UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: September 16, 2014

Opposition No. 91196299

Connect Public Relations, Inc.

v.

Digitalmojo, Inc.

Cancellation No. 92054395
Cancellation No. 90254427

Cheryl S. Goodman, Interlocutory Attorney:

Opposer/Respondent (hereinafter "Opposer") filed, on April 29, 2014, a motion for summary judgment. In response Applicant/Petitioner (hereinafter "Applicant") filed on May 22, 2014, a "Motion to compel . . . Fed. R. Civ. P. 56(f) [discovery] and for leave to serve additional discovery." The motion to compel was filed prior to suspension of Board proceedings.[1]

On September 15, 2014, Opposer filed a motion to strike Applicant's reply as not timely filed.[2] The reply was filed 40 days after the deadline under Trademark Rule 2.127(a) and has not been considered. *See Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220,

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[1] In 2010, Fed. R. Civ. P. 56(f) was amended to Rule 56(d). The change was stylistic and not substantive and did not affect applicable case law.
[2] Opposer advises the motion to strike was not filed sooner because it was not served with the reply.

1221 (TTAB 2003) (giving no consideration to untimely reply brief). Accordingly, the motion to strike is moot.

To the extent that Applicant's motion to compel is one seeking responses or supplemental responses for general discovery separate and apart from seeking discovery for purposes of responding to the motion for summary judgment, the motion to compel is denied without prejudice with the right of Applicant to refile the motion to compel if proceedings resume. *See* Quinn, T. Jeffrey, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 TMR 413 (July – August 1990). ("The Board generally does not compel answers to pending discovery requests once a motion for summary judgment is filed, in the interest of judicial economy . . . . The Board sees no reason to compel responses to the non-movant's discovery requests when the responses are not needed to respond to the summary judgment motion, especially since the motion may dispose of the case").

The Board now turns to consideration of Applicant's motion to the extent it seeks Rule 56(d) discovery.

Applicant states that it served Interrogatories, set one, on March 12, 2014, and Interrogatories, set two, and Requests for Admissions, sets one and two, on March 13, 2014, and that Opposer served its responses on April 21, 2014. The parties met and conferred on the discovery responses, and Opposer agreed to supplement its responses, but then refused to provide

supplemental responses. Applicant states that the responses to these discovery requests are needed to respond to Opposer's motion for summary judgment. Applicant complains that Opposer failed to properly respond to the requests for admissions and lodged improper objections. Applicant seeks to "serve (or re-serve)" the discovery requests.[3]

In response, Opposer argues that the Rule 56(d) motion should be denied because it is not supported by an affidavit that states the reasons why Applicant cannot raise a genuine dispute of material fact without this discovery. Opposer further submits that the motion is "Legally insufficient" and lacks specificity as it fails to identify the particular information Applicant seeks and how the information would rebut Opposer's motion for summary judgment.

Pursuant to Rule 56(d), the Board has the discretion to continue a motion for summary judgment "if a party opposing the motion shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition . . . ." Thus, the Board has discretion to continue the motion for summary judgment if the non-moving party needs to discover essential facts. *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992) (citing former Rule 56(f), now Rule 56(d)). A party moving for Rule 56(d) discovery

[3] Opposer lodged an objection to the interrogatories stating that the interrogatories exceeded the 75 interrogatory limit agreed to in the parent opposition proceeding and that the interrogatories were directed to the parent opposition proceeding and not the child cancellation proceedings.

must show how additional discovery would preclude summary judgment and why it cannot immediately provide "specific facts" demonstrating a genuine dispute of material fact. *Id*. at 1475; Rule 56(d). Thus, the party requesting a continuance for discovery must identify by affidavit or declaration the specific facts that further discovery would reveal, and explain why those facts would preclude summary judgment. *Keebler Co. v. Murray Bakery Products,* 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) ("the Rule requires that each request for discovery be adequately supported by a showing of need"). Failure to comply with the requirements of Rule 56(d) is a proper ground for denying discovery and proceeding to summary judgment. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (citations omitted) ("A party may not simply assert in its brief that discovery was necessary and thereby overturn summary judgment when it failed to comply with the requirement of Rule 56[d] to set out reasons for the need for discovery in an affidavit").

Applicant has not complied with Rule 56(d), as the "declaration" states in conclusory fashion that:[4]

"Counsel for DigitalMojo has notified counsel for Connect that DigitalMojo will not be able to have at hand all available materials to respond to that

[4] Although signed, dated and under penalty of perjury, the declaration is defective as it fails to include the required statement "all statements made of his or her own knowledge are true and all statements made on information and belief are believed to be true," either under 37 C.F.R. §2.20 or 28 U.S.C. §1746. TMEP Section 804.01(b). 28 U.S.C. §1746 requires the statement "the foregoing is true and correct." In addition, the declaration fails to include the warning that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. §1001). 35 U.S.C. §25(b). *Id*.

Motion for Summary Judgment without responses to Petitioner's interrogatories (and Petitioner's requests for admissions as set forth below). Equity in these consolidated cases requires full and complete responses from Connect." and

"DigitalMojo will not be able to have at hand all available materials to respond to that Motion [for summary judgment] without responses to DigitalMojo's requests for admissions as set forth herein. Equity in these consolidated cases requires full and complete responses from Connect."

The motion also states "Connect's responses to these discovery requests are needed to enable DigitalMojo, as nonmoving party, to respond to the Motion for Summary Judgment filed by Connect on April 29, 2014."

Applicant's declaration does not describe the specific facts that would be revealed or why the discovery of such facts would preclude summary judgment. The broad, conclusory statements provided in the declaration fail to demonstrate how or why Applicant's ability to respond to the summary judgment motion is impaired by its lack of discovery, obtaining supplemental discovery responses or new discovery responses.[5] The Board is not required "to visualize what might have been said in the affidavits [or declarations] required by Rule 56[d]". *Keebler Co. v. Murray Bakery Products,* 866 F.2d 1386, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989). Applicant simply cannot rely on vague assertions that discovery will produce needed but unspecified facts. *Id.*, 9 USPQ2d 1736, 1739 n.5 citation omitted.

[5] The Board also notes after proceedings resumed on August 14, 2013, Applicant had six months to conduct discovery with respect to the cancellations before Opposer moved for summary judgment. Applicant had ample time to propound discovery with respect to the cancellation actions but waited until the last two days of discovery to serve its discovery requests.

In view thereof, Applicant's Rule 56(d) discovery request is denied. *Sweats Fashions, Inc. v. Pannill Knitting* Co., 4 USPQ2d at 1799.

Applicant's request to extend its time for responding to the motion for summary judgment is granted to the extent that Applicant is allowed until THIRTY DAYS from the mailing date of this order to file and serve its response to the motion for summary judgment. Opposer's reply is due in accordance with Trademark Rule 2.127(e).

Proceedings herein remain otherwise suspended.