

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

MBA

Mailed: May 4, 2012

Opposition No. 91201070

Anderson Valley Acquisition
Company, LLC

v.

Matthew Harnden and Roger
Scommegna

Michael B. Adlin, Interlocutory Attorney:

On December 9, 2011, applicants filed a motion for summary judgment on opposer's sole claim of priority and likelihood of confusion, and that motion is currently pending. This case now comes up for consideration of opposer's fully-briefed cross-motion under Fed. R. Civ. P. 56(d), filed January 9, 2012, for discovery which opposer claims is necessary in order to respond to applicants' motion for summary judgment. Opposer specifically requests leave to take oral discovery depositions of both co-applicants.

By way of background, applicants seek registration of BOONVILLE CIDER HOUSE BITE HARD CIDER, in standard characters with BOONVILLE, CIDER and HARD CIDER disclaimed,

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for "Hard cider."¹ In its notice of opposition, opposer alleges prior use of THE LEGENDARY BOONVILLE BEER for "alcoholic beverages, namely beer, ale, lager, stout and porter, and malt liquor," and prior registration of the mark shown below



with a color claim and the words BOONVILLE and BEER disclaimed, for "Beer, ale, lager, stout and porter; Malt liquor."² As grounds for opposition, opposer alleges that use of applicants' mark would be likely to cause confusion with opposer's mark. In their answer, applicants deny the salient allegations in the notice of opposition.

There is no dispute that prior to the filing of applicants' motion, opposer served written discovery requests on applicants. There is also no dispute that pursuant to the parties' agreement, applicants responded to opposer's Interrogatory Nos. 3, 5, 6, 8, 10, 12-15 and 17 and Document Request Nos. 1, 3-8, 10, 13, 14, 16, 17, 20 and 21, despite the filing of applicants' motion for summary

¹ Application Serial No. 85178395, filed November 16, 2010 based on an alleged intent to use the mark in commerce.

² Registration No. 3801569, issued June 15, 2010 from an application filed January 31, 2008.

judgment before applicants' responses were due, and the Board's resulting suspension order of December 13, 2011. Opposer has not taken any depositions.

Applicants' motion for summary judgment is based primarily on applicant's argument that the parties' marks create different overall commercial impressions, and that "the only common term" between the parties' marks is "descriptive and disclaimed." However, applicants also rely on "copies of [two unidentified] articles," submitted through the Declaration of Adam Brookman ("Brookman Dec."), applicants' counsel, and declaration testimony from Roger Scommegna ("Scommegna Dec."), one of the two co-applicants. Mr. Scommegna testifies that although "[f]ormal use of the [involved] Mark has not yet begun," applicants have engaged in "some preliminary marketing and manufacturing of hard cider under similar marks." Scommegna Dec. ¶ 2. According to Mr. Scommegna, applicants will use the word "Boonville" to "identify the location of the source of the hard cider products sold under the Mark." Id. ¶ 3. Mr. Scommegna is an owner of The Boonville Hotel, which "sells wine, beer, and hard cider," including "various beer products offered for sale by" opposer, which "has a brewery and place of business in Boonville," California. Id. ¶¶ 4, 6-7. Mr. Scommegna testifies that nonparty Jim Ball Vineyards of

Boonville, California sells wine under the mark BOONVILLE.

Id. ¶ 5.

Opposer's cross-motion is supported by the Affidavit of Thomas R. Leavens ("Leavens Aff."), its counsel, who testifies that despite applicants' written discovery responses, opposer requires "the opportunity to orally depose [both]] Applicants, Scommegna and Harnden, on the merits of Applicants' Motion." Leavens Aff. ¶ 6.

Specifically, opposer claims to require oral discovery depositions of both applicants, the one who submitted a declaration and the one who did not, regarding:

- "the commercial impression of Applicants' Mark," apparently including the "intended" commercial impression thereof; Id. ¶ 8(a) and Cross-Motion at 5;
- the "marketing, and manufacturing of Applicants' goods;" Leavens Aff. ¶ 8(a);
- "the scope of Applicants' goods;" id. ¶ 8(b);
- "Applicants' current or proposed channels of trade for Applicants' goods;" id. ¶ 8(c);
- "allegations of third party use of 'Boonville;'" id. ¶ 8(d);
- "any instances of actual confusion between Opposer and Applicants' Marks;" id. ¶ 8(e);
- "the facts surrounding the allegations concerning Applicants'

other uses of the term 'Boonville;'"
id. ¶ 9; and

- Applicants' "intended use of the term 'Boonville;'" id. ¶ 10.

Without any support or explanation, and despite the fact that opposer asserts only one claim based on a single word mark and registered variation thereof against a single application, and applicant's motion is based on limited testimony primarily concerning a single DuPont factor, opposer argues that "the issues raised in Applicants' Motion are unusually complex."

In their response to the cross-motion, applicants point out that only Mr. Scommegna submitted a declaration in support of the motion for summary judgment, and argue that there is therefore no need for opposer to depose the non-testifying co-applicant. Applicants also claim that they "have not used the [involved] mark," that the "intended" commercial impression of their mark is "irrelevant" and that the involved intent to use application, including the goods identified therein and the disclaimer of BOONVILLE, speaks for itself.

