

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

MBA

Mailed: May 20, 2011

Cancellation No. 92052150

Wonderbread 5

v.

Patrick Gilles

**Michael B. Adlin, Interlocutory Attorney:**

On July 30, 2010, petitioner filed a putative "motion for judgment on the pleadings," or alternatively for summary judgment, on its claims of priority and likelihood of confusion and fraud. This case now comes up for consideration of respondent's cross-motion under Fed. R. Civ. P. 56(d), filed September 2, 2010, for discovery which respondent claims is necessary in order to respond to petitioner's motion for summary judgment.<sup>1</sup> Respondent's cross-motion is fully briefed.

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<sup>1</sup> While captioned as a motion for judgment on the pleadings, or, alternatively, for summary judgment, petitioner's motion relies on matters outside the pleadings, including materials from the parties' prior litigation. Accordingly, as the parties appear to recognize in briefing the cross-motion, petitioner's motion will be treated as a motion for summary judgment. TBMP § 504.03 (3d ed. rev. 2011). Indeed, respondent has denied the salient allegations in the petition for cancellation, which would preclude judgment on the pleadings. TBMP § 504.02. The delay in acting on the motion is regretted.

Background

Respondent owns a registration of the mark WONDERBREAD 5, in standard characters, for "Entertainment services in the nature of live musical performances" (the "Registration").<sup>2</sup> Petitioner seeks to cancel the Registration, alleging prior use of an identical mark for identical services and that use of respondent's mark is likely to cause confusion with petitioner's mark, and fraud. With respect to its fraud claim, petitioner specifically alleges that: (1) respondent "is a former member" of petitioner, the musical group Wonderbread 5; (2) in settling prior litigation between the parties, respondent "released ... all claims in and to the Band;" (3) respondent nevertheless claimed ownership of the mark WONDERBREAD 5 in applying for the Registration, even though he "clearly knew that the term 'WONDERBREAD 5' had previously been used, and was continuing to be used, by the Band;" (4) respondent "misrepresented his rights to the Mark at the time he submitted his Application;" and (5) respondent made false statements to the Office "with the intent to induce authorized agents of the USPTO to grant" the Registration. In his answer, respondent denies the salient allegations in the petition for cancellation.

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<sup>2</sup> Registration No. 3691948, issued October 6, 2009 from an application filed March 12, 2009, based on dates of first use of October 31, 1996.

Petitioner's Motion for Summary Judgment and Respondent's Cross-Motion

Petitioner's motion is based primarily on information and documents from the parties' prior litigation, in which, according to petitioner, respondent admitted that the mark WONDERBREAD 5 "was coined by another Band member, not by" respondent, and that "the Band began using the WONDERBREAD 5 mark in commerce in November 1996." Petitioner further alleges that respondent was fired from the band in March 2009 and told that the band "shall continue to perform and conduct business under the name 'Wonderbread 5.'" According to petitioner, the parties' prior litigation settled, "following the Band's payment" of "compensation" to respondent, as a result of which respondent now "has no rights in the Band or its trademark." Based on the allegations and "evidence" from the parties' prior litigation, petitioner argues in support of its claim of priority and likelihood of confusion that respondent's use of the mark in the Registration, if any, prior to his termination from the band inured to petitioner's benefit, that petitioner therefore has priority of use and that the parties' marks are confusingly similar because they create identical overall commercial impressions and are used for the same services. Petitioner argues in support of its fraud claim that respondent falsely declared in support of

his application which matured into the Registration that no other party had the right to use WONDERBREAD 5.<sup>3</sup>

In his cross-motion, which is supported by the Declaration of Matthew H. Swyers, his counsel, respondent argues that petitioner should be required to respond to certain of respondent's previously-served written discovery requests, before respondent is required to substantively respond to petitioner's motion for summary judgment. As a general matter, respondent contends that he is entitled to discovery regarding "[p]etitioner's alleged rights in the mark WONDERBREAD 5 as well as what, if any, rights of [respondent] were transferred to Petitioner" when the parties' settled their prior litigation. Respondent specifically seeks to establish that petitioner has no documentary evidence that respondent "transferred any intellectual property rights to Petitioner," and requests that petitioner be required to respond to respondent's Interrogatory Nos. 2, 3, 6, 8 and 10-20 and Document Request Nos. 1, 2, 6, 7 and 12-14. Respondent concedes, however,

