

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

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: Georgia Graham Jones, :  
: Petitioner, :  
: v. : Cancellation No. 92040746  
: Alison Holtzschue, :  
: Registrant. :  
-----x

MOTION PURSUANT TO RULE 56(f)

Pursuant to Rule 56(f) of the Federal Rules of Civil Procedure, Registrant Alison Holtzschue ("Registrant") moves the Trademark Trial and Appeal Board (the "Board") to refuse Petitioner's application for summary judgment because Registrant has had no opportunity to take discovery on the claims on which Petitioner seeks summary judgment.<sup>1</sup>

The "Motion for Summary Judgement" that Petitioner served on April 17, 2003 (the "Motion") appears to seek summary judgment on two grounds. Petitioner first claims that she may be entitled to summary judgment because

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<sup>1</sup> The Federal Rules of Civil Procedure generally govern proceedings before the Board. 37 C.F.R. § 2.116(a).

of unstated irregularities surrounding the Motion To Set Aside Default that Registrant filed and served on November 27, 2002. Petitioner then claims that the exhibits attached to her "Ammended [sic] Petition To Cancel" (the "Amended Petition") and her "representations ... are so clearly evident of likelihood of confusion" as to warrant summary judgment.

Registrant respectfully requests that the Board deny the Motion because Registrant has had no opportunity to conduct discovery on the claims on which Petitioner seeks summary judgment. "The Supreme Court has made clear that summary judgment is inappropriate unless a tribunal permits the parties adequate time for discovery." Dunkin' Donuts of America, Inc. v. Metallurgical Exoproducts Corp., 840 F.2d 917, 919 (Fed. Cir. 1988). See National Life Insurance Co. v. Solomon, 529 F.2d 59, 61 (2d Cir. 1975) (stating that summary judgment should be refused when "one party has yet to exercise its opportunities for pretrial discovery").

Opposing a motion for summary judgment requires setting forth specific facts that show that there is a

genuine issue for trial. See Fed. R. Civ. P. 56(e).<sup>2</sup>

Without an opportunity to conduct discovery to ascertain the facts of the case, the party against whom summary judgment is sought cannot meet its burden in opposing summary judgment of showing that genuine issues exist as to the facts material to the claims at issue. For this reason, Rule 56(f) calls for summary judgment to "be refused where the nonmoving party has not had the opportunity to discover information that is essential to his opposition." Opryland USA Inc. v. The Great American

<sup>2</sup> The obligation of the party against whom summary judgment is sought to show "that there is a genuine issue for trial" arises only "[w]hen a motion for summary judgment is made and supported as provided in this rule." Fed. R. Civ. P. 56(e). The Board need only look at the Motion itself to see that Petitioner has not met this burden as to her allegations concerning the Motion To Set Aside Default. The plain language of the Motion clearly indicates that Petitioner does not even know what the material facts are as to this claim, which is, itself, vague and relies on innuendo. Petitioner hints at instances of missing mail, suggests that Registrant's documents about "the mailing and receipt" of the Motion to Set Aside Default will not support Registrant's "representations," and claims that Petitioner will be entitled to summary judgment, if all is as she suspects it is after the Board obtains the facts she lacks. Summary judgment is appropriate, however, only when there are no more suspicions -- when the evidence shows "that there is no genuine issue as to any material fact" -- and summary judgment is plainly not appropriate when the movant is asking the Board to conduct discovery for her. Fed. R. Civ. P. 56(c).

Music Show, Inc., 970 F.2d 847, 852 (Fed. Cir. 1992)

(quoting Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 n.5 (1986)).

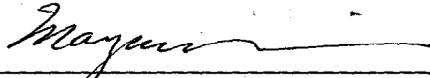
In this case, as Registrant has had no opportunity to discover any facts relating to the claims on which Petitioner seeks summary judgment, Registrant would be unable to meet its burden in opposing summary judgment of stating the specific material facts that are in dispute. It is precisely to such a situation that Rule 56(f) is directed. See Opryland USA, 970 F.2d at 852. Accordingly, Registrant respectfully requests that summary judgment be denied, and that Registrant be permitted to obtain discovery as outlined in the accompanying Declaration of Rita M. Carrier, attached hereto as Exhibit A.<sup>3</sup>

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<sup>3</sup> "Federal Rule of Civil Procedure 56(f) requires the nonmoving party to state, by affidavit, reasons why discovery is needed in order to support its opposition to a motion for summary judgment." Opryland USA, 970 F.2d at 852 (footnote omitted).

