

JHK
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TTAB

OSMM&N File No. 231555US33

By: JHK/ASC/rab

Opposition No.: 91/156.618

Applicant: YOSHIDA METAL INDUSTRY CO., LTD.

Matter: YOSHIDA METAL INDUSTRY CO., LTD. v. GLOBAL DECOR

Due Date: N/A

The following have been received in the U.S. Patent and Trademark Office on the date stamped hereon:

- Opposer's Motion for Further Discovery under Fed. R. Civ. P. 56(F) and for an Order Compelling Discovery
- Declaration of Amy Sullivan Cahill, Esq.
- E-mail correspondence from James Conte
- Applicant's Response to Opposer's First Set of Interrogatories
- Applicant's Responses to Opposer's First Request for Production of Documents
- Applicant's Response to Opposer's First Requests for Admissions



FILING RECEIPT

Attorney Docket No.: 231555US-33

TTAB

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

YOSHIDA METAL INDUSTRY CO., LTD.,)
)
Opposer,)
)
v.)
)
GLOBAL DÉCOR, INC.,)
)
Applicant.)

Opposition No. 91/156,618
Appln. Serial No.: 76/179,674
Mark: GLOBAL DECOR

**OPPOSER'S MOTION FOR FURTHER DISCOVERY UNDER FED. R. CIV. P. 56(f)
AND FOR AN ORDER COMPELLING DISCOVERY**

Opposer Yoshida Metal Industry Co., Ltd. ("Opposer"), by counsel, respectfully requests an opportunity for further reasonable discovery in order to respond to Applicant's Motion for Summary Judgment pending in the above proceeding under Rule 56(f) of the Federal Rules of Civil Procedure and TBMP § 528.06 and for an order compelling Applicant to answer Opposer's discovery.

Opposer cannot effectively oppose a Motion for Summary Judgment without the necessary discovery as outlined herein. In support of its Motion, Opposer submits the attached Affidavit of Amy Sullivan Cahill, Esquire (Exhibit A), outlining the grounds on which Opposer contends it cannot effectively oppose a Motion for Summary Judgment without an opportunity to ascertain relevant information and documents from Applicant in this matter.

FACTUAL BACKGROUND

Opposer commenced this Opposition proceeding alleging that Applicant's GLOBAL DECOR mark so resembles Opposer's GLOBAL mark for similar goods as to be likely to cause confusion, mistake or deception within the meaning of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

On July 3, 2003, the opening day of the discovery period, Opposer served Applicant with Opposer's First Set of Interrogatories, First Request for Production of Documents and First Requests for Admissions. On July 14, 2003, Applicant, through its counsel, requested, and was granted, an extension of time in which to complete its responses to Opposer's discovery requests. Per the agreement of the parties, Applicant's responses were due on September 6, 2003.

On August 27, 2003, Applicant filed a Motion for Summary Judgment arguing that that Applicant's GLOBAL DECOR mark was not likely to be confused with Opposer's GLOBAL mark as a matter of law.

On September 5, 2003, Applicant's counsel forwarded a proposed Protective Order to counsel for Opposer. Because Opposer's counsel needed time to consult its client's representatives abroad, the parties agreed to treat all documents produced by Applicant as limited to "Attorneys Eyes Only", pending an agreement on a mutually satisfactory Protective Order. Applicant's counsel agreed that Applicant's objections to Opposer's First Request for Production of Documents on grounds of confidentiality were thereby resolved, by e-mail of September 9, 2003 (Exhibit B).¹

On September 5, 2003, Applicant served responses to Opposer's First Set of Discovery Requests (Exhibits C, D, and E). However, Applicant failed to produce any documents and declined to provide meaningful answers to the interrogatories, effectively placing Opposer in the position of a party denied the opportunity to take discovery, making Opposer's motion under Rule 56(f) necessary.

¹ Applicant filed a Motion for Entry of Protective Order on September 5, 2003. Because Applicant's tendered Protective Order contains three typographical errors that affect its meaning, and does not specifically include Opposer's foreign counsel among those who may have access to certain confidential materials, Opposer filed a Response to Applicant's Motion for Entry of Protective Order agreeing to the need for protective order and tendering its own corrected Protective Order for entry.