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<sup>3</sup> Petitioner alleges that fraud occurs when a party makes a material misrepresentation which it "knows or should know" to be false, and that "[i]t is not necessary to have any type of intent to commit the fraud." Petitioner is incorrect, however, apparently because it relies on cases which are no longer good law. Petitioner should carefully review, among others, In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) and Asian and Western Classics B.V. v. Selkow, 92 USPQ2d 1478, 1479 (TTAB 2009), under which, among other things, "intent is a specific element of a fraud claim" and it is no longer enough to allege (or prove) that a party "knew or should have known" that a representation to the Office was false.

that he does not require discovery in order to respond to petitioner's motion for summary judgment on its fraud claim.

In its response to the cross-motion, petitioner argues that "[n]one of the discovery [respondent] seeks can raise a triable issue as to whether the Band's use of an identical mark predates any use by [respondent] individually, or as to whether the Band abandoned its use of the mark."

Furthermore, petitioner claims that respondent has the information he requires to respond to the motion for summary judgment, that any discovery which contradicts "admissions" respondent made in the prior litigation would be inadmissible or not credible and that much of the discovery respondent seeks is irrelevant to the motion for summary judgment. Petitioner specifically argues that "as a matter of law, upon a member's departure from the band, the band's name and trademark remain with the band and do not transfer to the leaving member."

In reply, respondent contends that "if the Band was formed as an LLC or Partnership specifically specifying rights upon dissolution of the Band and, in particular, what happens to the intellectual property rights of the Band when the same occurs such is highly relevant to the ownership of the mark at issue."

In order to establish that he is entitled to discovery under Fed. R. Civ. P. 56(d), respondent must show through

affidavit or declaration (in this case the affidavit of his counsel) "reasons why discovery is needed in order to support [his] opposition" to petitioner's motion for summary judgment. Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 852, 23 USPQ2d 1471, 1474 (Fed Cir. 1992) (citing Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989)). Respondent must do more than set forth a "speculative hope of finding some evidence" that would support his arguments, however. Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1566-67, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). Instead, respondent "should set forth with specificity the areas of inquiry needed" to respond to petitioner's motion for summary judgment. TBMP § 528.06 (2d ed. rev. 2004). "Unfocused requests" for discovery which lack specificity are not sufficient under Fed. R. Civ. P. 56(d). Keebler, 866 F.2d at 1390, 9 USPQ2d at 1739.

The rulings on respondent's cross-motion for discovery are as follows:

Interrogatory Nos. 2, 3 and 11

These interrogatories seek information about petitioner's selection and adoption of its pleaded mark, and its past, current and future use of the mark. While

petitioner is correct that information about its selection and adoption of its pleaded mark is not necessary for respondent to adequately respond to petitioner's motion for summary judgment, respondent is correct that information and documents related to petitioner's use of its mark is necessary if respondent is to adequately respond to the motion. Indeed, petitioner claims prior use of WONDERBREAD 5, but the only "evidence" supporting this claim comes from mere allegations, albeit allegations by respondent, in prior litigation that apparently did not specifically address trademark issues. Even if the Board were to ultimately accept petitioner's argument that respondent's allegations in his Complaint in the prior litigation should be admitted here, and that respondent should be estopped from contradicting or expounding on those allegations here, respondent's allegations in the Complaint in the prior litigation do not establish all facts necessary to full consideration of petitioner's motion for summary judgment. Indeed, respondent's limited allegations in his Complaint do not reveal, for example, precisely who owns the mark now or at the relevant time(s), whether petitioner's alleged use of the mark was pursuant to license or other agreement, whether petitioner's use was continuous, etc.<sup>4</sup> Accordingly,

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<sup>4</sup> In certain places in its motion for summary judgment, petitioner cites mere allegations in its petition as evidence, even where those allegations are without additional support.

respondent's cross-motion is **GRANTED** with respect to these interrogatories, to the extent they seek information about petitioner's past, current or future use (but not selection or adoption) of its mark. Petitioner is allowed until **THIRTY DAYS** from the mailing date of this order to respond to these requests to the extent set forth herein.

