

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: December 22, 2004

Opposition No. 91158237

World Confections Inc

v.

Kencraft, Inc.

Thomas W. Wellington
Interlocutory Attorney,
Trademark Trial and Appeal Board:

This case now comes up on opposer's motion (filed on July 19, 2004) for summary judgment; and applicant's motion (filed August 9, 2004) for leave to take limited discovery under Fed. R. Civ. P. 56(f), supported by a declaration, in accordance with 37 CFR § 2.20 and required by Fed. R. Civ. P. 56(f).

We turn first to the Rule 56(f) motion which has been briefed by the parties. In order to expedite our decision on the motion, the Board presumes familiarity with the issues presented and does not provide a complete recitation of the allegations and contentions of each party.

Generally, a motion for discovery under Rule 56(f), unless dilatory or lacking in merit, will be treated liberally by the Board. See James W. Moore, Moore's Federal

Procedure, § 56.24 (1985). If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion, discovery will be permitted. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). This is especially true if the information sought is largely within the control of the party moving for summary judgment. See *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989).

However, when a request for discovery under FRCP 56(f) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, requests for discovery outstanding, and those requests remain unanswered. See T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990). Cf. *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D. Ohio 1992).

While pursuant to Rule 56(f) the only discovery which may now be permitted is that specifically directed to the issues raised by the motion for summary judgment, we find that applicant has identified in the declaration of Todd Zenger, Esq. information essential to its opposition to

opposer's summary judgment motion. We also find that applicant has made a sufficient showing of need to obtain the discovery from opposer in regard to the matters raised in the motion for summary judgment.

Accordingly, applicant's motion for 56(f) discovery is hereby granted. Applicant is allowed **FORTY-FIVE (45) DAYS** from the mailing date of this order in which to notice and take the deposition of Mr. Matthew Cohen limited in scope to the subject areas specified in the declaration of Todd Zenger, Esq. (dated August 6, 2004 and submitted in support of applicant's Rule 56(f) motion).¹ Applicant may also use this time to review documents which opposer has agreed to make available for inspection in response to applicant's previously served discovery requests.

Applicant is allowed until **SEVENTY (70) DAYS** from the mailing date on this order to file a response to opposer's motion for summary judgment.

Except to the extent indicated above, proceedings remain **SUSPENDED**. See Trademark Rule 2.127.

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¹ The Board expects both parties to make all reasonable efforts to facilitate the taking of the deposition during the allowed time period. Should the parties not be able to reach a mutually agreeable date for the deposition during this time, either party may move to extend this time period after first attempting to obtain the other party's consent for the extension and explaining all efforts that were made to facilitate the taking of the deposition.

