

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

Mailed: August 16, 2006

Opposition No. 91163999

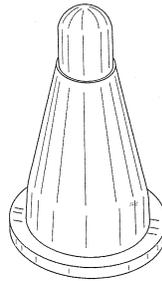
Sybaritic, Inc.

v.

Thomas P. Muchisky

**Thomas W. Wellington,  
Interlocutory Attorney:**

On August 4, 2003, Thomas P. Muchisky filed an application (Serial No. 78282661) to register the following configuration mark:<sup>1</sup>



The application contains the following description:

The mark consists of the configuration of an applicator for a hand-held massager. The applicator consists of a cone-shaped attachment having a firm rubber tip.

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<sup>1</sup> The application is based on alleged dates of first use anywhere on December 31, 1965 and first use in commerce on December 31, 1970.

Opposer filed its notice of opposition and, as amended, the complaint sets forth allegations that applicant's mark is *de jure* functional, has not acquired secondary meaning, and fails to function as a trademark.<sup>2</sup>

On December 16, 2005, applicant filed a motion for summary judgment under Fed. R. Civ. P. 56. By way of the motion, applicant moves the Board to "determine whether applicant's mark is not functional, has acquired distinctiveness and secondary meaning, and functions as a trademark."

On January 20, 2006, applicant filed a motion for leave to take limited discovery under Fed. R. Civ. P. 56(f), supported by an affidavit of Frank B. Janoski, Esq. in accordance with 37 CFR § 2.20 and required by Fed. R. Civ. P. 56(f).

The Board presumes familiarity with the issues presented via applicant's Rule 56(f) motion 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

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<sup>2</sup> On June 29, 2005, opposer filed its amended notice of opposition. On July 27, 2005, applicant filed his answer to the amended notice of opposition. The amended pleadings were noted by the Board on August 18, 2005 and entered.

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).

Again, applicant's summary judgment motion involves the grounds and issues of functionality, failure to function, and acquired distinctiveness and secondary meaning. 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 opposer's discovery requests (identified in the declaration of Frank Janoski,

Esq. and previously served on opposer) seek information that is essential to opposer's opposition to the summary judgment motion. However, opposer has not demonstrated the need to "conduct further discovery." We note that discovery closed on October 25, 2005 and opposer served its discovery requests one day prior thereto. Thus, absent a reopening of the discovery period, there was no possibility for any "follow-up" discovery requests.

Accordingly, opposer's motion for Rule 56(f) discovery is granted only to the extent that applicant is hereby ordered to serve supplemental responses to opposer's first set of interrogatories, opposer's first set of document requests, and opposer's requests for admissions within **THIRTY (30) DAYS** from the mailing date of this order.<sup>3</sup> To the extent that opposer also seeks leave to "conduct further discovery", the Rule 56(f) motion is denied.

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<sup>3</sup> It is acknowledged that applicant raised several objections in his previously served responses to these discovery requests. To alleviate any concerns and potentially obviate some of these objections, **the Board is hereby imposing its standard protective order**. The protective order is now in force and applicant's supplemental responses shall be served in compliance therewith. The standard protective order may be found in the Appendix of Forms of the TBMP (2d ed. rev. 2004) and on the USPTO website at: [www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm](http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm) Should the parties not be able to resolve their discovery disputes, in spite of protective agreement, the Board will entertain a motion to compel so long as it is (1) filed prior to the deadline (set forth in this order) for opposer's response to the summary judgment motion, and (2) filed after the parties have met and conferred in a good faith effort to resolve the outstanding discovery disputes.

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Opposer is allowed until **SIXTY (60) DAYS** from the mailing date on this order to file a response to applicant's motion for summary judgment.

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

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