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

Proceeding	91264021
Party	Plaintiff Volkswagen Aktiengesellschaft
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Attachments	919 547 OPPOSERS REDACTED MEMORANDUM IN OPPOSITION TO MO-TION FOR SUMM ARY JUDGMENT.pdf(352126 bytes) 919-547 EXHIBIT A.pdf(1166483 bytes) 919-547 EXHIBIT B.pdf(2431174 bytes)

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

VOLKSWAGEN AKTIENGESELLSCHAFT
Opposer,

Opposition No. 91264021
Application Ser. No. 88/780,498

v.

DMA HOLDINGS INC.
Applicant.

OPPOSER'S MEMORANDUM IN OPPOSITION TO MOTION FOR SUMMARY JUDGMENT

[REDACTED VERSION]

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PREAMBLE

Opposer, Volkswagen Aktiengesellschaft (VWAG), respectfully submits this Memorandum in Opposition to Applicant, DMA-Holdings Inc's, Motion for Summary Judgment. That Motion for Summary Judgment was erroneously captioned, perhaps in haste, as "Opposer's Motion for Summary Judgment."[1] Applicant's Motion for Summary Judgment was filed with the Board on February 12, 2021 in what Opposer believes was a thinly veiled attempt to delay if not outright thwart Applicant's need and inherent obligation to respond to Opposer's First Requests for Admission No(s) 1-50, Opposer's First Set of Interrogatories No (s) 1-20, and Opposer's First Request for the Production of Documents No(s) 1-24. Applicant's Responses to Opposer's Requests for Admission and Interrogatories were due on February 21, 2021 and the Responses to its Requests for Production of Documents were due on February 26, 2021.

Rather than respond to Opposer's discovery requests, Applicant provided its "Preliminary Objections" based on 37 C.F.R. Section 2.127(d) and the present practice that this rule immediately tolls the need to respond to outstanding discovery instantly upon filing, without need for a subsequent and independent suspension order by the Board. While Opposer respects the Board's Order of Suspension dated March 1, 2021 [10 TTABVUE] and appreciates its practice since *Super Bakery Inc. v. Benedict*, 96 USPQ 2d 1134, 1135 (TTAB 2010) *as clarified*, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011) to apply retroactively the actual suspension order to the date of filing, Opposer respectfully argues in good faith and invites the Board to perhaps revisit its interpretation of 37 C.F.R. Section 2.127(d) and the interpretation by the Federal Circuit. A fair reading of the rule strongly suggests that a separate order of suspension is first and specifically mandated by the rule, as initially interpreted and applied by the Board, before any tolling can take legal effect. A careful reading of the Federal Circuit's "clarification," suggests that the court's "clarification" was in reality limited to situations involving "sanctions," since the Federal Circuit explicitly noted that the "[the]… **ambiguity** [in the rule] does [did] not support the **extreme sanction** of

[1] It appears that its service was "Certified," not by email, but by First Class mail, in violation of the email service requirements mandated in 37 C.F.R. Section 2. 119(b), though Opposer did receive the Motion by email.

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default judgment." *Id* at 665 F.3d 1267, Here, we are not talking about a "sanction;" only that a hastily filed Motion for Summary Judgment should not be permitted to thwart or delay responses to discovery that is properly served **well before the filing of the motion for summary judgment.** Nor that such a motion should serve as a substitute for proper, not *preliminary,* legal objections, particularly in lieu of a party's responsibility to admit or deny requests for admission. For the purposes of this Memorandum in Opposition, Opposer, with all due respect, will rely upon Applicant's failure to either admit or deny Opposer's Requests for Admission in part and where applicable as evidentiary support. Opposer's relevant Requests for Admission are attached as Opp. Ex. A, and Applicant's preliminary objections as Opp. Ex. B.