In its reply brief, opposer argues that there are inconsistencies between applicants' motion for summary judgment and their response to the cross-motion for discovery. Specifically, while applicants claim that they have not used the involved mark, in their motion for summary

judgment they claim to have engaged in "preliminary marketing and limited manufacturing" of products under a "similar" mark. Moreover, although Mr. Scommegna owns part of a hotel which sells wine, beer and hard cider, including opposer's beer offered under opposer's pleaded mark, applicants claim in response to the cross-motion that the hotel is unconnected to their involved mark or application.

In order to establish that it is entitled to discovery under Fed. R. Civ. P. 56(d), opposer must show through affidavit or declaration (in this case the declaration of its counsel) "reasons why discovery is needed in order to support its opposition" to applicants' motion for summary judgment. Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 852, 23 USPQ2d 1471, 1474 (Fed Cir. 1992) (citing Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989)). Opposer must do more than set forth a "speculative hope of finding some evidence" that would support its arguments, however. Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1566-67, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). Instead, opposer "should set forth with specificity the areas of inquiry needed" to respond to applicants' motion for summary judgment. TBMP § 528.06 (2d ed. rev. 2004). "Unfocused

requests" for discovery which lack specificity are not sufficient under Fed. R. Civ. P. 56(f). Keebler, 866 F.2d at 1390, 9 USPQ2d at 1739.

Before addressing the specific topics which opposer claims to require multiple depositions to explore, it should be pointed out that, contrary to opposer's suggestion, a movant under Fed. R. Civ. P. 56(d) is not *per se* entitled to depose declarants who testify in support of a summary judgment motion. Rather, the movant must still explain why affidavits are insufficient to oppose the motion for summary judgment, and provide specific reasons for needing to question the credibility of declarants. Strang v. United States Arms Control and Disarmament Agency, 864 F.2d 859, 861 (D.C. Cir. 1989) (cross-motion for discovery denied despite movant's claim that discovery would be "invaluable" and provide "an opportunity to test and elaborate the affidavit testimony already entered"); Getz v. Boeing Co., 690 F.Supp.2d 982, 1000 (N.D. Cal. 2010) (same). Furthermore, the issues raised in applicants' motion are anything but complex. Indeed, this is a run-of-the-mill likelihood of confusion case made even more uncomplicated because the involved application is based on intent to use, rather than actual use.

In any event, turning to the specific topics of discovery on which opposer claims to require deposition testimony:

- as applicants' point out, their involved mark, which is a mere standard character word mark, speaks for itself, and even if applicants "intended" the mark to create a particular impression, their intention, as opposed to the mark's overall commercial impression to consumers, would be irrelevant;³
- applicants have already provided all necessary information about the "marketing and manufacturing of Applicants' goods," when they indicated, in response to opposer's Interrogatory Nos. 6 and 10, that they do not advertise and have not sold the involved goods under the involved mark;
- as applicants point out, "the scope of Applicants' goods" is for purposes of this proceeding, "Hard cider," i.e. the goods identified in the involved application; Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); Octocom Systems, Inc. v. Houston Computers Services, Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application, regardless of what the record may reveal as to the

³ It also does not escape notice that opposer's written discovery requests, served prior to applicants' motion for summary judgment, do not seek any information about the commercial impression of applicants' mark, much less applicants' "intentions," if any, with respect to the commercial impression of the involved mark.

particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed");

- similarly, because applicants seek an unrestricted registration, their goods are presumed to travel in all normal channels of trade, and in any event, applicants indicate in their discovery responses that they have not sold the involved goods under the involved mark so there are no channels of trade, and deposition testimony is therefore unnecessary on this topic; id.; see also, Venture Out Properties LLC v. Wynn Resorts Holdings, LLC, 81 USPQ2d 1887, 1893 (TTAB 2007);
- with respect to third party use of similar marks, the articles attached to the Brookman Declaration speak for themselves, and the entirety of Mr. Scommegna's testimony about Jim Ball Vineyards is that it "has been using the word/name 'Bonneville,' as shown [in a photograph], to identify one of its wine products since at least 2007," and to the extent opposer requires more information, it should seek it through Jim Ball Vineyards or any other third parties using similar marks, which would have more information than Mr. Scommegna, let alone Mr. Harnden;
- because applicants have already indicated that they do not yet use the involved mark for the involved goods, and more specifically, in response to Interrogatory No. 13, that "there are no instances of actual confusion," taking applicants' depositions on this topic would be pointless;

- applicants' "other uses" of BOONVILLE, besides the intended use of the involved mark for the involved goods, are irrelevant and deposition testimony on this topic is therefore not necessary, especially where applicants have already indicated that they have sold hard cider under similar marks and that The Boonville Hotel sells beer, including opposer's beer; see TBMP § 414(11) (3d ed. 2011); and
- finally, applicants' "intended use of the term 'Boonville'" is as specified in the involved intent to use application, and applicants have already indicated that they will use the word "to identify the location of the source of the hard cider products sold under the Mark," so deposition testimony about this topic is unnecessary.

For all of these reasons, opposer's cross-motion for discovery under Fed. R. Civ. P. 56(d) is hereby **DENIED**.

Opposer is allowed until **THIRTY DAYS** from the mailing date of this order to file and serve its substantive response to applicants' motion for summary judgment. Proceedings herein remain otherwise suspended pending disposition of the motion for summary judgment.
