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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91210158 |
| Party | Plaintiff<br>Larry Pitt & Associates, P.C. |
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| Date | 10/31/2013 |
| Attachments | Memorandum of Law In Support of Larry Pitt & Associates' Motion under Rule 56(d).PDF(175925 bytes ) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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| LARRY PITT & ASSOCIATES, P.C.<br><br>Opposer,<br><br>v.<br><br>LUNDY LAW, LLP<br><br>Applicant | Opposition No 91210158 |

**MEMORANDUM OF LAW IN SUPPORT OF LARRY PITT & ASSOCIATES' MOTION UNDER RULE 56(d)**

Pursuant to Rule 56(d) of the Federal Rules of Civil Procedure and 37 C.F.R. §2.127(e)(1), Opposer, Larry Pitt and Associates ("Opposer" or "Larry Pitt") hereby moves for an order to: 1) defer or deny the motion for summary judgment of Applicant, Lundy Law LLP ("Applicant" or "Lundy Law") as premature pursuant to Fed. R. Civ. P. 56(d)(1); or 2). to issue an Order to allow time for Opposer to obtain declarations and take additional discovery to respond to the motion, pursuant to Fed. R. Civ. P. 56(d)(2); or 3) to make any other ruling consistent with Rule 56(d)3.

## I. PROCEDURAL BACKGROUND RELEVANT TO THIS MOTION

Larry Pitt has opposed Applicant's attempt to register REMEMBER THIS NAME on the grounds that the phrase is merely descriptive, if not generic, and that it fails to function as a trademark. Indeed, it is Opposer's position that no trademark rights should accrue to the common instructional phrase: REMEMBER THIS NAME which Applicant concedes always

precedes its name: Lundy Law, as in "INJURED? REMEMBER THIS NAME: LUNDY LAW" which Applicant uses so that potential clients "recall" and recognize its name. Declaration of Jacqueline M. Lesser, Esq., dated October 31, 2013 ("Lesser Decl.") ¶¶4 and 5; Interrogatory Response No. 6 and Admission 1.

At issue is the right of third party law firms to direct their own potential clients to remember their own law firms' names, or their own law firms' telephone numbers, as is the practice with most, if not all, personal injury attorneys. Prior to the filing of this Opposition, Lundy Law, in fact, moved to enjoin Opposer's use of the similarly generic phrase REMEMBER THIS NUMBER based on Lundy Law's purported rights in REMEMBER THIS NAME. Lesser Decl. ¶2.

Initial disclosures were due July 19, 2013 and discovery is set to close on December 16, 2013. No extensions to the discovery and trial schedule have been sought at this point in the proceedings. Applicant served its formal responses and objections to Opposer's First Set of Interrogatories, First Request for Production of Documents, and First Requests for Admission on September 10th, and filed its motion for summary judgment 2 ½ weeks later, without providing either promised production; or permitting Opposer to object to Applicant's deficient responses. Lesser Decl. ¶¶3-5. Moreover, no depositions have as yet been noticed – the September 10th discovery responses provided the first notice of potential witnesses, other than Applicant's principal, Leonard Lundy, who is first identified in the September 10th responses as one of the people involved in coming up with the phrase REMEMBER THIS NAME. Lesser Decl. ¶4; Interrogatory Response Nos. 1 and 2. While Leonard Lundy submitted a declaration in support of Applicant's summary judgment motion, Opposer has not had an opportunity to test either the veracity of Leonard Lundy's statements made in his summary judgment declaration, or to

examine Leonard Lundy (or the other persons first identified in the September 10th discovery responses) regarding the creation and use of the REMEMBER THIS NAME slogan or on any other matter.

## II. APPLICANT'S SUMMARY JUDGMENT MOTION IS PREMATURE

The true purpose of Lundy Law's summary judgment motion is simply to freeze discovery, and to deny Larry Pitt an opportunity for adequate discovery to support its evidentiary burden of proofs in the opposition proceeding. However, a plaintiff should not be "'railroaded' by a premature motion for summary judgment." *Celotex Corp. v. Catrett*, 477 U.S. 317, 326, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). Without question, Applicant's summary judgment motion – filed a mere 2 ½ weeks after first identifying potential discovery witnesses, and prior to promised production of documents – is premature. The Board is especially mindful of 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.,* 970 F.2d 847, 23 U.S.P.Q. 1471 (Fed Cir. 1992); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 U.S.P.Q. 2d 1736 (Fed. Cir. 1989). This case before the Board now exemplifies the very "railroading" of which the Board disapproves. The majority of discovery requested in the accompanying Lesser Declaration is of existing, pending discovery requests, or foreseeable follow up discovery by way of depositions of Lundy Law employees or third parties who have worked with Lundy Law. It is appropriate for Opposer to request that either the motion for summary judgment be denied or deferred, or that discovery be allowed before it responds to the motion since the parties are in the middle the discovery period, and Opposer still awaits production – failing which it will move to compel. Indeed, although requests have been served,

Lundy Law has refused any production on matters of distinctiveness. Lesser Decl. ¶¶ 3; 4 and 7 (i)[1]. Similarly, although requests have been served, Lundy Law has refused any discovery on genericness. Lesser Decl. ¶¶3 and 4; Interrogatory Response No. 16; Responses to Document Requests Nos. 13 and 20. Moreover, to the extent that persons have been identified in response to Opposer's first set of discovery requests, because of the timing of the summary judgment motion, Larry Pitt has been unable to schedule depositions.

