

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: February 29, 2016

Opposition No. 91218431 (**Parent Case**)

Double Down, Inc.

v.

IGT

Cancellation No. 92059996

Double Down, Inc.

v.

IGT

Cancellation No. 92060105

IGT

v.

Double Down, Inc.

George C. Pologeorgis,
Administrative Trademark Judge:

On July 15, 2015, IGT filed a motion for summary judgment as to only Cancellation No. 92059996 of these consolidated proceedings on its asserted affirmative defense of laches. These consolidated proceedings now come before the

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Board for consideration of Double Down, Inc.'s ("DDI") motion for Rule 56(d) discovery to respond to IGT's motion for summary judgment. DDI's motion is fully briefed.

DDI's Motion for Rule 56(d) Continued Discovery

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of these consolidated proceedings and the arguments and evidence submitted with respect to DDI's motion for Rule 56(d) discovery. For the reasons set forth below, DDI's motion for Rule 56(d) continued discovery is **DENIED**.

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 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

As the movant in the Rule 56(d) motion, DDI 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 IGT's summary judgment motion. The party seeking to conduct additional discovery must put forth sufficient facts to show

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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), DDI 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).

In her affidavit in support of DDI's motion for 56(d) discovery, DDI's counsel indicates that additional discovery is needed for DDI to respond properly to IGT's motion for summary judgment which is predicated on IGT's affirmative defense of laches with regard to DDI's asserted claim of likelihood of confusion in Cancellation No. 92059996. Specifically, DDI seeks additional and/or supplemental discovery regarding (1) information and documents relating to IGT's acquisition of Double Down Interactive; (2) documents evidencing the manner in which IGT uses its subject DOUBLE DOWN CASINO mark; (3) information and documents relating to IGT's plans to use or expand its use of the DOUBLE DOWN CASINO mark; (4) information and documents relating to agreements between IGT and third parties wherein IGT grants permission to use the DOUBLE DOWN CASINO mark; (5) information relating to, and documents evidencing, each product or services with which the DOUBLE DOWN CASINO mark has been or will be used; (6) documents relating to the assignment of rights in the DOUBLE DOWN CASINO mark from

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Pickjam through IGT; (6) information relating to, and documents evidencing, the advertisement and promotional materials in each media utilized in connection with the DOUBLE DOWN CASINO mark; and (7) documents relating to the identity and characteristics of consumers and potential consumers of products or services offered in connection with IGT's DOUBLE DOWN CASINO mark. DDI maintains that it needs this discovery because it goes directly to the issue of whether IGT progressively encroached on DDI's alleged trademark rights in a manner that would justify the delayed filing of DDI's petition to cancel in Cancellation No. 92059996.

While the Board acknowledges that the discovery DDI seeks pursuant to its Rule 56(d) discovery motion may be relevant to its asserted claim of likelihood of confusion, the Board finds, contrary to DDI's contentions, that this information is not necessary for DDI to respond to IGT's motion for summary judgment on the issue of laches. Any information that formed the basis for DDI's decision to file its petition to cancel IGT's subject DOUBLE DOWN CASINO mark at the time it did would already be in DDI's own possession, custody and control. Moreover, DDI's filing of a Rule 56(d) motion for the purpose of exploring its progressive encroachment theory as a means to justify its alleged delay in filing its petition to cancel is inappropriate since such a motion necessarily seeks evidence that could not have informed DDI's knowledge at the time of the filing of the petition to cancel and thus cannot inform whether DDI acted reasonably in light of what it knew at the time it filed its petition to cancel. Accordingly, the Board finds that there is no

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need for DDI to obtain any additional discovery from IGT in order to respond to IGT's motion for summary judgment on its asserted affirmative defense of laches.

In view of the foregoing, DDI's motion for continued discovery under Fed. R. Civ. P. 56(d) is **DENIED**.

DDI is allowed until **March 30, 2016** in which to file and serve a response to IGT's motion for summary judgment.

A reply brief in support of the motion for summary judgment, if filed, is due in accordance with Trademark Rule 2.127(e).

Proceedings otherwise remain suspended pending the disposition of IGT's motion for summary judgment on its asserted affirmative defense of laches.