

TTHB



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U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

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

-----X  
HCA-HealthONE LLC :  
: Petitioner, :  
: v. :  
Winifred Masterson Burke :  
Rehabilitation Hospital, Inc. :  
: Respondent. :  
-----X

Reg. No. 2,102,922

Mark: RENEWING HOPE, REBUILDING LIVES,  
RESTORING INDEPENDENCE

Cancellation No. 92/042,004

2003 DEC 05 10:20  
U.S. PATENT & TRADEMARK OFFICE  
WASHINGTON, DC 20503

RESPONDENT'S BRIEF IN OPPOSITION TO  
PETITIONER'S MOTION UNDER F.R.C.P. RULE 56(f)

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December 4, 2003

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## INTRODUCTION

Respondent Winifred Masterson Burke Rehabilitation Hospital, Inc. (“Burke”) hereby opposes the present motion of petitioner HCA-HealthOne LLC (“HCA”) pursuant to F.R.C.P. 56(f), in view of the following.

## FACTUAL BACKGROUND

The present motion is captioned by HCA as a “Motion to Require Respondent to Respond to Discovery”. HCA identifies only by number certain discovery requests previously served on Burke, and to which responses were not yet provided in view of Burke’s pending motion for summary judgment. HCA now seeks to compel Burke to respond to the discovery requests, maintaining that it needs the responses in order for it to respond fully to the motion for summary judgment.

## ARGUMENT

### I. HCA’s Present Motion Does Not Comply with Trademark Rule 2.120(e)(1)

Trademark Rule 2.120(e)(1) states, in pertinent part, that a motion to compel responses

“shall include . . . a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and

a list and brief description of the documents or things that were not produced for inspection and copying.”

The required copies were not annexed to HCA's present motion to compel, thus depriving the Board of an opportunity to consider the relevance of the discovery requests in light of the pending summary judgment motion. “[W]hen a party moves for an order compelling discovery, such party *must* always submit together with its motion a copy both of the request for discovery in question and of the answers and/or objections thereto so that the Board may be able to rule expeditiously and effectively on the merits of the motion.” *Amerace Corp. v. USM Corp.*, 183 U.S.P.Q. 506 (T.T.A.B. 1974)(emphasis added). See also, *Fidelity Prescriptions v. Medicine Chest Discount Centers*, 191 U.S.P.Q. 127 (T.T.A.B. 1976):

“In order to enable the Board to render a meaningful decision on the motion, a copy of the interrogatories in question and of the objections thereto should accompany the motion.” 191 U.S.P.Q. at 128.

Accordingly, HCA's present motion should properly be denied.

## II. HCA Should Not Be Allowed Discovery Under F.R.C.P. 56(f) on Matters Not Pleaded By the Present Petition

HCA's motion at the top of page 3 alleges that responses to the outstanding discovery requests are “necessary in order to allow it to fully respond to the Motion for Summary Judgment and determine if any *additional* bases for cancellation

exist." (emphasis added). Further, at the middle of page 4, HCA argues that the responses are necessary to determine whether Burke's registered mark was "abandoned", and to "establish whether any *other* ground exists which would undermine the validity of the registration of [Burke's] mark." (emphasis added). Finally, without citing any authority, HCA suggests that the responses may show that Burke is "estopped" from asserting the five-year time limit against HCA. See the paragraph spanning pages 4-5.

The potential issues now raised by HCA such as abandonment and estoppel were not pleaded in its petition and, thus, are matters it should not be allowed to explore by discovery under F.R.C.P. 56(f). Other than to assert that the information it now seeks is exclusively in Burke's possession, HCA has not proffered any evidence beyond its own speculation in support of its present motion for discovery. As stated by the Federal Circuit in *Keebler v. Murray Bakery Products*, 9 U.S.P.Q.2d 1736 (1989);

[i]f all one had to do to obtain a grant of a Rule 56(f) motion were to allege possession by movant of 'certain information' and 'other evidence', every summary judgment decision would have to be delayed while the non-movant goes fishing in the movant's files. . . . Summary judgment need not be denied merely to satisfy a litigant's speculative hope of finding some evidence . . . that might tend to support a complaint." 9 U.S.P.Q.2d at 1739.

### CONCLUSION

In view of all the foregoing, HCA's present motion for discovery pursuant to F.R.C.P. 56(f) should be denied.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Leo Zucker", written over a horizontal line.

Leo Zucker, Attorney for Respondent  
Winifred Masterson Burke  
Rehabilitation Hospital, Inc.

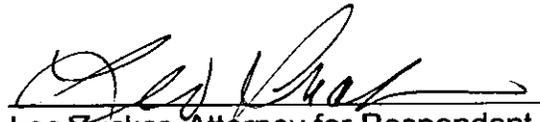
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December 4, 2003

CERTIFICATE OF SERVICE

I hereby certify that the within Respondent's Brief in Opposition to Petitioner's Motion under F.R.C.P. Rule 56(f), was served upon Petitioner on December 4, 2003, by mailing a true copy thereof by first class mail, postage prepaid, and addressed to Julie Ann Gregory, Middleton Reutlinger, Attorneys for Petitioner, 2500 Brown & Williamson Tower, Louisville, KY 40202-3410.

  
Leo Zucker, Attorney for Respondent  
Winifred Masterson Burke  
Rehabilitation Hospital, Inc.

December 4, 2003