Dated: Washington, D.C.  
May 22, 2003

Respectfully submitted,



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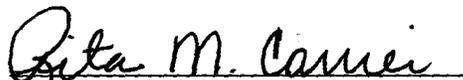
Margaret K. Pfeiffer, Esq.  
Rita M. Carrier, Esq.  
SULLIVAN & CROMWELL LLP  
1701 Pennsylvania Avenue, N.W.  
Washington, D.C. 20006  
(202) 956-7685 (Voice)  
(202) 293-6330 (Facsimile)  
carrierr@sullcrom.com (E-mail)

Attorneys for Registrant,  
Alison Holtzschue

Certificate of Service

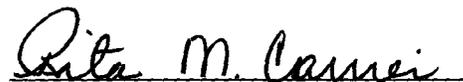
I hereby certify that a true copy of the foregoing Motion Pursuant To Rule 56(f), with the Declaration of Rita M. Carrier attached thereto as Exhibit A, were mailed to Petitioner Georgia Graham Jones, 42 Pascal Lane, Austin, Texas 78746, via first-class mail, postage prepaid, this 22nd day of May, 2003.

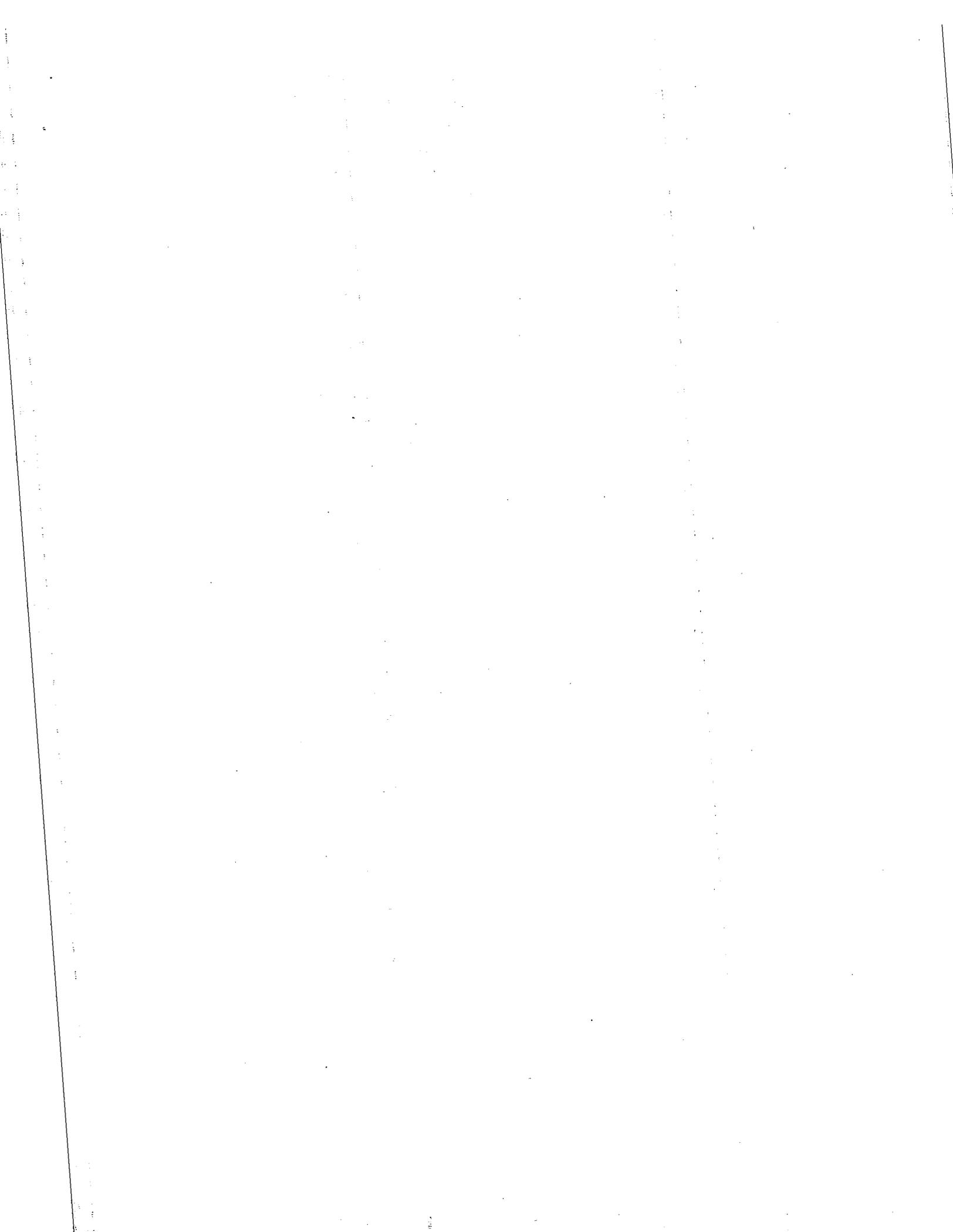
Dated: May 22, 2003

  
Rita M. Carrier

Certificate of Mailing

I hereby certify that, in connection with Cancellation No. 92040746, this Motion Pursuant To Rule 56(f), with the Declaration of Rita M. Carrier attached thereto as Exhibit A, is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington Virginia 22202-3514, on this 22nd day of May, 2003.

