

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: September 29, 2015

Cancellation No. 92059866

Kini Kai, L.L.C.

v.

Taryn Rodighiero dba KaiKini

Benjamin U. Okeke, Interlocutory Attorney:

On May 1, 2015, Petitioner filed a motion for summary judgment on the grounds that: “(i) The KaiKini Mark is void *ab initio* as Registrant admits in responses to requests for admission that she has never used the KaiKini Mark in commerce on numerous goods identified in the Registration; and (ii) Petitioner has used its Kini Kai mark in commerce prior to Registrant’s date of first use and the KaiKini Mark and Petitioner’s Kini Kai mark will easily be confused.” 7 TTABVUE 3.

The Board, in its May 14, 2015 order, stayed the proceeding for consideration of Petitioner’s motion for summary judgment under Trademark Rule 2.127(d).

On May 29, 2015, in lieu of filing a response to the motion, Respondent filed a motion under Fed. R. Civ. P. 56(d) to stay consideration of Petitioner’s motion for summary judgment to allow Respondent an opportunity to conduct discovery prior to responding to the motion. Respondent requests specifically “that the Board allow

[Respondent] to take the deposition of Jennifer K. Meadors, who is one of the owners and managers of Petitioner.” 9 TTABVUE 2. Respondent asserts it “has the need to take the deposition of Ms. Meadors regarding (1) Petitioner’s alleged prior use of its KINI KAI mark, (2) the facts alleged in the Declaration of Ms. Meadors regarding Petitioner’s alleged prior use of its KINI KAI mark, and (3) the exhibits attached to Petitioner’s Motion for Summary Judgment purporting to demonstrate prior use of Petitioner’s KINI KAI mark,” and that “[w]ithout the requested discovery, [Respondent] will be unable to present facts sufficient to show the existence of a genuine issue of material fact for trial.” *Id.* at 3.

Petitioner contests Respondent’s motion, arguing that: (i) Respondent’s request made under Fed. R. Civ. P. 56(d) was untimely made; and (ii) Respondent has failed to sufficiently articulate a basis to allow for discovery prior to responding to Petitioner’s motion for summary judgment. The motion has been fully briefed.¹

Motion for Discovery to Respond to the Motion for Summary Judgment under Fed. R. Civ. P. 56(d)

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. *See* Fed. R. Civ. P. 56(d); TBMP § 528.06 (2015). The request must be supported by an affidavit showing that the non-moving party cannot, for reasons stated therein, present by affidavit facts essential to justify its opposition to the motion. In such affidavit, the party must state the reasons why it

¹ Respondent’s reply brief, filed June 14, 2015, is noted.

is unable, without discovery, to present by affidavit, facts sufficient to show the existence of a genuine issue of material fact for trial. *See* TBMP § 528.06.

Initially, it is important to note that Respondent's motion to stay consideration of Petitioner's motion for summary judgment and to allow Respondent to take discovery necessary to respond to the motion was timely filed. It is the general practice of the Board to treat the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion. *See Leeds Techs. Ltd. v. Topaz Commc'n Ltd.*, 65 USPQ2d 1303, 1305-06 (TTAB 2002); *Elec. Indus. Ass'n v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999). The Board does not see any reason to treat this proceeding any differently; therefore, the proceeding was considered suspended as of May 1, 2015, while the discovery period remained open.²

Accordingly, Petitioner's objection with regard to the timeliness of Respondent's filing is not well-taken and is **OVERRULED**.

Respondent's motion is supported by the declaration of the owner of the subject mark, Taryn Rodighiero, which sets forth reasons why Respondent needs the discovery sought prior to responding to the motion for summary judgment. Respondent notes, however, that its motion is directed solely to "Petitioner's allegations and evidence of prior use of its KINI KAI mark in commerce.