**a. Opposer is entitled to discovery on genericness, descriptiveness and functionality.**

Lundy Law's argument essentially is that as a matter of law, Opposer cannot prove that the slogan REMEMBER THIS NAME (concededly, used always with the name to be remembered[2]) is generic, merely descriptive, and simply fails to function as a trademark.

However, it is a *factual* issue whether REMEMBER THIS NAME is a generic phrase. *See*, *In re Pennington Seed, Inc., 466 F.3d 1053, 1056, 80 U.S.P.Q. 2d 1758 (Fed. Cir. 2006); Rock & Roll Hall of Fame v. Gentile Prods*., 134 F.3d 749, 753 (6th Cir. 1998) (genericness is an issue of fact). Generic terms are incapable of functioning as a trademark, a term may not be registered if due to its inherent nature or manner of use, the mark does not function as a trademark. TMEP Section 1202.

Whether the phrase REMEMBER THIS NAME is merely descriptive is also a question of fact. *DuoPross Meditech Corp. v. Inviro Medical Devices Ltd*. 103 U.S.P.Q. 1753, 1756

[1] Lundy Law has refused to produce any documents that would support its claimed acquired distinctiveness since the parties have agreed that there would be no protective order entered in this case. Typical evidence would be advertising, promotional figures in support of such a slogan. Lundy Law has in the past made its advertising and promotional figures generally and publicly available on the PTO website without any confidentiality limitation.Since this type of material has not been considered by Lundy Law as confidential in the past, one can only presume that Lundy Law's failure to produce this information in support of its claimed distinctiveness really means it has no financials to support this claim.

[2] Lesser Decl. ¶3; Document Request No. 18.

(Fed. Cir. 2012). In a descriptiveness analysis,"[t]he question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc*., 64 U.S.P.Q. 2d 1314, 1316-17 (TTAB 2002). Slogans such as REMEMBER THIS NAME are descriptive where they are commonly used in the relevant industry. *In re Melville Corp*., 228 U.S.P.Q. 970, 971-971 (TTAB 1986). *See also*, TMEP 1209.3(p) (terms that describe a function or purpose may be merely descriptive or generic); and likewise, slogans such as REMEMBER THIS NAME in common industry use are not registrable. *See*, TMEP 1209.3(s). Applicant has argued that REMEMBER THIS NAME is "inherently distinctive." See Motion at 16. Opposer is entitled discovery of Applicant's claimed inherent distinctiveness, and the lack of descriptiveness and lack of genericness of the advertising phrase.

Lundy Law's argument that the Examining Attorney has approved REMEMBER THIS NAME without requiring a claim under 2(f) does not end the distinctiveness inquiry – it is well settled that the Board is not bound by the decisions of Examining Attorneys. *See Superbakery Inc. v. Benedict*, 96 U.S.P.Q. 2d 1134*,* 1135 *(Fed. Cir. 2010)*; *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 U.S.P.Q. 2d 1538, 1541 (TTAB 2000). Despite the weak arguments, Larry Pitt must still respond to Lundy Law's points that its slogan is not generic and is both distinctive or has acquired distinctiveness through consumer identification, and requires further discovery to do so.

**b. Lundy Law has refused to produce discovery**

Although Applicant's claim of inherently distinctive and nongeneric is specious, at best, Larry Pitt is entitled to discovery on the following subjects for its response to the motion.

- Discovery on creation of REMEMBER THIS NAME from Applicant and its identified advertising and marketing personnel, including drafts of mock ups, notes, memorandum, and third party discovery of the identified advertising and marketing persons.

- Discovery on consumer association of REMEMBER THIS NAME.
- Discovery on distinctiveness of REMEMBER THIS NAME.
- Discovery of any consumer perceptions of the phrase REMEMBER THIS NAME as a mark, as a descriptive or generic phrase, and on grounds that the phrase fails to function as a trademark.

