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

Proceeding	92050789
Party	Defendant Hewlett-Packard Development Company, L.P.
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Dated: November 24, 2009

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

NARTRON CORPORATION, Petitioner, v. HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P., Respondent.	Cancellation No. 92050789 Registration No. 3,600,880 Registration Date: April 7, 2009 Mark: **TOUCHSMART** RESPONDENT HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P.'S OPPOSITION TO PETITIONER'S MOTION UNDER RULE 56(f) FOR DISCOVERY

INTRODUCTION

Respondent Hewlett-Packard Development Company, L.P. ("HP") filed a motion for summary judgment on the ground that there is no likelihood of confusion between its registered mark TOUCHSMART and Petitioner Nartron Corporation's ("Nartron") registered mark SMART TOUCH. In opposition to the summary judgment motion, Nartron filed a brief ("Opp."), an affidavit from its counsel (attaching three exhibits) and a declaration from its Senior Vice President of Engineering (attaching eleven exhibits). In its opposition brief, Nartron stated that the motion "should be denied on the evidence of record." While HP disagrees with Nartron's interpretation of the registrations and the record, HP agrees that the Board can and should decide the motion for summary judgment on the basis of the record presented by the parties. The parties' respective registrations are dispositive of the issues presented by the motion for summary judgment and there is no need for discovery. In any event, Nartron's summary judgment opposition demonstrates that it does not need discovery to oppose the motion. *See* Section I, *infra*.

Putting aside the fact that Nartron has demonstrated its ability to put forth an opposition to the motion for summary judgment, Nartron's motion under Rule 56(f) also fails because Nartron has not provided the Board with the *reasons* why it believes the discovery it seeks is essential to its opposition. *See* Section II., *infra*.

For each of these reasons, Nartron's Rule 56(f) motion should be denied.

ARGUMENT

I.

NARTRON'S OPPOSITION MAKES CLEAR THAT NO DISCOVERY IS NECESSARY FOR IT TO OPPOSE HP'S MOTION FOR SUMMARY JUDGMENT.

HP has moved for summary judgment solely on grounds that require no additional discovery. Nartron has alleged that the marks and goods described in the parties' respective registrations are closely related and likely to cause confusion among consumers. The

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registrations, together with facts of which the Board may take notice, are sufficient to demonstrate that the marks at issue are dissimilar, and that the claimed goods are substantially different, would typically travel in different channels of trade, and would typically be purchased with a high degree of care. The Board may grant summary judgment if it finds that these factors are dispositive. *See Kellogg Co. v. Pack'Em Enters., Inc.*, 951 F.2d 330, 332-33, 21 U.S.P.Q.2d 1142, 1144-45 (Fed. Cir. 1991) (single *DuPont* factor of dissimilarity of marks outweighed all others such that the other factors, even if decided in nonmovant's favor, would not be material because they would not change the result). In other words, even if the Board were to find that other factors were relevant, the factors analyzed in HP's motion would still mandate summary judgment in favor of HP.

In opposition to the motion for summary judgment, Nartron states that its opposition "demonstrates there are genuine issues of material fact precluding summary judgment on all *DuPont* factors raised on HP's motion," and that the Board should deny the motion "on the evidence of record." Opp. at 1. Thus, on its face, Nartron's brief demonstrates that Nartron is able to respond to HP's summary judgment motion. For this reason alone, the Board should deny Nartron's motion under Rule 56(f). *See Dyneer Corp. v. Automotive Prods., PLC*, 37 U.S.P.Q.2d 1251, 1253 (T.T.A.B. 1995) (denying Rule 56(f) motion where the movant demonstrated its ability to respond to the summary judgment motion without additional discovery).

II.

NARTRON'S MOTION AND SUPPORTING DECLARATION FAIL TO MEET THE STANDARD REQUIRED BY RULE 56(f).

Invocation of Rule 56(f) does not automatically avoid summary judgment. Its application is limited to circumstances where the moving party has demonstrated both the necessity and materiality of further discovery. Nartron bears the burden to "proffer sufficient facts to show that the evidence sought exists, and that it would prevent summary judgment." *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1161 n.6, 58 U.S.P.Q.2d 1222, 1229 n.6 (9th Cir. 2001). In order to meet this burden, Nartron must come forward with

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evidence (in the form of declarations or affidavits) stating the *reasons* why it cannot present facts essential to justify its opposition. *See Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1389, 9 U.S.P.Q.2d 1736, 1739 (Fed. Cir. 1989).