² Moreover, Petitioner has not cited, and the Board is unaware of any rule that limits the time for filing a motion under Rule 56(d) to the discovery period of a proceeding. Indeed, inasmuch as a motion for summary judgment may be filed at any time prior to the opening of a plaintiff's testimony period, including after the discovery period has closed, a reading of Rule 56(d) in this manner would result in an unwritten, and illogical, limitation of the rule. The Board may, in its discretion or upon motion, reopen discovery to allow for the investigation of matter necessary to respond to a motion for summary judgment given appropriate circumstances.

[Respondent] has no need to take discovery from Petitioner regarding Petitioner's allegations of fraud." 9 TTABVUE 3 n.1.

The reasons proffered by Applicant through its declaration are as follows:

- 1) Respondent has "no other feasible way in which to obtain facts and information pertaining to Petitioner's alleged prior use or to test the veracity of Ms. Meadors' allegations;"
- 2) Respondent has "no other feasible way in which to obtain facts and information pertaining to the exhibits or to test the genuineness and veracity of the information presented in the exhibits;"
- 3) "It is [Respondent's] belief that all such facts and essential pieces of information pertaining to Petitioner's alleged prior use of its KINI KAI mark are exclusively within the control of Petitioner and Ms. Meadors."

Petitioner argues that "[t]he allegation in Petitioner's motion for summary judgment that Petitioner is the senior user of the mark are the same facts and evidence presented in the Petition to Cancel filed in August 2014, in Petitioner's initial disclosures made in November 2014, and Petitioner's supplemental disclosures and discovery responses made in March 2015," and thus Respondent could have and should have "more closely" reviewed the evidence "months ago." 10 TTABVUE 3. However, inasmuch as a party may take discovery at any point during the discovery period, the Board does not find reason at this time to penalize Respondent for its discovery strategy or schedule.³

The Board finds, in view of the declaration submitted by Respondent, that Respondent has satisfactorily demonstrated a need for discovery that is reasonably

³ Nonetheless, a party is well-advised to avoid waiting until the waning days of the discovery period to seek information necessary to support its position. *See, e.g. Luehrmann v. Kwik Kopy Corp*, 2 USPQ2d 1303, 1305 (TTAB 1987).

directed to obtaining facts essential to its opposition of Petitioner's motion for summary judgment prior to responding to the motion. The Board disagrees with Petitioner's argument that Respondent is simply "hoping" to find "some evidence to support [her] case." *Id.* 3-4. Indeed, Respondent has specified that it requires information regarding Petitioner's claim of priority, which is an issue central to the determination of likelihood of confusion. *See* 15 U.S.C. § 1052(d); *West Florida Seafood, Inc., v. Jet Rests., Inc.*, 31 F.2d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994); *Research in Motion Ltd. v. Defining Presence Mktg. Group Inc.*, 102 USPQ2d 1187, 1195 (TTAB 2012).

The Board also agrees with Respondent's assertion that much of the information it needs appears to be in Petitioner's control, such as facts relating to Petitioner's dates of use of its mark in the United States, the selection and adoption of Petitioner's mark, and any information relating to Petitioner's knowledge of Respondent's use of its mark. These factual issues are central issues in this cancellation proceeding, and Respondent is entitled to discovery thereon prior to responding to Petitioner's motion for summary judgment. *See Orion Group Inc. v. Orion Insurance Co., PLC*, 12 USPQ2d 1923 (TTAB 1989).

Accordingly, Respondent's motion for Rule 56(d) discovery is **GRANTED**, to the extent that Respondent is allowed, within **THIRTY DAYS** from the mailing date of this order, to notice and conduct the deposition of Jennifer K. Meadors, **limited to the topic of Petitioner's priority and use of the KINI KAI mark**, as set forth in Respondent's motion for Rule 56(d) discovery.

Respondent is then allowed until **SIXTY DAYS** from the mailing date set forth in this order to file a brief in response to Petitioner's motion for summary judgment. Petitioner's reply brief in support of that motion is due in accordance with Trademark Rules 2.119(c) and 2.127(e)(1).

The proceeding otherwise remains **SUSPENDED**.