Thus far, Lundy Law has refused production on these topics. Given Lundy Law's position that the phrase functions as a mark, and that the phrase is not merely descriptive, Opposer is entitled to discovery on the creation and use of the phrase. *See e.g. T. Marzetti Co. v. Roskam Baking Co*., 102 U.S.P.Q.2d 1801, 1804 (6th Cir. 2012) (Texas Toast found generic for croutons based on discovery of trademark owner's own documents). Tellingly, Lundy Law has refused to produce any documents relating to communications on the development and creation of its slogan, stating that "Applicant further objects to this Request to the extent that developing a response to this Request would be oppressive, unduly burdensome, unreasonably expensive and/or would require an unreasonable investigation on the part of Applicant." Lesser Decl. ¶3; Response to Document Request No. 11. And although Applicant has agreed to produce nonprivileged or documents which are not work product "regarding or concerning the creation of the tag line phrase REMEMBER THIS NAME," no documents have been forthcoming, and it is unclear what documents would be deemed privileged or work product. *Id*.

Lundy Law makes the broad statement that the phrase REMEMBER THIS NAME is neither generic nor descriptive because the individual words "remember" and "name" are not defined as "law firm" in a dictionary. However, the inquiry does not end there, and Larry Pitt is entitled to test this assertion through discovery, in particular, given that there are entire categories of marks that have been deemed "descriptive" although the marks do not immediately

describe the product or service in question.[3] Tellingly, Lundy Law has refused to produce any documents to support its contention that REMEMBER THIS NAME is not merely descriptive, other than the advertisements that are attached to the Leonard Lundy declaration, and Lundy Law characterizes the production request as "unreasonable". Lesser Decl. ¶3; Response to Document Request No. 18. Larry Pitt should be entitled to question Lundy Law about this.

Further, on the issue of descriptiveness, Larry Pitt is entitled to discovery on "whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.,* 64 U.S.P.Q. 2d 1314, 1316-17 (TTAB 2002), *accord DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 U.S.P.Q.2d 1753, 1757 (Fed. Cir. 2012). Applicant has also argued in its motion, that its slogan, if not inherently distinctive, has acquired distinctiveness -- that "Lundy Law's mark REMEMBER THIS NAME has been, and continues to be, used and promoted in such a manner so as to make it both known to consumers and to have consumers associate it with Lundy Law and its services as an identifier of source." Motion at 15. Larry Pitt has the right to test this bold and unsupported assertion through discovery. None of this discovery has been produced at this point.

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[3] *See e.g. Ringling Bros.-Barnum & Bailey v. Celozzi-Ettelson*, 855 F. 2d 480, 481 (7th Cir. 1988) ("the Greatest Show on Earth" descriptive of circus); *Co-Rect Prod, Inc. v. Marvy!Adver. Photo*, 780 F. 2d 1324, 1331-32 (8th Cir. 1985) (advertising expression "he can save you enough money to pay his own salary" descriptive of bartending product); *Sparknet Commc'n L.P. v. Bonneville Int'l Corp*., 386 F. Supp. 2d 965, 977(N.D. Ill. 2005) ("whatever we want" descriptive for radio station, despite registration); *K Merchandise Mart, Inc. v. Kmart Corp*., 81 F. Supp. 2d 923, 929 (C.D. Ill. 2000) ("Changing for a better day" descriptive of plaintiff's retail business – plaintiff failed to offer any evidence of secondary meaning, relying on its characterization of its mark as "suggestive"); *Stop & Shop Supermarket Co. v. Fullerton Corp*., 943 F. Supp. 120, 122 (D. Mass. 1996) ("It's that simple" for a supermarket deemed descriptive); Reed v. Amoco Oil Co, 611 F. Supp. 9, 13 (M.D. Tenn. 1984) ("goin the extra mile" descriptive of a tire dealership).

That Applicant's real intention is simply to avoid the discovery process and railroad Larry Pitt is highlighted by Lundy Law's *own* papers. Lundy Law cites Larry Pitt's discovery response and objection to Applicant's Interrogatory No. 5 that at this point in the proceeding, Opposer need not identify all of the documents upon which it intends to rely insofar as the request is "premature in that the opposition and discovery are in its initial stages." By moving for summary judgment at this juncture, while acknowledging that Opposer seeks additional discovery, Lundy Law essentially admits that its motion is premature.

**III. CONCLUSION**

For the foregoing reasons as detailed above, and in attached declaration of Jacqueline M. Lesser submitted herewith, Opposer requests that the Board, pursuant to Fed. R. Civ. P.56(d) and 37 C.F.R. §2.127(e)(1) defer considering the motion or deny it; or alternatively, allow time to obtain affidavits, declarations or discovery; or alternatively, issue any appropriate order.

Respectfully submitted,

Dated: October 31, 2013

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 31st day of October, 2013, I caused a true and correct copy of the foregoing MEMORANDUM OF LAW IN SUPPORT OF LARRY PITT & ASSOCIATES' MOTION UNDER FED.R.CIV.P. 56(D) to be served by First Class mail upon counsel for Applicant, Lundy Law, LLP at:

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