

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

EJW

Mailed: June 30, 2015

Opposition No. 91213266

ActII Jewelry, LLC d/b/a lia sophia

v.

Mialisia & Co., LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On August 13, 2014, Applicant filed a motion for summary judgment. In response thereto, on September 10, 2014,¹ Opposer filed a motion under Fed. R. Civ. P. 56(d), requesting that the Board's consideration of the summary judgment motion be deferred and that Opposer be allowed to conduct certain discovery in order to respond to the motion for summary judgment.

Applicant did not file a response to Opposer's motion under Rule 56(d). Nonetheless, the Board exercises its discretion to consider the motion on its merits. *See* Trademark Rule 2.127(a).

By way of background, Applicant seeks summary judgment on the basis that the parties' respective marks are not confusingly similar in appearance, sound, meaning or commercial impression. For purposes of the motion, Applicant concedes the relatedness of the goods and that Opposer has priority (12 TTABVUE 3-4).

¹ The Board's delay in addressing this matter is regretted.

Although the motion for summary judgment focuses solely on the factor of similarity, Opposer seeks discovery on the issues of asserted bad faith on the part of Applicant in adopting the mark MIALISIA & CO., “on the conditions under and buyers to whom sales are made” (13 TTABVUE 5-6), and on “how Applicant’s goods are marketed and policies it promulgates to that end” (13 TTABVUE 11). Opposer states also that it will request that Applicant produce samples of the “Basic Designer Kit” and “Complete Fashion Kit” used by Applicant’s designers, with the goal of obtaining additional information on how Applicant’s goods are marketed (13 TTABVUE 11).

A party that 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 moving party must state therein the reasons why it is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial. In particular, the motion should set forth with particularity what facts the movant hopes to obtain by discovery and how these facts will raise a genuine dispute as to a material fact. Further, the request must be supported by an affidavit showing that it cannot, for reasons stated in the affidavit, present 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, 1738-39 (Fed. Cir. 1989). *See generally* TBMP § 528.06 (2014). “Where the nonmoving party has not had the opportunity to discover

information that is essential to his opposition,” and “when the proposed discovery is reasonably directed to ‘facts essential to justify the party’s opposition,’ ... such discovery must be permitted.” *Opryland*, 23 USPQ2d at 1474-75 (internal citations omitted). See also *Dunkin’ Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026, 1028 (Fed. Cir. 1988) (Board erred by prematurely granting summary judgment when movant had not had any opportunity to gather evidence through discovery).

The Board is not persuaded that Opposer should be allowed time to conduct discovery of the information it seeks. Opposer’s proposed discovery is not reasonably directed to facts essential to justify its opposition to the summary judgment motion. In particular, Opposer has not shown how facts related to asserted bad faith in choosing the applied-for mark or the conditions under which and buyers to whom sales are made will raise a genuine dispute as to a material fact pertaining to the similarity or lack thereof of the parties’ respective marks. Rule 56(d) “requires that each request for discovery be adequately supported by a showing of need.” *Keebler Co. v. Murray Baker Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed.Cir. 1989). Opposer has not established its need for the specified, additional discovery here. In view thereof, Opposer’s motion under 56(d) is **denied**.

Opposer is allowed until **THIRTY DAYS** from the mailing date of this order to serve and file its opposition to Applicant’s motion for summary judgment.

This proceeding remains **SUSPENDED** pending the Board’s consideration of Applicant’s motion for summary judgment.