dear Ms. Gentner:

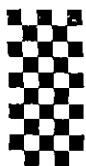
I am writing regarding our conversation of yesterday, October 10, during which we discussed the possibility of settling the pending opposition to the "JET PEP" mark. During that conversation, you agreed to a three-month extension for responses to Pep Boy's discovery requests upon our agreement to extend all discovery dates for the same amount, pursuant to 37 C.F.R. § 2.120. Consistent with 37 C.F.R. § 2.120, I will prepare a stipulation for submission to the board for its approval. Therefore, we will refrain from submitting answers to your discovery requests for the time being.

As I mentioned, I will speak to my client regarding settlement and get back to you as quickly as possible. In the meantime, if you have any questions or concerns, please do not hesitate to contact our offices.

Sincerely yours,


PATRICK J. COYNE
JAMES M. PACIOUS

Enclosures



MGG

3050 K Street, NW
Washington, DC 20007-5108
202.342.8400 TEL
202.342.8451 FAX

Collier Shannon Scott

Sending Secretary: g.tyler

Secretary's Phone Number: 202.945.6646

TO:	COMPANY:	FAX NO.	CONFIRMATION NO.
<u>Marsha Gentner</u>	<u>Jacobson Holman, PLLC</u>	<u>202.393.5350</u>	<u>202.638.6666</u>

OCT 24 PM4:40

FROM: James M. Pacious **Direct Dial No.:** 202.342.8497

DATE: October 24, 2002

CLIENT: 42110-00601

MESSAGE: Please execute the attached Stipulation and return to me. Once I received the Stipulation, I will forward it to the TTAB with an attached Order adopting the Stipulation. I have spoken briefly with my client and we are scheduled to have another conversation early next week. If you have any questions, please do not hesitate to contact me.

NUMBER OF PAGES (INCLUDING THIS COVER PAGE):
PLEASE DELIVER IMMEDIATELY

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Law Offices
Jacobson Holman
Professional Limited Liability Company
400 Seventh Street, N.W.
Washington, D.C. 20004-2218

(202) 638-6666
(202) 393-5350/51/52 (fax)
www.jhip.com
Firm e-mail: ip@jhip.com

November 21, 2003

VIA FACSIMILE

(202) 342-8451

page 1 of 1

James M. Pacious, Esquire
Collier Shannon Scott, PLLC
Washington Harbour
Suite 400
3050 K Street, N.W.
Washington, D.C. 20007

RE: Opposition No. 150,819
Pep Boys v. Jet-Pep, Inc.
JET-PEP - Serial No. 76/158,291
Your Ref.: 42110-00601

Dear Mr. Pacious:

Further to our telephone conversation today, I now understand that nearly one year after you indicated your client's interest in the settlement proposed on behalf of Pep Boys, your client now has decided not to pursue settlement.

Therefore, your client's (long) outstanding responses to Opposer's First set of interrogatories, First request for production of documents, and Requests for admissions promptly should be served, but no later than Board resuming the proceedings in the referenced opposition).

Sincerely,

Marsha G. Gentner

MGG/tlb