

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

Mailed: January 12, 2012

Opposition No. 91198922

The Clorox Company

v.

Hermilo Tamez Salazar

**George C. Pologeorgis,
Interlocutory Attorney:**

Opposer filed a motion for summary judgment on September 23, 2011 with respect to its asserted claim of priority and likelihood of confusion. This case now comes before the Board for consideration of (1) applicant's motion (filed on September 28, 2011) for continued discovery under Fed. R. Civ. P. 56(d) and (2) applicant's motion (filed November 10, 2011) to strike opposer's reply brief in support of its motion for summary judgment. Both motions are briefed..

We first turn to applicant's motion to strike. In support thereof, applicant maintains that, since he has yet to file a response to opposer's motion for summary judgment on the merits, opposer's reply brief in support of its

motion for summary judgment is premature and should be stricken.

The Board agrees with applicant. Trademark Rule 2.127(e) provides that a party has thirty days from the date of service of a motion for summary judgment to file either a Rule 56(d) motion or, if no motion under Rule 56(d) is filed, a brief in response to the motion for summary judgment. Further, a reply brief in support of a motion for summary judgment should only be filed in response to the non-movants brief opposing the motion for summary judgment. *Id.* In this instance, applicant filed a motion for continued discovery under Rule 56(d) and not a substantive response to opposer's motion for summary judgment. Accordingly, we find that opposer's reply brief in support of its motion for summary judgment filed on November 8, 2011 is premature inasmuch as applicant has yet to file a brief in opposition to opposer's motion for summary judgment on the merits.¹

¹ To the extent opposer's reply brief also serves as a supplemental opposition to applicant's motion for Rule 56(d) continued discovery, we find the reply brief to be improper. Opposer has already filed an opposition to applicant's motion for Rule 56(d) continued discovery on October 13, 2011 and cannot use its reply brief in support of its motion for summary judgment as another opportunity to oppose applicant's motion for continued discovery under Rule 56(d).

In view thereof, applicant's motion to strike is granted and opposer's reply brief filed on November 8, 2011 is hereby stricken as premature.

We next turn to applicant's motion for Rule 56(d) discovery. In the affidavit submitted in support of his motion, applicant indicates that he has yet to conduct discovery in this proceeding. Applicant further states that, before he had the opportunity to serve written discovery, opposer filed its motion for summary judgment. In view thereof, applicant requests time to conduct discovery in order to respond to opposer's motion for summary judgment.

Specifically, applicant requests the opportunity to conduct discovery regarding the issues surrounding opposer's asserted claim of likelihood of confusion. In particular, applicant seeks discovery concerning the relatedness of the parties' respective goods, the similarity of the parties' respective class of customers, and the similarity of the trade channels of the parties' respective goods.² By way of his motion, applicant is also seeking additional time in

² The Board notes that applicant, in his reply brief in support of his motion for Rule 56(d) discovery, requests discovery above and beyond the discovery requested in his initial moving papers, i.e., (1) evidence of lack of actual confusion, (2) evidence regarding potential confusion or lack thereof, (3) evidence of third-party usage of marks similar to opposer's pleaded marks; and (4) evidence regarding the conditions under which buyers make sales decisions. The request for this additional discovery by way of applicant's reply brief is untimely under Trademark Rule 2.127(e) and therefore has been given no further consideration.

which to obtain evidence and prepare a declaration to rebut opposer's contention that applicant added the letters "tec" to "Clor" in its involved mark because it is short for technology.³

In opposition to applicant's Rule 56(d) motion, opposer maintains that applicant has not demonstrated that he is unable to respond to opposer's motion for summary judgment without discovery. Opposer contends that no discovery is needed on the issue of the similarities between applicant's and opposer's respective goods. In support of this contention, opposer states that the fundamental question is whether the goods and services, as described in the relevant application and pleaded registrations, can be related in the mind of the consuming public as to their origin. Opposer further maintains that the only evidence which it has asserted beyond the description of its goods in its pleaded registrations is a short declaration stating that the product commonly known as bleach is a solution of sodium hypochlorite and that sodium hypochlorite bleach is manufactured by a process known as "electrolysis." Opposer

³ A request for additional time to draft a declaration and obtain evidence in applicant's own possession to rebut a contention in opposer's motion for summary judgment is an inappropriate basis for seeking discovery under Rule 56(d). Accordingly, the Board has given no consideration to this argument in its determination herein.

argues that applicant has not and cannot take issue with this evidence and therefore there is no need for discovery regarding the contents of opposer's pleaded registrations.

Opposer also argues that no discovery is needed on the issue of the similarities between applicant's and opposer's customers and channels of trade. Specifically, opposer argues that, since there are no restrictions in the involved application and pleaded registrations in this case, the goods and services identified therein are presumed to travel in the same channels of trade to the same class of purchasers and, therefore, there is no need for discovery on this issue. Finally, opposer contends that applicant's affidavit in support of his motion for Rule 56(d) continued discovery is insufficient as a matter of law in that it fails to meet the requirements of Rule 56(d).

In view thereof, opposer requests that the Board deny applicant's motion for Rule 56(d) discovery.

A party that believes 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 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(d); *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).

As a general rule, the Board is liberal in its treatment of requests for discovery in response to motions for summary judgment. However, when a request for discovery under Fed. R. Civ. P. 56(d) 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). 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 opportunity to exercise pretrial discovery. See *Opryland USA Inc. v. Great American Music Show Inc.*, *supra*.

Here, the Board finds that applicant has sufficiently carried his burden in demonstrating the need to conduct discovery on the following issues: (1) the relatedness between applicant's goods and opposer's goods, (2) the class

of purchasers of opposer's goods, and (3) the trade channels through which opposer's goods are sold.

Accordingly, applicant's motion under Rule 56(d) is hereby granted solely to the extent noted below.

Applicant is allowed until thirty (30) days from the mailing date of this order in which to draft and serve upon opposer written discovery requests solely concerning (1) the relatedness of the parties' respective goods, (2) opposer's class of purchasers and (3) the channels of trade in which opposer's goods travel.

Opposer is allowed thirty (30) days after the date of service thereof to provide responses to the discovery requests permitted by this order.

Applicant is allowed until thirty (30) days after the date of service of said discovery responses in which to file his response to opposer's motion for summary judgment.

A reply brief in support of opposer's motion for summary judgment, if filed, is due in accordance with Trademark Rule 2.127(e).

Proceedings otherwise remain suspended pending the disposition of opposer's motion for summary judgment.