Applicant's Responses to Opposer's First Request for Production of Documents

Applicant declined to produce a single document in response to Opposer's First Request for Production of Documents. In response to standard requests seeking documentation demonstrating (1) representative specimens of Applicant's current and proposed advertising (Request No. 1); (2) Applicant's dates of first use of its mark (Request No. 4); (3) the types of products with which Applicant's mark is used (Request No. 5); (4) geographical areas and channels of trades in which Applicant's mark is used (Request No. 6); (5) assignments, consents or licenses involving Applicant's mark (Request No. 7); (6) specimens of packaging or labeling for Applicant's products bearing Applicant's mark (Request No. 8); (7) channels of advertising or promotion of Applicants Products (Request No. 9); (8) the types of customers with whom Applicant does business and its ultimate purchasers (Request No. 10); (9) Applicant's first knowledge of Opposer's Mark (Request No. 13); and (10) instances of actual confusion between Applicant's goods and Opposer's goods (Request No. 17), Opposer objected to the requests stating:

Without waiving its objections Applicant will produce copies of those unprivileged documents which it has, after and if the Board rules negatively on its Motion for Summary Judgment, and after a protective order is entered.

Applicant's Answers to Opposer's First Set of Interrogatories

Similarly, Applicant refused to answer Opposer's interrogatories seeking information about (1) the common commercial descriptive name of each product sold by Applicant bearing Applicant's mark (Interrogatory No. 5); (2) the date of first use of Applicant's mark in commerce (Interrogatories No. 6 & 7); (3) the amount budgeted and expended to promote Applicant's Mark (Interrogatory No. 8); (4) income from sales of Applicant's Products bearing Applicant's Mark (Interrogatory No. 9); (5) representative examples of promotions documents and items (Interrogatory No. 10); (6) searches conducted by Applicant in connection with its selection, use

and registration of Applicant's mark (Interrogatory No. 11); (7) Applicant's knowledge of Opposer's Mark (Interrogatory Nos. 12 and 13); (8) the identity of persons having knowledge of market research conducted by Applicant (Interrogatory No. 17); (9) the existence of agreements, such as licenses, entered into by Applicant regarding Applicant's Mark (Interrogatory No. 19); and (10) the identity of those who supplied information or documents in responding to Opposer's first set of discovery requests (Interrogatory No. 24). Applicant objected to each of the above interrogatories, in part, on grounds that:

Applicant filed a Motion for Summary Judgment on August 27, 2003. The Board will issue an order suspending all proceedings. As no discovery is needed for the Board to rule for Applicant, it is unduly burdensome for Applicant to have to respond to these interrogatories.

ARGUMENT

Rule 56(f) of the Federal Rules of Civil Procedure allows for the taking of discovery by a party opposing summary judgment if discovery is necessary in order to respond to the motion. *See, e.g., Orion Group, Inc. v. Orion Ins. Co., P.L.C.*, 12 USPQ2d 1923, 1924-25 (TTAB 1989); *Keebler Co. v. Murray Bakery Products*, 9 USPQ 1736, 1739 (Fed. Cir. 1989). The purpose of Rule 56(f) is to prevent summary judgment in cases where the nonmoving party has been denied discovery necessary to respond to the motion. *Orion Group* at 1924-25, citing *Dunkin' Donuts of America, Inc. v. Metallurgical Exoproducts Corp.*, 6 USPQ 1026 (Fed. Cir. 1988).

Applicant, in its Motion for Summary Judgment, argues that Opposer's GLOBAL mark is entitled to only a narrow scope of protection and is sufficiently distinct from Applicant's GLOBAL DECOR mark, when used with the goods at issue, to preclude a likelihood of confusion among consumers. In considering Applicant's motion for summary judgment, the Board must take into consideration whether there is a genuine issue as to any material fact. Rule 56(c), Fed.R.Civ.P. A material fact is one that may affect the decision where that fact is relevant and necessary to the proceedings. *Opryland USA, Inc. v. The Great American Music Show, Inc.*,

23 USPQ2d 1471, 1472 (Fed. Cir. 1992), citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1988).

Opposer currently has insufficient facts essential to justify its opposition to Applicant's Summary Judgment Motion. These facts, including the information and documents sought by Opposer in its first set of discovery, include: documents and information directed to Applicant's intent; Applicant's advertising and promotions; Applicant's intended consumers; and Applicant's trade channels. Such information and documents are directly relevant to the issue of likelihood of confusion and follow directly the elements the Board must consider in determining a likelihood of confusion under *In re E.I. Du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). *See Opryland* at 1473 (the factual considerations pertinent to a likelihood of confusion analysis are contained in *E.I. Du Pont de Nemours & Co.*).

