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

Proceeding	91196299
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91196299 (Parent) CONNECT PUBLIC RELATIONS, INC., Opposer, v. DIGITALMOJO, INC., Applicant. **Cancellation Nos. 92054395 & 92054427** DIGITALMOJO, INC., Petitioner, v. CONNECT PUBLIC RELATIONS, INC., Respondent.	**MEMORANDUM IN OPPOSITION TO MOTION TO COMPEL**

Opposer and Respondent Connect Public Relations, Inc. ("Connect") opposes Applicant and Petitioner Digitalmojo, Inc.'s ("Digitalmojo") *Motion to Compel Supplemental Responses to 1. Petitioner's Interrogatories Set One and Set Two, and 2. Petitioner's Requests for Admissions, Set One Necessary For Response to Opposer's Motion For Summary Judgment Fed. R. Civ. P.*

56(f) and for Leave to Serve Additional Discovery ("Motion to Compel") for the reasons stated herein.

I. INTRODUCTION

Digitalmojo's Motion to Compel should be denied because it is not supported by an affidavit stating the reasons why Digitalmojo is unable, without the requested discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial as specifically required by Fed. R. Civ. P. 56(d)[1] ("Rule 56(d)") and TBMP § 528.06.

(Note: In lieu of resubmitting duplicate copies of the relevant discovery requests and responses, Connect will cite to the exhibits attached to Digitalmojo's Motion to Compel in the footnotes of this opposition.)

II. LEGAL REQUIREMENTS UNDER RULE 56(d) AND TBMP § 528.06 TO OBTAIN ADDITIONAL DISCOVERY PRIOR TO RESPONDING TO A SUMMARY JUDGMENT MOTION

A non-moving party requesting additional discovery in response to a motion for summary judgment must "show by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition." Fed. R. Civ. P. 56(d). In this regard, TBMP § 528.06 reaffirms that "[t]he request <u>must</u> be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion." (Underlining added.) TBMP § 528.06 further states that "[i]n the event the moving party fails to support its Fed. R. Civ. P. 56(d) motion by an affidavit, the motion generally will be denied."

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[1] Digitalmojo's citation to Rule 56(f) is incorrect as it should instead read Rule 56(d). (Former subdivision (f) of Fed. R. Civ. P. 56 has been carried forward by the 2010 amendments to the Federal Rules of Civil Procedure as subdivision (d). However, as noted in TBMP § 528.06, the textual differences between current Rule 56(d) and former Rule 56(f) are purely stylistic and the case law developed under the earlier version remains authoritative.)

Federal courts have consistently upheld the requirement that the moving party provide an affidavit demonstrating that it is entitled to additional discovery under Rule 56(d). *See, e.g., Ray v. American Airlines, Inc.*, 609 F.3d 917, 923 (8th Cir. 2010)("To obtain a Rule 56([d]) continuance, the party opposing summary judgment must file an affidavit 'affirmatively demonstrating . . . how postponement of a ruling on the motion will enable him, by discovery or other means, to rebut the movant's showing of the absence of a genuine issue of fact.'"); *Doe v. Abington Friends Sch.*, 480 F.3d 252, 257 n.3 (3d Cir. 2007)(A properly filed motion must be accompanied by "a supporting affidavit detailing 'what particular information is sought; how, if uncovered, it would preclude summary judgment; and why it has not previously been obtained.'"); *see also* Moore's Federal Practice-Civil, § 56.102[2] (3d ed. 2013) ("Specific facts sought must be identified. Mere speculation that there is some relevant evidence not yet discovered will never suffice."). Moreover, it is well settled that Rule 56(d) does not condone a "fishing expedition" where the moving party merely hopes to uncover some possible evidence of unlawful conduct. *See Duffy v. Wolle*, 123 F.3d 1026, 1041 (8th Cir. 1997).

III. DIGITALMOJO'S MOTION TO COMPEL SHOULD BE DENIED FOR ITS FAILURE TO PROVIDE A SUPPORTING AFFIDAVIT IDENTIFYING THE PARTICULAR INFORMATION IT IS SEEKING AND HOW, IF UNCOVERED, IT WOULD PRECLUDE SUMMARY JUDGMENT

Digitalmojo's statements in its Motion to Compel that it "needs" Connect's discovery responses in order to enable it to respond to Connect's pending summary judgment motion are legally insufficient to satisfy the requirements of Rule 56(d) and TBMP § 528.06. First, both Rule 56(d) and TBMP § 528.06 explicitly require that the moving party support a motion for additional discovery by an affidavit. In fact, TBMP § 528.06 goes so far as to state that a Rule 56(d) motion filed without an affidavit should "generally be denied." In the present case,

Digitalmojo's failure to provide a supporting affidavit mandates that the Board deny its Motion to Compel.

