

**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: April 2, 2015

Opposition No. 91207895

Hokie Objective Onomastics Society  
LLC

v.

Virginia Polytechnic Institute and  
State University

Opinion by Goodman, Administrative Trademark Judge:

This case now comes up on Opposer's motion for Fed. R. Civ. P. 56(d) discovery, filed November 25, 2014, in response to Applicant's motion for summary judgment (filed October 21, 2014). Applicant has opposed the motion.

Rule 56(d) provides, in pertinent part, that a party which believes that 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 or declaration showing that the nonmoving party cannot, for reasons stated, present by affidavit or declaration 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 the movant in the Rule 56(d) motion, Opposer bears the burden of persuasion in establishing why the Board should grant it the opportunity to seek specifically identified information in order to respond to Applicant's summary judgment motion which is solely based on standing.

Opposer submits that it requires responses to certain interrogatories and requests for production as well as documentation relating to answers to interrogatories to which Applicant has objected. It also seeks a Rule 30(b)(6) deposition and a deposition of Mr. Lawrence G. Hincker, whose declaration Applicant provided in connection with the motion for summary judgment. The information Opposer seeks to discover by these requests and depositions relate to Applicant's use of the involved mark by Applicant or its licensees, including historical use, and documentation of Applicant's "claims of rights".

In response, Applicant argues that "[a]ll of the facts that are essential for Hokie Society to know in order to oppose Virginia Tech's summary judgment motion are solely within its own possession" and it has not explained in its declaration how the discovery it seeks is "essential to justify its opposition." Applicant further argues that "[n]owhere in its Rule 56(d) motion or the support Declaration . . . does Hokie Society allege that it does not possess those facts" and the facts and discovery it seeks "have nothing whatsoever to do with whether or not Hokie Society has standing." Applicant

further argues that Lawrence G. Hincker's declaration "was simply for the purpose of providing background facts regarding Virginia Tech's adoption and use of the HOKIE Mark" and that permitting discovery of facts related to "Virginia Tech's historical use of the HOKIE Mark, . . . would not affect the outcome of Virginia Tech's summary judgment motion."

In reply, Opposer submits that information provided by Applicant as to its historical use is for the purpose of "persuading the Board that Applicant's position is correct and that its Motion should be granted. These assertions thus are 'issues presented by the motion for summary judgment.'"

Applicant's summary judgment motion is limited to Opposer's standing. One primary question for the Board to consider is whether the requested discovery will be necessary or relevant to the nonmovant's opposition to the motion for summary judgment and whether the discovery sought is limited to the legal issues upon which resolution of the motion for summary judgment will turn. *See Opryland USA Inc.*, 23 USPQ2d at 1475 (granting Rule 56(f) discovery where evidence sought directly related, and not peripheral, to the principal issues raised on summary judgment).

Although Opposer has stated with precision what discovery it requires, it has not shown that supplemental interrogatory responses, responses to document requests, or the taking of a Rule 30(b)(6) deposition or a deposition of Mr. Hincker related to applicant's use, including historical use, and Applicant's "claims of rights" are even marginally relevant to the question of

Opposer's standing. Nor has Opposer explained what specific material facts this discovery will likely disclose or how the facts obtained from this discovery will raise an issue of material fact as to Opposer's standing. *Keebler Co.*, 9 USPQ2d at 1739.

Standing is part of Opposer's case and any information related to Opposer's standing is solely within its possession. Opposer's requested discovery regarding Applicant's use and its claims of rights concerns issues unrelated to Opposer's standing. This information is simply not germane to the factual or legal issues presented in Applicant's motion for summary judgment as to Opposer's standing, and thus cannot help Opposer oppose Applicant's motion for summary judgment.

Opposer has failed to articulate any basis for its belief that the requested discovery would raise a trial worthy issue. Because the facts Opposer seeks to discover are not essential to oppose Applicant's motion for summary judgment, Opposer's arguments do not support a continuance under Fed. R. Civ. P. 56(d).

In view thereof, the motion for Rule 56(d) discovery is DENIED.

Opposer is allowed until THIRTY DAYS from the mailing date of this order to file its response to the motion for summary judgment.

Proceedings herein remain suspended pending disposition of the motion for summary judgment.