

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Mailed: June 19, 2006

Cancellation No. 92043516

JZCHAK N. WAJCMAN d/b/a BILL  
LAWRENCE PRODUCTS

v.

WILLI LORENZ STICH

**Thomas W. Wellington,  
Interlocutory Attorney:**

This proceeding now come up on the following motions:  
(1) respondent's motion (filed June 17, 2005) for summary judgment; (2) petitioner's concurrently filed motions (filed July 15, 2005) (a) for further discovery under Fed. R. Civ. P. 56(f), (b) to compel respondent to produce substantive discovery responses to petitioner's interrogatories and to petitioner's document requests, and (c) to determine the sufficiency of respondent's responses to petitioner's requests for admissions; (3) respondent's motion (filed August 15, 2005) "for a protective order from further discovery"; (4) respondent's motion (filed August 8, 2005) to make a specific negative averment under Fed. R. Civ. P.

9(a) regarding petitioner's entity status; and (5) petitioner's second group of motions (filed August 31, 2005) to compel responses to petitioner's second sets of interrogatories and requests for production of documents and to deem its requests for admissions as admitted.<sup>1</sup>

The Board also recently convened a telephone conference between Jay Kopelowitz, Esq., counsel for petitioner, and Greg Richardson, Esq., counsel for respondent, and the above-referenced Board attorney responsible for resolving interlocutory matters in this case. The purpose of the telephone conference was to clarify the issues currently before the Board in order to expedite this proceeding.

Initially, we note that during the telephone conference, counsel for respondent stated that a petition to the Director (filed June 13, 2005) is now moot and said petition would be withdrawn in due course. Accordingly, this proceeding will go forward regardless of the petition.

We turn first to respondent's motion filed under Fed. R. Civ. P. 9(a) captioned as a motion for a "specific negative averment," and respondent's motion "for a protective order from further discovery." Essentially, respondent argues by way of these motions that he is unable to verify petitioner's capacity to file the petition to cancel under a "d/b/a" or "dba" designation and that

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<sup>1</sup> Respondent's motion (filed July 27, 2005) for a more definite

respondent should not be forced to provide potentially confidential information to "an unknown or legal non-entity." Petitioner has opposed these motions because the Rule 9(a) motion was not timely filed inasmuch as it was not filed prior to or concurrently with respondent's answer; the motion for a protective order is not supported by a good faith attempt to resolve any differences prior to filing the motion; the petition to cancel clearly identifies petitioner as an "individual", thus a known legal entity; and that motion for a protective order is not otherwise supported by a showing of good cause.

The Board initially notes that the petition to cancel clearly identifies petitioner as "Jzchak N. Wajcman d/b/a Bill Lawrence Products and Bill Lawrence Pickups,...an individual having a business address..." Thus, it clear that petitioner is one entity, an individual who may or may not be doing business under a different name. The addition of a "doing business as" or "d/b/a" is meaningless in this cancellation proceeding to the extent that such self-described titles do not create a separate legal entities nor do they negate the entity status of petitioner, an individual, Mr. Wajcman. Respondent's concern that any information provided by respondent may be shared with an unknown entity is obviated by the condition that there is

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statement was subsequently withdrawn by respondent on August 8, 2005.

only one petitioner. Moreover, should petitioner seek to show use of his mark(s) under a different name, such as his alleged d/b/a, any such use on petitioner's behalf must be proven at trial.

In view thereof, Respondent's Rule 9(a) motion and motion for a protective order from further discovery is denied.

We now turn to petitioner's Rule 56(f) motion. The Board presumes familiarity with the issues presented via petitioner's Rule 56(f) motion and does not provide a complete recitation of the allegations and contentions of each party.

Generally, a motion for discovery under Rule 56(f), unless dilatory or lacking in merit, will be treated liberally by the Board. See James W. Moore, Moore's Federal Procedure, § 56.24 (1985). If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion, discovery will be permitted. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). This is especially true if the information sought is largely within the control of the party moving for summary judgment. See *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989).

However, when a request for discovery under FRCP 56(f) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, requests for discovery outstanding, and those requests remain unanswered. 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).

Respondent's summary judgment motion raises issues of whether petitioner properly acquired any prior use of the mark BILL LAWRENCE, whether any such prior rights in the mark BILL LAWRENCE were abandoned by petitioner or his predecessor in interest, and whether respondent fraudulently obtained his registration. While pursuant to Rule 56(f) the only discovery which may now be permitted is that specifically directed to these issues raised by the motion for summary judgment, we find that petitioner seeks responses to all of his discovery requests (previously served), namely, petitioner's first and second sets of discovery. In his declaration in support of petitioner's Rule 56(f) motion, petitioner's counsel states that petitioner is "unable [without the aforementioned discovery]

to present affidavit facts sufficient to show the existence of a genuine issue of material fact" and goes on to identify certain discovery requests but states that these are "by way of example, but not limitation." [Kopelowitz Dec. p. 2]

Because petitioner has not properly presented how all of his discovery requests are directed to the aforementioned issues raised by the motion for summary judgment, we find that petitioner has not made a sufficient showing of a need to all such discovery from respondent. Accordingly, petitioner's Rule 56(f) motion is denied, in part, to the extent that it seeks new and/or complete responses to all discovery previously served on respondent, including his second sets of discovery.

Petitioner has, however, made a sufficient showing that he is entitled to responses to the discovery requests identified in Mr. Kopelowitz's declaration. Accordingly, petitioner's motion for 56(f) discovery is hereby granted, in part, to the extent that respondent is allowed **THIRTY (30) DAYS** from the mailing date of this order in which to serve its responses to the following discovery requests identified in petitioner's Rule 56(f) motion:

- petitioner's first set of requests for admissions nos. 12, 31, 33, 34, 37, 38, 39, and 42;
- petitioner's first set of interrogatories nos. 4, 5, 8, 9, 11 13, and 14;

- petitioner's first set of requests for the production of documents nos. 4, 9, and 17.

To the extent that respondent has already served responses to these discovery requests, it is hereby ordered to serve renewed responses in view of the Board's decision above regarding petitioner's entity status and the standard protective agreement imposed herein (see below).

Petitioner is allowed until **SIXTY (60) DAYS** from the mailing date on this order to file a response to respondent's motion for summary judgment.

Petitioner's two sets of motions to compel responses to petitioner's sets of interrogatories and requests for production of documents and to deem its requests for admissions as admitted are denied without prejudice inasmuch as they were filed after the summary judgment motion. However, should a discovery dispute arise regarding the Rule 56(f) discovery and the parties are unable to resolve the dispute after making good faith efforts to do, the Board will entertain a timely filed motion to compel any such discovery.

Board's Standard Protective Agreement Imposed

The Board's standard protective order is now in force. The protective order may be found in the Appendix of Forms of the TBMP (2d ed. rev. 2004) and on the USPTO website at

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www.uspto.gov. Of course, upon stipulation, the parties may amend the terms of this order to suit their needs.

The parties are referred, as appropriate, to TBMP §§ 412.03, 412.04, and 412.05 (2d ed. rev. 2004) (concerning, respectively, Signature of Protective Order, Filing Confidential Materials With Board, and Handling of Confidential Materials by Board). The parties are also advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Except to the extent indicated above, proceedings remain **SUSPENDED**. See Trademark Rule 2.127.

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