  
Rita M. Carrier



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

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Georgia Graham Jones, :  
Petitioner, :  
v. : Cancellation No. 92040746  
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Declaration of Rita M. Carrier

I, Rita M. Carrier, declare as follows:

1. I am a member of the bar of the State of New York and of the District of Columbia and an associate in the law firm of Sullivan & Cromwell LLP, attorneys for Registrant Alison Holtzschue ("Registrant"). I have personal knowledge of the facts set forth herein, and, if called upon to do so, would competently testify thereto. I make this declaration in support of Registrant's Motion Pursuant To Rule 56(f) for denial of Petitioner's "Motion for Summary Judgement" (the "Motion") on the ground that Registrant has not yet had the opportunity to conduct any discovery on the claims on which Petitioner seeks summary judgment. There has been, therefore, no opportunity to learn what the facts of this case are, much less to

determine whether genuine issues exist as to the facts material to Petitioner's claims.

2. In the Motion, Petitioner claims that, on the basis of her "representations" and the exhibits attached to the "Ammended [sic] Petition to Cancel" (the "Amended Petition"), she is entitled to summary judgment on her claim that a likelihood of confusion exists between Registrant's mark (Reg. No. 2,412,405 for COMPUTERSDOTMOM COMPUTER SKILLS, CONFIDENCE AND REALLY GOOD COFFEE and Design) and Petitioner's mark (Reg. No. 2,075,655 for COMPUTER MOMS (STYLIZED)). As explained in greater detail below, Registrant has had no opportunity to obtain discovery on any of the allegations that Petitioner makes in the Amended Petition and the Motion about the parties' marks, services, and customers and about instances of actual confusion, nor on any other factor that is pertinent to a determination of likelihood of confusion. Such a determination depends upon a myriad of facts, none of which Registrant has had the opportunity to explore through discovery. A few examples of the discovery to which Registrant is entitled concerning Petitioner's claim of likelihood of confusion make plain that the Motion is, at the very least, premature.

3. In paragraph 3.2 of the Amended Petition, it appears that Petitioner assumes that she knows how Registrant offers her services because Petitioner concludes that Petitioner and Registrant offer their services in a similar manner. Since there is no evidence in the record about how Petitioner offers her services, however, it is impossible for Registrant to test Petitioner's conclusion. Accordingly, Registrant is entitled to obtain specific information on this issue, which is relevant in an inquiry into likelihood of confusion.

4. Petitioner alleges in paragraph 3.1 of the Amended Petition that there have been instances when potential franchisees and customers have contacted Registrant's company when they intended to contact Petitioner's company, but provides no specific information about these contacts. We do not know who these potential franchisees and customers were, and with whom they made contact at Petitioner's company. Neither do we know when these alleged contacts occurred, how often they occurred, or by what method they occurred. Registrant is entitled to take discovery to learn the events on which Petitioner relies for this allegation, as such events would be relevant to the determination of likelihood of confusion.

5. Petitioner further claims in the Motion that her potential customers and Registrant's are "virtually identical." While Petitioner assumes that she knows who Registrant's potential customers are, Registrant has no information at all about Petitioner's customers. Accordingly, Registrant is entitled to take discovery to learn the factual basis for Petitioner's claim because the identity of the customers for the parties' services is a relevant factual consideration in determining likelihood of confusion.

6. The commercial impression of the parties' marks is relevant to a determination of likelihood of confusion, but there has been no discovery on this issue. Nevertheless, Petitioner apparently assumes that she has sufficient information to know how Registrant uses her mark. In paragraph 5.1 of the Amended Petition, Petitioner alleges that when Registrant displays her mark, only the words "computers and mom are prominent" and asserts that the materials in Exhibit D to the Amended Petition support this proposition. Exhibit D-1 is merely a printout from the Trademark Electronic Search System of the Web site of the United States Patent and Trademark Office and is not an

example of how Registrant actually uses her mark in commerce. The depiction of Registrant's mark in Exhibit D-2 proves just the opposite of Petitioner's allegation. The element of Registrant's mark that is most prominently featured in Exhibit D-2 is the design of a woman holding a computer, and although the words "computers" and "mom" are written in larger type than Registrant's slogan ("computer skills, confidence, and really good coffee"), the slogan is italicized and is by no means buried in miniscule type as Petitioner asserts.

7. Petitioner also intimates that the circumstances surrounding Registrant's Motion to Set Aside Default may entitle Petitioner to summary judgment. As shown in the Motion Pursuant To Rule 56(f), this claim fails on its face to comply with the requirements of Rule 56(c) of the Federal Rules of Civil Procedure. In the event, however, that the Board intends to consider whether Petitioner is entitled to summary judgment on this claim, Registrant is likewise entitled to take discovery concerning these allegations.

8. Based on the above, Registrant respectfully requests that, in the event that the Board does not simply deny Petitioner's Motion on the ground that it was not made

and supported as the Federal Rules of Civil Procedure require, the Board deny the Motion as premature and permit Registrant to take the discovery necessary to ascertain the facts of this case in order to determine whether facts material to Petitioner's claims are genuinely disputed.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed: May 22, 2003  
Washington, D.C.

  
Rita M. Carrier