As a final note, in view of the Board's recent February 5, 2021 decision in *The United States Olympic Committee v. Tempting Brands Netherlands B.V.,* __ USPQ2d ___ (TTAB 2021) [Opposition No. 91233138], Opposer respectfully withdraws its claim for a false suggestion of connection relative to Section 2(a) of the Trademark Act as specified in paragraphs 28-33 of its Notice of Opposition. [1 TTABVUE].

INTRODUCTION

Opposer, reported to be one of the largest automobile manufacturers in the world in terms of unit volume, commenced use of the ATLAS mark for its mid-line class of sport utility vehicles (SUVs) in May 2017 for the 2018 model year. [Opp. Ex. C ¶ 6]. In preparation for this vehicle launch, Opposer, in accordance with Section 66(a) of the Madrid Protocol, secured its International Registration No. 1308524 on April 28, 2016, based on a corresponding application in Germany with a **convention priority date of October 28, 2015**. Based on its Extension of Protection to the United States, Opposer secured U.S. Trademark Registration No. 5,202,310 for the mark ATLAS that matured to registration on May 16, 2017. This registration, as corrected on October 24, 2017, registered specifically for "automobiles; automobile engines in class 12;" "scale model automobiles in class 28;" and in abbreviated terms "repair and maintenance" services in class 37.

Since then, Opposer through its wholly owned U.S. subsidiary, Volkswagen Group of America, Inc. (VWGoA), has expanded the ATLAS program to include the ATLAS CROSS SPORT that was introduced in January 23, 2020 and is considering the future introduction of the ATLAS ALL SPORT.

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[Opp. Ex. C ¶¶ 14-15]. Opposer's Registration No. 6,069,893 covering ATLAS CROSS SPORT enjoys a constructive use date of November 15, 2017 and a first use date of October 1, 2018. Its application to register its ATLAS ALL SPORT, Serial No. 88/686,388, was filed on November 15, 2017 under Section 1(b) of the Trademark Act and is still pending.

By the end of 2020, Opposer's ATLAS line of SUVs now accounts for ███ of all Opposer's vehicle sales in the United States and has generated, based on extrapolation, approximately $ ██████ in gross revenues for VWGoA and its dealership network. [Opp. Ex. C ¶¶ 16 and 17]. Simply put, Opposer's launch of the ATLAS program has proven to be one of Opposer's more successful vehicle programs in recent years, and has garnered very positive reviews and publicity by both the trade and public at large. [Opp. Ex. C ¶ 16 and Ex. F ¶ ¶10-12; 14].

Inherent in Opposer's vehicle program, as with most, if not all vehicle manufacturers, is, as asserted in ¶ 5 of the Notice of Opposition, a vehicle manufacturer's natural zone of expansion for a vehicle line to include not only variations of the vehicle, such as the ATLAS CROSS SPORT and ATLAS ALL SPORT together with various trim levels, but also vehicle accessories and, most important, replacement parts. As a general matter, sale of accessories alone for Opposer's ATLAS vehicle has accounted for ███ of VWGoA's revenue from the sale of all accessories for the calendar year ending in 2020. [Opp. Ex. D ¶ 7].

In contrast, Applicant filed its application to register the mark ATLAS LIFT on January 31, 2020 -- well after Opposer's convention priority date of October 28, 2015 and with constructive notice of Opposer's prior registration, if not actual knowledge of Opposer's use.[2] Applicant claims a subsequent first use date of October 1, 2018. Applicant's mark is limited to "vehicle parts, namely lift supports."

Due to its generic nature, Applicant properly entered a disclaimer of the term "lift" apart from its mark as shown. Applicant in its Motion at 9 TTABVUE 3 arguably attempts to "deflect"

[2] As an after-market supplier of automotive replacement parts, it is fair to surmise that Applicant is well aware of new vehicle lines entering the market, and their respective specifications in order to produce replacement parts. Thus, there is every reason to believe that Applicant had actual knowledge of Opposer's prior use before it commenced use of the ATLAS LIFT mark, and before it filed its application.

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