

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

DUNN

Mailed: December 4, 2009

Cancellation No. 92050789

Nartron Corporation

v.

Hewlett-Packard Development
Company, L.P.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on the following contested matters:

- I. respondent's motion to suspend proceedings, filed September 30, 2009;
- II. petitioner's motion to compel, filed October 20, 2009; and
- III. petitioner's motion for discovery under Fed. R. Civ. P. 56(f), filed November 4, 2009.

As background, the Board notes that on September 30, 2009, respondent filed a motion for summary judgment on the pleaded issue of likelihood of confusion between its registered mark TOUCHSMART for "personal computers, computer hardware, computer monitors, computer display screens" and

petitioner Nartron Corporation's registered mark SMART TOUCH for "electronic proximity sensors and switching devices."

Trademark Rule 2.127(d) states:

When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

Accordingly, because the Board was obliged to suspend this proceeding, and in fact did so suspend on November 9, 2009, respondent's motion to suspend was unnecessary, and is denied as moot.

While petitioner is correct that the filing of a potentially dispositive motion, such as the motion for summary judgment here, does not automatically suspend a case, because the parties are presumed to know that the filing of such a motion will result in a suspension order, the filing itself generally will provide parties with good cause to cease or defer activities unrelated to the briefing of such motion. Thus, although proceedings had not been officially suspended by the Board at the time respondent's discovery responses were due, the Board, in this instance, will consider proceedings suspended retroactive to the date of filing of respondent's motion for summary judgment. If

this proceeding goes forward following the Board's disposition of respondent's motion for summary judgment, respondent's time for serving responses to outstanding discovery requests will be reset. Accordingly, petitioner's motion to compel discovery responses is denied as premature.

On November 4, 2009, petitioner filed both a motion for discovery under Fed. R. Civ. P. 56(f), and a substantive response to respondent's motion for summary judgment. A party able to fashion a response to a motion for summary judgment does not need discovery to be able to respond to the motion. See *Dyneer Corporation v. Automotive Products, PLC.*, 37 USPQ2d 1251 (TTAB 1995); *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 USPQ2d 1381 (TTAB 2005); *Ron Cauldwell Jewelry, Inc. v. Clothesline Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002). Inasmuch as petitioner has submitted a substantive response to the motion for summary judgment, petitioner's request for discovery pursuant to Fed. R. Civ. P. 56(f) is denied.

The Board notes that the motion for summary judgment is now fully briefed, and will be forwarded to the panel for decision.

Proceedings herein remain suspended pending the Board's disposition of respondent's motion for summary judgment.
