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: July 30, 2015

Opposition No. 91210158

Larry Pitt & Associates, P.C.

v.

Lundy Law, LLP

George C. Pologeorgis,
Interlocutory Attorney:

Lundy Law, LLP ("Applicant") seeks to register the mark REMEMBER THIS NAME, in standard characters, for "legal services" in International Class 45.[1]

On November 13, 2014, Larry Pitt & Associates, P.C. ("Opposer") filed an amended notice of opposition opposing the registration of Applicant's mark on the ground that Applicant's mark fails to function as a service mark under Sections 1, 3, and 45 of the Trademark Act. On December 2, 2014, Applicant filed an answer to the amended notice of opposition denying the salient allegations asserted therein.

On March 4, 2015, Applicant filed a motion for summary judgment regarding Opposer's claim that Applicant's mark does not function as a service mark. The

[1] Application Serial No. 85767757, filed on October 31, 2012, based upon an allegation of use under Section 1(a) of the Trademark Act, claiming May 16, 2011 as both the date of first use and the date of first use in commerce.

Board notes that Applicant submitted, among other things, the declaration of L. Leonard Lundy, in support of its motion for summary judgment.

This proceeding now comes before the Board for consideration of Opposer's motion (filed March 11, 2015) for Rule 56(d) discovery. Opposer's motion is fully briefed.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to Opposer's motion.

Opposer's Motion for Rule 56(d) Discovery

In support of its motion, Opposer contends that in order to respond properly to Applicant's motion for summary judgment it requests an order permitting it to take the depositions of (1) L. Leonard Lundy, managing partner of Applicant, (2) Tami Sortman, Applicant's marketing director, and (3) Applicant's 30(b)(6) witness. Opposer has submitted the declaration of Jacqueline M. Lesser, an attorney of the law firm representing Opposer in this matter, in support of Opposer's motion for Rule 56(d) discovery.

Rule 56(d) provides, in pertinent part, that 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 or declaration 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 U.S.A. Inc. v. Great*

American Music Show Inc., 970 F.2d 847, 23 USPQ 2d 1471 (Fed. Cir. 1992); and *Keebler Co. v. Murray Bakery Products*, 866 F2d 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. The party seeking to conduct additional discovery must put forth sufficient facts to show that such evidence exists and is not pure speculation. *See e.g., Vold v. D.A. Davison & Co.*, 816 F2d 1406, 1416 (9th Cir. 1987). Rule 56(d) discovery is not a substitute for full-blown pre-trial discovery. Under Rule 56(d), Opposer is limited to discovery it 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).

As a general rule, the Board is liberal in its treatment of requests for discovery in response to motions for summary judgment. 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.*

In view of the foregoing, Opposer's motion for Rule 56(d) discovery, is **GRANTED**, in part, and **DENIED**, in part, for the reasons set forth below.

The Board finds that, based upon the record, Opposer has sufficiently demonstrated a need to take the deposition of the L. Leonard Lundy, particularly since Mr. Lundy submitted his declaration in support of Applicant's motion for summary judgment. The deposition of Mr. Lundy, however, must be limited to the topics raised in his declaration, and may include testimony regarding any documents/exhibits attached to his declaration. Similarly, the Board finds, based on the record, that Opposer has sufficiently demonstrated a need to take the discovery deposition of Ms. Tami Sortman, inasmuch as Ms. Sortman, in her capacity as Applicant's marketing director, would be a person with specific knowledge regarding the manner in which Applicant uses the wording REMEMBER THIS NAME in association with its legal services and, therefore, her testimony would be directly relevant and necessary to the issues raised in Applicant's motion for summary judgment.

However, with regard to Opposer's request to permit the 30(b)(6) deposition of Applicant, the Board finds that Opposer has failed to demonstrate the need to take this deposition in order to respond to Applicant's motion for summary judgment. The fact that the parties may have agreed to proceed with Applicant's 30(b)(6) witness prior to the filing of Applicant's motion for summary judgment does not, in and of itself, justify the taking of the deposition for purposes of responding to Applicant's motion for summary judgment. Moreover, the Board notes that

Opposer's deposition notice of Applicant's 30(b)(6) witness, submitted as an exhibit to Opposer's motion for 56(d) discovery, identifies topics for discovery that clearly exceed the scope of information necessary for Opposer to respond to Applicant's motion for summary judgment. Accordingly, Opposer's Rule 56(d) motion, as it pertains to Applicant's 30(b)(6) witness, is **DENIED**.

Summary

Opposer's motion for Rule 56(d) discovery is **GRANTED**, in part, and **DENIED**, in part. Opposer is allowed until **thirty (30) days** from the mailing date of this order in which to notice, take, and complete the discovery depositions of L. Leonard Lundy and Tami Sortman pursuant to the guidelines set forth herein.[2]

Opposer is then allowed until **thirty (30) days** from the expiration of the thirty-day period provided above or the date the last deposition is taken permitted by this order, whichever is earlier, in which to file and serve its response to Applicant's motion for summary judgment.

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

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

[2] The Board expects that Applicant will be cooperative in scheduling the depositions of Mr. Lundy and Ms. Sortman within the time period provided by this order. The Board **will not** entertain a request by Applicant to extend the time provided for such depositions absent Opposer's consent.