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Carol Zumbach
 Signature

**UNITED STATES PATENT AND TRADEMARK OFFICE
 TRADEMARK TRIAL AND APPEAL BOARD**

Registration No.: 2,666,400
Mark: K 326
Registered: December 24, 2002

**CROSS CREEK SEED, INC., and
 COATING SUPPLY, INC.,**

Petitioners,

v.

F.W. RICKARD SEEDS, INC.,

Registrant.



06-16-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

Cancellation No. 92041792

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 TRADEMARK TRIAL AND APPEAL BOARD

**CONDITIONAL REQUEST FOR A RULE 56(f) CONTINUANCE TO TAKE
 DISCOVERY NEEDED TO RESPOND TO PETITIONERS'
 PRE-DISCOVERY MOTION FOR SUMMARY JUDGMENT**

Pursuant to FED. R. Civ. P. 56(f), 37 C.F.R. § 2.116, and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 101.02 and 528.06, Registrant F.W. Rickard Seeds, Inc. ("Registrant") hereby conditionally requests a continuance in order to take discovery needed to respond to Petitioners' pre-discovery motion for summary judgment. In support, Registrant states as follows:

1. Petitioner Cross Creek Seed, Inc., initiated this cancellation proceeding on January 22, 2003, seeking to cancel Registrant's United States Trademark Registration No. 2,666,400 ("the '400 Registration") for the mark K 326.

2. On May 5, 2003, Registrant timely answered the petition and simultaneously moved to suspend this proceeding in light of earlier-filed litigation involving Petitioner Cross Creek and Registrant in the United States District Court for the Middle District of North Carolina, Civil Action No. 1:02CV01004, concerning, among other things, the trademark that is the subject of the '400 Registration (the "U.S. District Court litigation"). As set forth in Registrant's Motion to Suspend and its related Reply Brief, the parties do not dispute that this proceeding and the U.S. District Court litigation involve identical issues—whether there are registrable trademark rights in K326, or whether the Plant Variety Protection Act completely precludes such rights. Moreover, cancellation of Registrant's '400 Registration is demanded in both this proceeding and in the earlier-filed U.S. District Court litigation.

3. Only twenty days after Registrant answered and filed its motion to suspend this proceeding—and before any discovery had taken place—Petitioners moved for summary judgment of cancellation.

4. Registrant, in its *Reply in Further Support of Registrant's Motion to Suspend Proceedings Pending Outcome of Federal Court Litigation*, has requested that the Board not consider Petitioners' pre-discovery motion for summary judgment before ruling on Registrant's earlier-filed motion to suspend. If the Board, however, despite the pendency of an earlier-filed motion to suspend, decides to address Petitioners' motion for summary judgment,¹ Registrant

¹ This is the "condition" to this "conditional" request.

will need to take discovery to respond to the motion for summary judgment, as this proceeding is in its infancy and no discovery has occurred.

5. When the summary judgment nonmovant requests discovery that “is reasonably directed to ‘facts essential to justify the party’s opposition,’ in the words of Rule 56(f), such discovery must be permitted or summary judgment refused.” *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 852 (Fed. Cir. 1992) (citation omitted).

6. In this case, to be entitled to summary judgment, Petitioners must demonstrate that there is no genuine dispute of material fact on two required elements: “(1) that [they have] standing; and (2) that there are valid grounds for canceling the registration.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir.2000). Facts supporting standing must be pleaded, then proved, or the merits of the petition to cancel cannot be heard. *See, e.g., Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 493 (Fed. Cir.1987).

7. Registrant has not only denied the substantive allegations in the Petition, but has also asserted in its Answer that the Petitioners lack the required element of standing. To have standing, each Petitioner must plead, and ultimately prove, that it is something more “than an intermeddler” who lacks the required personal interest in the outcome of the case beyond that of the general public. *See, e.g., Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029-30 (C.C.P.A. 1982).

8. Because Petitioners filed their summary judgment motion after Registrant moved to suspend (albeit still early in this proceeding), Registrant has had no opportunity to take any discovery against Petitioner Coating Supply, the only party to have submitted testimony in support of Petitioners’ motion for summary judgment. Registrant expects that discovery (including document requests, interrogatories, requests to admit, and depositions) will reveal,

among other relevant facts, that Coating Supply has no real interest in this proceeding beyond that of the general public. (See Decl. of James Strickland at ¶ 3.) (attached hereto).

9. If discovery reveals that Petitioners lack standing—an essential element of their claim for cancellation—then their motion for summary judgment must fail. See, e.g., *Cunningham*, 222 F.3d at 945; *Jewelers Vigilance Comm*, 823 F.2d at 493.

