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

DUNN

Mailed: November 25, 2009

Opposition No. 91189629

Borghese Trademarks Inc.

v.

Multi Media Exposure, Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on opposer's motion for discovery under Fed. R. Civ. P. 56(f). The motion is contested, and the Board held a phone hearing on November 24, 2009. The participants were Moira Selinka, attorney for opposer, Mark Kaufman, attorney for applicant, and Elizabeth Dunn, attorney for the Board.[1]

On September 23, 2009, applicant filed a motion for summary judgment on the opposer's claim of likelihood of confusion between its pleaded registrations for PRINCESS MARCELLA BORGHESE and BORGHESE marks for a variety of products, including shampoo, conditioner, and fragrances, and applicant's mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA

[1] Opposer attorney John Rannells attended the conference but did not participate.

for "pet shampoo, conditioners, and body sprays", the subject of opposed ITU Application Serial No. 77435171. Applicant contends that its mark identifies a different person than opposer's mark and has additional arbitrary matter which distinguishes the marks, and that the marks are used for substantially different goods, which are sold to different consumers in different channels of trade, and which cannot be used interchangeably.

By its motion for discovery under Fed. R. Civ. P. 56(f), opposer requests the deposition of applicant's declarant, Vice President Borghese, and responses to specified interrogatories, requests for documents, and requests for admission.[2] Opposer submits the declaration of Attorney Moira Selinka and notes that the motion for summary judgment was served before applicant served any response to opposer's discovery requests, and that the requested information is necessary in order for opposer to respond to applicant's motion.

Upon review, the Board finds that opposer seeks discovery tailored to the issues raised by applicant's motions for summary judgment. Specifically, inasmuch as applicant contends that the marks create different commercial impressions and that purchasing public will not

[2] During the conference, opposer withdrew the motion for discovery under Fed. R. Civ. P. 56(f) with respect to Document Request No. 11.

consider the marks related, and that the goods of the two parties are not the same, travel in different channels of trade, and that the different formulations of the goods preclude interchangeable use, applicant must produce the requested discovery regarding media references to applicant's mark (Document Request No. 2), applicant's promotional materials (Document Request No. 3), applicant's business and marketing plans (Document Request No. 8), applicant's use of the term PRINCESS MARCELLA BORGHESE (Request for Admission Nos. 10, 18-26), differences between the goods (Request for Admission No. 9) applicant's intended distributors, suppliers, sellers, and licensees (Interrogatory No. 4 and Document Request No. 9), trade channels (Interrogatory No. 5), trade shows where the goods under the mark are promoted (Interrogatory No. 11), ingredients (Interrogatory No. 9), and facilities for production (Interrogatory No. 10).

In addition, the Board will allow applicant to take the discovery deposition of applicant's declarant, Vice President Borghese on the matters raised in the declaration, discovery responses received as a result of this motion, and applicant's use of the term PRINCESS MARCELLA BORGHESE.

In summary, opposer's motion for discovery under Fed. R. Civ. P. 56(f) is granted as set forth above.

Applicant is allowed until January 9, 2010 to (i) serve its responses to discovery under Fed. R. Civ. P. 56(f) approved in this order, and (ii) notify opposer of the availability for deposition of Vice President Borghese.

The deposition must take place no later than thirty days after service of applicant's Fed. R. Civ. P. 56(f) discovery responses.

Opposer's response to applicant's motion for summary judgment is due within twenty days from the date of deposition.

Proceedings herein are otherwise suspended pending the Board's disposition of applicant's motion for summary judgment.

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