Second, Digitalmojo's general statements in its Motion to Compel that it "needs" Connect's discovery responses do not satisfy the TBMP § 528.06 requirement that "[t]he motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment." (Underlining added). In this regard, Digitalmojo utterly failed to set forth with specificity in its Motion to Compel why it cannot respond to Connect's Motion for Summary Judgment without the requested discovery. For example, Digitalmojo does not identify a single fact that would be uncovered by the requested discovery and that could be used to rebut Connect's summary judgment motion.

Thus, for at least the reasons stated above, Digitalmojo's Motion to Compel should be denied.

IV. EVEN IF DIGITALMOJO'S MOTION TO COMPEL HAD BEEN PROPER AND IN ACCORDANCE WITH THE RULES (WHICH IT IS NOT), DIGITALMOJO IS NOT ENTITLED TO THE REQUESTED DISCOVERY ON PROCEDURAL GROUNDS

Digitalmojo requests that Connect be compelled to provide responses to (i) Petitioner's Interrogatories, Set One[2] served on March 12, 2014 and Petitioner's Interrogatories, Set Two[3] served on March 13, 2014 (collectively "2014 Interrogatories"); and (ii) Petitioner's Requests for Admission, Sets One and Two[4] served on March 13, 2014 (collectively "2014 RFA"). For the

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[2] Motion to Compel, Exhibit C.

[3] Motion to Compel, Exhibit C.

[4] Motion to Compel, Exhibit C.

reasons set forth below, Connect submits that Digitalmojo is procedurally barred from receiving responses to its 2014 Interrogatories and 2014 RFA.

A. Digitalmojo Should Not Be Awarded Additional Interrogatories in Excess of the 75 Interrogatory Limit Set in 37 C.F.R. § 2.120(d)(1) and TBMP § 405.03(a) Because the Request is Untimely

Digitalmojo does not dispute that its 2014 Interrogatories exceeded the 75 interrogatory limit agreed to by the parties in 2010 and set forth in 37 C.F.R. § 2.120(d)(1) and TBMP § 405.03(a). As justification for serving excess interrogatories, Digitalmojo contends that the 75 interrogatory limit agreed to by the parties only applied to the opposition proceeding and that there was no agreement between the parties as to the number of interrogatories in the cancellation proceedings. *See* Motion to Compel, pp. 7-8.

Digitalmojo's contention, however, is in direct contradiction to TBMP § 405.03(c) which unequivocally states:

> 37 CFR § 2.120(d)(1) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. <u>That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim.</u>

(Underlining added). Thus, the mere fact that this case involves multiple consolidated proceedings did not automatically entitle Digitalmojo to more than 75 interrogatories. In fact, the 75 interrogatory limit seems intended for cases just like this one, where there is only one

application being opposed, and two registrations being challenged, and any interrogatory from Digitalmojo against the latter could be asserted to both registrations as a single interrogatory, as pointed out in the regulation cited above.

Digitalmojo further asserts that it is entitled to serve the additional interrogatories because this proceeding involves "unusually numerous or complex issues" as set forth in TBMP § 405.03(c). Connect submits that Digitalmojo may have misread § 405.03(c). First, a party is not automatically entitled to serve excess interrogatories just because it believes that a proceeding involves "unusually numerous or complex issues." Instead, 37 C.F.R. § 2.120(d)(1) states that, absent a stipulation, a party must file a motion with the Board demonstrating good cause for the additional discovery. TBMP § 405.03(c) simply indicates that "unusually numerous or complex issues" in a proceeding "will be considered in determining a motion for leave to serve additional interrogatories." Thus, absent a motion granted by the Board, Digitalmojo is not entitled to additional interrogatories, but Digitalmojo's motion clearly cannot be granted given the defects and omissions noted above.

To the extent that Digitalmojo may be moving for leave to serve additional interrogatories, Connect submits that this request must be denied as both untimely and noncompliant with the TBMP. In regard to untimeliness, the discovery period for this proceeding closed on March 13, 2014. Digitalmojo should have and could have filed a motion requesting additional interrogatories well prior to the close of discovery. Connect submits at this late stage, additional discovery should not be granted as it would only serve to further delay this proceeding which as been pending since April of 2010, more than four years ago.

In regard to further procedural non-compliance by Digitalmojo, 37 C.F.R. § 2.120(d)(1) specifically requires that

> [a] motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served.

(Underlining added). Digitalmojo has clearly violated § 2.120(d)(1) because it has already served the additional interrogatories that it is requesting, namely, its 2014 Interrogatories, prior to the filing of the Motion to Compel. Digitalmojo further violated § 2.120(d)(1) because it did not provide a copy of all of the interrogatories which have previously been served with its Motion to Compel as it failed to provide a copy of its Applicant's Interrogatories, Set Two served on February 24, 2011.