Interrogatory Nos. 6, 8

These interrogatories seek information concerning "the manner in which Petitioner's claimed Mark is promoted in the United States," but respondent fails to explain why such information is required in order to respond to petitioner's motion for summary judgment. Accordingly, respondent's cross-motion is **DENIED** with respect to these requests.

Interrogatory No. 10 and Document Request No. 6

These requests relate to proceedings or challenges related to petitioner's pleaded mark, as well as respondent's membership in petitioner's band and respondent's ownership interest in the involved mark, if any. Because this information relates to the validity and ownership of the mark at issue, and respondent's rights thereto, if any, respondent's cross-motion is **GRANTED** with respect to these requests, to which petitioner is ordered to

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However, respondent denies virtually all allegations in the petition, which are therefore, without more, not evidence which may be considered in support of petitioner's motion. See, TBMP § 704.06(a).

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serve responses within **THIRTY DAYS** of the mailing date of this order.

Interrogatory Nos. 12-14 and Document Request No. 12

Petitioner alleges that it is a "general partnership," that the band Wonderbread 5 is comprised of several members and that the band owns petitioner's pleaded mark.

Information about the general partnership, the band's membership and especially any documents related to how the general partnership is governed may therefore relate to petitioner's claim of ownership, the terms of the alleged ownership and respondent's rights, if any, in the involved mark. Accordingly, respondent's cross-motion is **GRANTED** with respect to these requests, to which petitioner is ordered to respond within **THIRTY DAYS** of the mailing date of this order.

Interrogatory No. 15 and Document Request Nos. 1, 2 and 13

As indicated in connection with Interrogatory No. 2, respondent does not require information related to the selection and adoption of petitioner's mark in order to respond to petitioner's motion, and therefore respondent's cross-motion is **DENIED** with respect to these requests.

Interrogatory Nos. 16, 19 and 20 and Document Request No. 14

While Interrogatory No. 16 addresses the selection and adoption of petitioner's mark, which is not necessary information, it also, along with Interrogatory Nos. 19 and

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20 and Document Request No. 14, addresses the ownership of petitioner's mark, and to that extent only, respondent's cross-motion is **GRANTED** and petitioner is allowed until **THIRTY DAYS** from the mailing date of this order to respond to these requests. However, petitioner may object and refuse to respond to Document Request No. 14 as overly broad and not reasonably calculated to lead to the discovery of admissible evidence, to the extent it goes beyond the ownership of petitioner's pleaded mark (as opposed to other intellectual property).

Interrogatory Nos. 17 and 18

As respondent was the plaintiff in the parties' prior litigation, he does not require discovery related thereto. Indeed, the relevant information is or should be in respondent's possession or control. Accordingly, respondent's motion is **DENIED** with respect to these requests.

Document Request No. 7

A copy of the letter at issue is attached as Exhibit C to the Declaration of David M. Given in Support of Petitioner's Motion. Accordingly, respondent's cross-motion is **DENIED** with respect to this document request.

Conclusion

Respondent's cross-motion for discovery under Fed. R. Civ. P. 56(d) is granted in part, to the extent set forth herein.

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Petitioner is allowed until **THIRTY DAYS** from the mailing date of this order to serve its responses to respondent's Interrogatory Nos. 2, 3, 10-14, 16, 19 and 20 and Document Request Nos. 6, 12 and 14, to the extent set forth herein. Respondent is allowed until **SIXTY DAYS** from the mailing date of this order to file his substantive opposition to petitioner's motion for summary judgment. Proceedings herein remain otherwise suspended pending disposition of petitioner's motion for summary judgment.

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