This is not a situation in which Opposer merely speculates that Applicant has evidence that may support its position. Rather, Applicant has indicated that while relevant documents and information exist, they will not be produced at this time. Without information and documents on these specific material issues, Opposer cannot adequately defend against Applicant's Motion for Summary Judgment, nor can the Board properly consider the motion. *See Cahill Affidavit, Exh. A; see also Dunkin' Donuts of America, Inc. v. Metallurgical Exoproducts Corp.*, 6 USPQ2d 1026 (Fed. Cir. 1988)(It is well settled that the granting of a motion for summary judgment is inappropriate where the responding party has been denied discovery needed to enable it to respond to the motion).

CONCLUSION

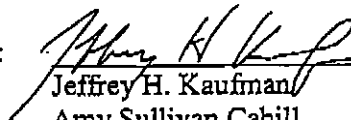
Accordingly, Opposer asks that its request be granted and that a ruling on Applicant's Motion for Summary Judgment be continued pending further opportunity for discovery by Opposer.

Opposer, through undersigned counsel, has made a good faith effort, by correspondence with Applicant's counsel, to resolve the discovery issues presented in the accompanying Motion.

Respectfully submitted,

YOSHIDA METAL INDUSTRY CO., LTD.

By:



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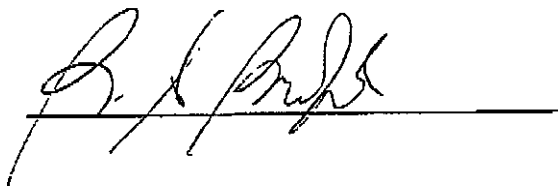
Dated: October 1, 2003

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S MOTION FOR FURTHER DISCOVERY UNDER FED. R. CIV. P. 56(f) AND FOR AN ORDER COMPELLING DISCOVERY** was served on counsel for Applicant, this 1st day of October 2003, by sending same via First Class Mail, postage prepaid, to:

James B. Conte, Esq.
BARNES & THORNBURG
One North Wacker Drive
Suite 4400
Chicago, Illinois 60606

A handwritten signature in cursive script, appearing to read "J. B. Conte", is written over a horizontal line.

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

1940 Duke Street
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FACSIMILE TRANSMISSION

PLEASE DELIVER TO:

**Ms. Nancy Omelko
U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
South Tower Building
9th Floor
Arlington, VA 22202-3514**

FACSIMILE NO.: 703-746-7111

FROM: Amy Sullivan Cahill

DATE: October 28, 2003

OUR REF.: 231555US-33

NUMBER OF PAGES INCLUDING COVER LETTER: 10

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October 28, 2003

Via Facsimile and Regular Mail

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Re: *Yoshida Metal Industry Co., Ltd. v. Global Décor, Inc.*
Opposition No. 91/156,618
Appln. Serial No. 76/179,674
Mark: GLOBAL DECOR
Our Docket No.: 231555US-33

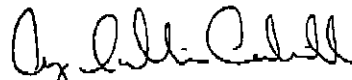
Dear Ms. Omelko:

Further to our conversation this afternoon, I am forwarding a copy of Opposer's Motion for Further Discovery under Fed. R. Civ. P. 56(f) and for an Order Compelling Discovery previously filed on October 1, 2003. I am sending the entire motion with attachments to your attention via U.S. mail as you requested. This Motion was filed in timely response to Applicant's Motion for Summary Judgment.

Thank you for your assistance and please do not hesitate to contact me with any questions.

Sincerely,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Amy Sullivan Cahill

ASC/rab (L:\att\YHK\4646-231555US-1t4.doc)

Enclosure(s): Copy of Opposer's Motion for Further Discovery under Fed. R. Civ. P. 56(f)
and for an Order Compelling Discovery

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