

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

Mailed: November 29, 2005

Opposition No. **91159871**

Mario Diaz

v.

Servicios de Franquicia
Pardo's S. A. C.

Peter Cataldo, Attorney:

On December 29, 2004, applicant filed a motion for summary judgment on the issues of priority and likelihood of confusion.¹ On January 28, 2005, opposer filed a motion for discovery under Fed. R. Civ. P. 56(f) in response thereto.² The motion is fully briefed.³

The Board has carefully reviewed the parties' arguments with regard to this motion. However, an exhaustive review

¹ In its notice of opposition, opposer asserts its standing as well as priority and likelihood of confusion as a ground for opposition to the registration of applicant's challenged mark.

² Opposer's motion for Rule 56(f) discovery thus is timely. See Trademark Rule 2.127(e)(1).

Further, in consequence of its timely filed Rule 56(f) motion, opposer's January 26, 2005 motion for extension of time in which to file its response in opposition to applicant's summary judgment motion is moot.

³ In addition, opposer submitted a reply brief which the Board has entertained. Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(e). Applicant's February 16, 2005 sur-reply was rejected in a Board order issued on February 17, 2005.

of the arguments made by each party would only delay this case.

Turning now to the merits of opposer's motion, it is well settled that a party which believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit or declaration showing that the nonmoving party cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion. See Fed. R. Civ. P. 56(f). See also *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

When a request for discovery under Fed. R. Civ. P. 56(f) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to respond to the motion for summary judgment. 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).

In support of its motion for summary judgment, applicant submits, *inter alia*, the affidavit of Mr. Arnold H. Wu, its director and general manager. Opposer now seeks to depose affiant pursuant to Rule 56(f). Turning to the ground for applicant's summary judgment motion, it is noted that the issues of priority and likelihood of confusion are mixed questions of law and fact, and opposer has demonstrated the need for discovery pertaining to the following factors which are pertinent to establishing or not establishing priority and likelihood of confusion; namely, the assertions contained in Mr. Wu's affidavit regarding applicant's bona fide intent to use its involved mark in commerce. The Board finds that opposer has adequately established by declaration that it cannot present its opposition to the motion for summary judgment without the requested discovery. The Board is also mindful of our reviewing court's concern with the "railroading" of nonmovants by premature summary judgment motions or the improper entry of summary judgment when the nonmoving party has not had an adequate opportunity to exercise pretrial discovery. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Therefore, the Board is persuaded that opposer has a legitimate need for discovery from Mr. Wu. Mr. Wu is an officer of applicant who has made significant sworn

statements relating to issues material to applicant's motion for summary judgment. If applicant wishes to rely upon Mr. Wu's affidavit as evidence in support of its position, equitable considerations require that opposer also be allowed the opportunity to obtain information from him.

Accordingly, opposer's motion for Rule 56(f) discovery is hereby **granted** to the extent that opposer may depose Mr. Wu with regard to applicant's bona fide intent to use its involved mark in commerce, which forms part of the subject matter of his affidavit.

With regard to the manner in which the deposition of Mr. Wu will be taken, Trademark Rule 2.120(c) provides as follows:

(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

The discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party may be taken on notice alone.

See Trademark Rules 2.120(c) and 2.124. *Compare* TBMP §703.01(g) (2d ed., rev. 2004). However, if the discovery deposition of such a person is taken in a foreign country, it must be taken on written questions, in the manner described in Trademark Rule 2.124, unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); Trademark Rule 2.120(c)(1); and TBMP §520 (2d ed., rev. 2004). See also *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989).

In this case, opposer asserts that an oral telephonic deposition will greatly speed the process of concluding its Rule 56(f) discovery and resolution of applicant's summary judgment motion. Further, opposer argues that applicant will not experience any financial hardship inasmuch as neither party will be required to travel in order to attend and opposer will pay for the required translator. In contrast, applicant points to no disadvantages aside from the asserted "awkwardness of a translator." However, any potential awkwardness posed by the necessity of translating opposer's questions on deposition will also be present to some extent even in the event the deposition is taken on written questions. On the balance of the equities in this case, the Board finds that due to the savings in time

afforded by a telephonic oral deposition and the absence of financial hardship or other measurable prejudice to applicant, opposer has made a sufficient showing of good cause for the Board to order Mr. Wu to attend a telephonic oral deposition.

In view thereof, opposer is allowed **sixty days** from the mailing date of this order in which to notice and take the oral telephonic Rule 56(f) deposition of Mr. Wu on the above referenced subject. The parties are ordered to apply their joint efforts to completion of the deposition process as expeditiously as possible. In the event that applicant fails to cooperate in this matter, then the Board may prohibit applicant from later relying upon Mr. Wu's affidavit.

Opposer is allowed until **thirty days** after the completion of Mr. Wu's deposition in which to file and serve its response to applicant's summary judgment motion. Proceedings herein otherwise remain suspended.

The Board will come to a determination with regard to applicant's summary judgment motion in due course upon the parties' completion of the foregoing.