10. Similarly, Registrant will need discovery from both the Petitioners and from third-party seed and crop organizations such as the Association of Official Seed Certifying Agencies (“AOSCA”), the North Carolina Department of Agriculture and Consumer Services, and the North Carolina Crop Improvement Association, Inc., to develop facts that support Registrant’s unclean hands defense. (*Id.* ¶ 4.) Indeed, Registrant has already obtained a preliminary injunction against Petitioner Cross Creek on this very ground in the United States District Court for the Middle District of North Carolina in *F.W. Rickard Seeds, Inc., and Gold Leaf Seed Company v. Cross Creek Seed, Inc., Cross Creek Farms, Eddie Baker, and Bill Earley*, Civil Action No. 1:02CV1004. Discovery as to these third parties will also focus on facts bearing on the use of K 326 as a trademark, etc. (*Id.* ¶ 5.)

WHEREFORE, Registrant prays that the Board, in the event it decides to address Petitioners' summary judgment motion despite the pendency of Registrant's earlier-filed motion to suspend, grant a continuance of ninety (90) days from the date of the Board's ruling hereon for Registrant to engage in discovery necessary for Registrant to respond to Petitioners' summary judgment motion.

Respectfully submitted,

Dated: June 13, 2003



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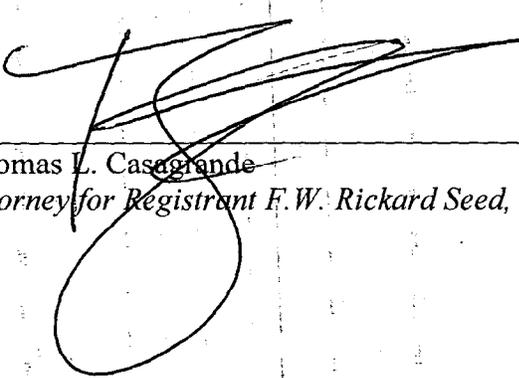
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*Attorneys for Registrant F.W. Rickard Seed,
Inc.*

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **CONDITIONAL REQUEST FOR A RULE 56(f) CONTINUANCE TO TAKE DISCOVERY NEEDED TO RESPOND TO PETITIONERS' PRE-DISCOVERY MOTION FOR SUMMARY JUDGMENT** has been served on June 13, 2003 by first class mail, postage prepaid, on:

Kenneth S. Kaufman, Esq.
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Attorney for Registrant F.W. Rickard Seed, Inc.

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Registration No.: 2,666,400
Mark X 326
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**CROSS CREEK SEED, INC., and
COATING SUPPLY, INC.,**

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v.

F.W. RICKARD SEEDS, INC.,

Registrant.

CANCELLATION NO. 92041792

DECLARATION OF JAMES STRICKLAND

I, JAMES STRICKLAND, pursuant to 28 U.S.C. § 1746, hereby declare as follows:

1. I am the Executive Vice President of Registrant F.W. Rickard Seeds, Inc. I am over 18 years of age and believe in the obligations of an oath.
2. I submit this Declaration in support of Registrant's "Conditional Request For A Rule 56(f) Continuance To Take Discovery Needed To Respond To Petitioners' Pre-Discovery Motion For Summary Judgment" in this proceeding. The statements in this declaration are based upon my own personal knowledge and experience in the tobacco seed business, or on information supplied to me by officers of, or persons employed or retained by, Registrant, who are knowledgeable in the premises.
3. I am unaware of, and do not believe that there exists, any evidence that Petitioner Coating Supply, Inc. has any direct or indirect commercial interest that will be affected by any

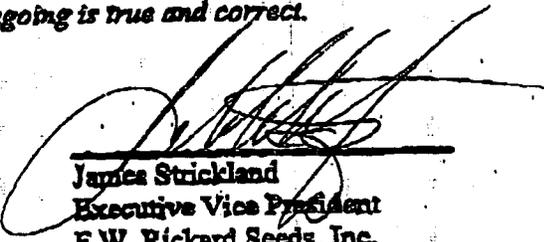
decision as to whether or not Registrant keeps its registration for the mark K 326. I therefore expect that discovery will bear out my belief on this point.

4. I also believe that discovery will show that one or both of the Petitioners have unclean hands due to false representations made in connection with their sales of alleged K 326 tobacco seed, thereby disqualifying them from seeking relief in this proceeding. Indeed, Registrant has already obtained a preliminary injunction against Petitioner Cross Creek on this very ground in the United States District Court for the Middle District of North Carolina in *F.W. Rickard Seeds, Inc., and Gold Leaf Seed Company v. Cross Creek Seed, Inc., Cross Creek Farms, Eddie Baker, and Bill Earley*, Civil Action No. 1:02CV1004.

5. I also believe that discovery of third-parties such as the Association of Official Seed Certifying Agencies ("AOSCA"), the North Carolina Department of Agriculture and Consumer Services, and the North Carolina Crop Improvement Association, Inc. will reveal additional facts that support Registrant's unclean hands defense, as well as bear on the issue of the use of K 326 as a trademark.

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

DATED: June 13, 2003.


James Strickland
Executive Vice President
F.W. Rickard Seeds, Inc.