In short, Connect should not be compelled to respond to the 2014 Interrogatories because (I) Digitalmojo has already served the 75 interrogatory limit agreed to by the parties in this proceeding; (ii) the discovery period is closed; and (iii) Digitalmojo already served the additional interrogatories and failed to provide a copy of all of its previous interrogatories, all in direct violation of 37 C.F.R. § 2.120(d)(1).

B. Connect Cannot Be Compelled to Provide Responses to the 2014 RFA Because the Motion to Compel was not Brought Within a Reasonable Time as Required by TMBP § 523.03

Connect objected to Digitalmojo's 2014 RFA numbers 1 to 403 on the basis that they were "previously asked and answered." In this regard, Digitalmojo does not dispute that the disputed 403 requests served in 2014 are word-for-word identical to requests numbered 1-403 propounded in Digitalmojo's Requests for Admission, Set Two[5] served on September 4, 2011. As a basis for re-serving the 403 requests for admission in 2014, counsel for Digitalmojo asserted in

[5] Motion to Compel, Exhibit B.

a letter[6] dated May 3, 2014 that Digitalmojo was dissatisfied with Connect's previous responses to the same 403 requests, which were originally served by Connect on December 5, 2011.

First, Connect submits that Digitalmojo acted outside of Fed. R. Civ. P. 37 ("Rule 37) by re-serving the exact same 403 requests in 2014 as were served in 2011 instead of pursuing the relief allowed under this rule. In particular, Rule 37 requires a propounding party that is dissatisfied with discovery responses to request a meet and confer conference with the responding party. Fed. R. Civ. P. 37(a). If dissatisfied with the outcome of the meet and confer conference, the propounding party must then file a motion to compel to obtain relief. *Id.* Instead of following proper procedure (by proceeding under the auspices of Rule 37 to resolve the allegedly unsatisfactory responses to the 403 requests served in 2011), Digitalmojo inappropriately re-served the exact same 403 requests in 2014, over two and one-half years later.[7] Importantly, Digitalmojo has cited no authority that would allow it to re-serve discovery requests where it is dissatisfied with the initial response to the same requests.

Second, Digitalmojo is precluded from seeking relief on this issue through its Motion to Compel because Digitalmojo did not act within a reasonable time after service of Connect's original responses to the 403 requests in December of 2011. In particular, TMBP § 523.03 is clear that a propounding party must file a motion to compel "within a reasonable time . . . after service of the response believed to be inadequate and must, in any event, be filed before the first testimony period opens." In the present case, it is undisputed that two and one-half years have passed since Connect served its original responses to the 403 requests. In all of that time, Digitalmojo never sought a meet and confer conference to discuss the allegedly unsatisfactory

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[6] Motion to Compel, Exhibit D

[7] For this reason, Connect objected to the requests numbered 1-403 in the 2014 RFA as already having been asked and answered.

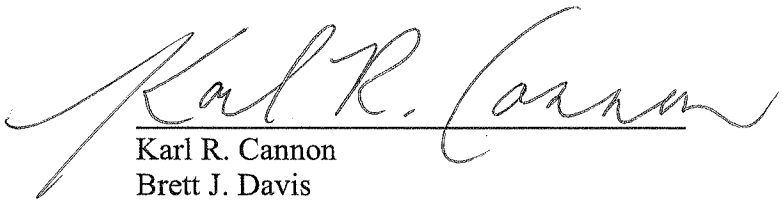
responses. Only now, two and one half years later and after discovery has closed and then only after Connect filed a motion for summary judgment, does Digitalmojo contend that Connect's responses to the 403 requests served in December of 2011 were inadequate. Connect respectfully submits that re-serving the same 403 requests two and one half years later does not restart the clock for determining a "reasonable time."

For the reasons set forth above, the Board should deny the Motion to Compel on this issue outright on the basis that (I) Digitalmojo acted improperly be re-serving the 403 requests in 2014 instead of seeking relief under Rule 37; and (ii) Digitalmojo's two and one-half year delay in brining its Motion to Compel is not "within a reasonable time" as required by TMBP § 523.03.

V. CONCLUSION

Connect respectfully submits that when all of the foregoing is considered, the Board will deny Digitalmojo's Motion to Compel. Further, because Digitalmojo's Motion to Compel did not procedurally comply with the affidavit requirement of Rule 56(d) and TMBP § 528.06, the Motion to Compel was non-responsive, and Connect respectfully asks the Board to strongly consider granting Connect's Motion for Summary Judgment forthwith.

Respectfully submitted this 11 day of June, 2014.



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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing **MEMORANDUM IN OPPOSITION TO MOTION TO COMPEL** to be served, via first class mail, postage prepaid, on this 11 day of June, 2014 to:

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