The cases cited by Nartron confirm that Rule 56(f) motions should be granted only where the requested discovery is *essential* to oppose summary judgment. *See, e.g., Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 n.5 (1986) (noting without deciding the issue that Rule 56(f) provides a safeguard where the nonmoving party has not had "the opportunity to discover information that is essential to his opposition"); *Metabolife Int'l, Inc. v. Wornick*, 264 F.3d 832, 846 (9th Cir. 2001) (same) (quoting *Anderson*, 477 U.S. at 250 n.5); *Program Eng'g, Inc. v. Triangle Publ'ns, Inc.*, 634 F.2d 1188, 1193 (9th Cir. 1981) (discovery should be allowed before the trial court rules on a motion for summary judgment where "the evidence is crucial to material issues in the case"). In particular, the notion that continuances pursuant to Rule 56(f) should be granted "almost as a matter of course" is qualified by the strict requirement that the party seeking discovery "demonstrat[e] to the trial court specifically how the requested discovery pertains to the pending motion." *See Wichita Falls Office Assocs. v. Banc One Corp.*, 978 F.2d 915, 919 (5th Cir. 1993).

Here, Nartron has failed to meet its burden under Rule 56(f). The declaration from Nartron's counsel states that Nartron seeks "additional discovery of HP on matters targeting the *DuPont* factors, including a Rule 30(b)(6) deposition of Respondent HP on such factors [and] . . . a discovery deposition of Jean Newman, Marcom Programs Manager II, identified by HP in its Initial Disclosures as a person likely to have discoverable information on the claims and defenses in this proceeding." Declaration of Robert C.J. Tuttle Pursuant to Fed. R. Civ. P. 56(f) ¶¶6-7. The declaration then states that this discovery is "needed to present facts essential to Narton's opposition." This conclusory statement is insufficient. Nowhere does the declaration state reasons *why* Nartron allegedly cannot oppose HP's motion absent the requested discovery. As stated by the Federal Circuit in *Keebler*, Rule 56(f) requires the declarant to "*state reasons*" why discovery is essential for opposition. 866 F.2d at 1389, 9 U.S.P.Q.2d at 1739. Indeed, "[i]f all one had to do to obtain a grant of a Rule 56(f) motion

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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." *Id.*

To prevail under Rule 56(f), Nartron must do more than designate certain depositions and broad legal issues. Notably absent from Nartron's motion is any explanation of "what other specific evidence [Nartron] hopes to discover or the relevance of that evidence to its claims." *See Program Eng'g*, 634 F.2d at 1194. Also absent is any showing of "how the requested discovery pertains to the pending motion" (*Wichita Falls*, 978 F.2d at 919), or how such discovery "would prevent summary judgment" (*Chance*, 242 F.3d at 1161 n.6, 58 U.S.P.Q.2d at 1229 n.6). These inquiries are particularly important, where, as here, the registration statements alone are dispositive. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1359, 56 U.S.P.Q.2d 1351, 1355-56 (Fed. Cir. 2000). In sum, Nartron has failed to meet its burden under Rule 56(f) to identify the specific discovery it seeks and the reasons why that discovery is essential to its opposition.

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CONCLUSION

For the foregoing reasons, the Board should deny Nartron's motion under Rule 56(f) for discovery.

DATED: November 24, 2009.

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By: _____
JEFFREY E. FAUCETTE

Attorneys for Respondent HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P.

PROOF OF SERVICE BY MAIL

The undersigned declares and says as follows: my business address is Three Embarcadero Center, Seventh Floor, San Francisco, CA 94111-4024. I am employed in the City and County of San Francisco; I am over the age of 18 years, and I am not a party to this cause. I am readily familiar with this business' practices for collection and processing of correspondence for mailing with the United States Postal Services. On the same day that a sealed envelope is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service with postage fully prepaid.

Date of Deposit and eFiling with the TTAB: November 24, 2009

I served the within **Respondent Hewlett-Packard Development Company, L.P.'s Opposition To Petitioner's Motion Under Rule 56(f) for Discovery** on Petitioner and counsel for Petitioner at the following address:

Robert C.J. Tuttle
Hope V. Shovein
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075

by placing a true copy thereof, enclosed in a sealed envelope with postage thereon fully prepaid, for deposit in the United States mail for collection and mailing on this day following ordinary business practices of Howard, Rice, Nemerovski, Canady, Falk & Rabkin.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this Declaration is executed in San Francisco, California, this 24th day of November, 2009.

By: Georgie M. Price
Georgie M. Price

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