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

Proceeding	91166194
Party	Defendant Steve Dahl & Company, Inc. Steve Dahl & Company, Inc. 250 Parkway Drive. Suite 110 Lincolnshire, IL 60069
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

FOX BROADCASTING COMPANY,

Opposer,

v.

STEVE DAHL & COMPANY, INC.,

Applicant.

Opposition No. 91166194

**APPLICANT'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

**APPLICANT'S OPPOSITION TO OPPOSER'S RULE 56(F) MOTION FOR  
DISCOVERY**

**APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL**

**APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR EXTENSION OF TIME  
TO RESPOND TO SUMMARY JUDGMENT PENDING RULING ON 56(f) MOTION**

**APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR SANCTIONS**

Applicant Steve Dahl & Company, Inc. ("Applicant"), through its undersigned counsel, hereby submits this Reply Memorandum of Points and Authorities in Support of Applicant's Motion for Summary Judgment. Applicant also submits this memorandum in opposition to the motions brought by Opposer Fox Broadcasting Company ("Opposer"), including Opposer's Motion under Fed. R. Civ. Proc. 56(f) for Discovery, Opposer's Motion to Compel, Opposer's Motion For Extension of Time to Respond to Summary Judgment Pending Ruling on 56(f) Motion, and Opposer's Motion for Sanctions. Applicant respectfully requests that Opposer's Motions be denied and summary judgment be granted in Applicant's favor.

**I.**  
**INTRODUCTION**

Opposer's various Motions are without merit because they ignore one simple and essential fact: Applicant's TRADING SPOUSES mark (the "Mark") has not yet been used in commerce and Applicant's Application is based entirely on an intent to use the Mark. Accordingly, a decision as to whether the Mark is descriptive of Applicant's proposed goods and services -- the only matter at issue in the Opposition proceeding -- must be based solely upon the Application and the file before the United States Patent and Trademark Office, which is the only relevant evidence available regarding the Mark or its intended use. Opposer's arguments and various discovery and sanctions Motions are a smokescreen to distract the Board from the complete lack of disputed facts in this proceeding. Applicant's responses to Opposer's previously propounded discovery requests are sufficient, and provided to Opposer all relevant and discoverable documents in Applicant's possession. The fact that the Application is based on an intent to use the Mark means that there is very little to discover and, in fact, no additional discovery is necessary or appropriate for the Board to have all the evidence required to rule on Applicant's summary judgment motion.

Further, Opposer has offered no evidence that genuine issues of material fact remain for trial. All that now remains is for the Board to determine whether the Mark is arbitrary or suggestive as applied to Applicant's proposed goods and services (as Applicant contends and the Examining Attorney found), or descriptive (as Opposer contends).

**II.**  
**THIS CASE IS RIPE FOR SUMMARY JUDGMENT**

**A. Additional Discovery Under Rule 56(f) Is Unnecessary**

Opposer's laundry list of information it seeks to obtain through new discovery demonstrates, by its very nature, that Opposer's request for additional discovery is unnecessary.

Opposer includes information that has either already been requested, does not exist, or is irrelevant to this proceeding.

For example, Opposer seeks information about all references to the Mark made on Applicant's radio show.<sup>1</sup> Such information, however, even if it existed (which it does not) is not relevant to the issue raised by Opposer's Opposition – *i.e.*, whether the Mark is merely descriptive of the goods and services recited in the Application. Opposer's purported need for such information is a red herring designed to distract the Board from the issue raised in Applicant's summary judgment motion.

Opposer also asserts that it must be granted leave to pursue discovery of items it has already requested and to which discovery Applicant has already responded. In its Motion, Opposer lists nineteen topics on which it claims it is entitled to discovery. Yet each of the topics listed corresponds with at least one discovery request already made by Opposer and to which Applicant has already responded. For instance, Opposer seeks additional discovery on "the creation, selection, development and adoption of Applicant's Mark and Applicant's decision to use Applicant's Mark." *See* Opposition, p. 14. In its First Set of Requests for Production, Opposer made this very request, seeking "All documents that refer to or relate to the creation, selection, development and adoption of Applicant's Mark and Applicant's decision to use Applicant's Mark." Applicant responded with an agreement to produce responsive documents, if any, which it did. *See* Responses to Opposer's First Set of Requests for Production, p. 5. Opposer has not stated what additional information on this same topic it seeks to obtain by submitting an identical request. The other subjects on which Opposer seeks to take discovery are similarly covered, often verbatim, in Opposer's First Set of Requests for Production and First Set of Interrogatories, to which Applicant has responded. To the majority of these requests,

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<sup>1</sup> Applicant's principal, Steve Dahl, is the host of a popular radio talk show.

Applicant has responded that no such documents exist. *See* Responses to Opposer's First Set of Requests for Production; Responses to Opposer's First Set of Interrogatories. No additional discovery is necessary in this case because Opposer has already sought and received discovery on all topics on which it claims a need for information.

Further, Opposer continues to claim a need for discovery of information that Opposer knows does not exist, including information relating to the volume of Applicant's sales under the Mark. As Opposer is aware, Applicant seeks to register the Mark on an intent to use basis and has not yet made use of the Mark in commerce. Applicant therefore could not provide information on, *e.g.*, sales under the Mark, advertising of the Mark, products sold under the Mark, and other information Opposer purports to seek. Accordingly, the majority of the information Opposer claims is essential to its response to Applicant's summary judgment motion is information Opposer knows does not exist and which, perforce, Applicant is unable to provide.

The information sought is also irrelevant. Applicant has filed an intent to use Application, and the Mark has not yet been used in commerce. Details of Applicant's past use of the Mark (even if such past use existed, which it does not) are irrelevant, as Applicant has claimed no such past use as the basis for registration of the Mark. Also irrelevant to the issue of descriptiveness are such matters as the channels of trade in which the claimed goods and services are to be sold, plans to expand the goods and services offered under the Mark, and the dollar volume of advertising and promotional expenditures made in connection with the Mark. This information has no bearing on whether the Mark is descriptive of the goods and services listed in Applicant's trademark Application, and Opposer's contentions that it cannot fully oppose Applicant's summary judgment motion without such information are meritless.

All information and documents relevant to this proceeding – namely, the Application file, Examining Attorney's findings, and arguments made to the Examining Attorney – are already a part of the file in this proceeding and are available to the Board and to Opposer. Additional discovery is therefore unnecessary. Opposer's request for such discovery is merely a delaying tactic intended to disguise the absence of any genuine issues of material fact. Because Opposer's basis for requesting additional discovery is the claimed need for irrelevant and/or nonexistent information, or information that has already been provided, Opposer's request for additional discovery under Rule 56(f) should be denied.

**B. Applicant Has Adequately Responded to Opposer's Discovery Requests**

Opposer disputes Applicant's responses to Opposer's discovery requests, to which Applicant objected on relevancy grounds. However, Opposer's contention that relevance is not a valid grounds for objection is directly contradicted by the very authorities cited by Opposer. Rule 26(b)(1) of the Federal Rules of Civil Procedure, while permitting the discovery of inadmissible evidence, nonetheless requires that the evidence sought be *relevant*. See Fed. R. Civ. Proc. 26(b)(1) ("*Relevant* information need not be admissible. . . .") (emphasis added). Nor does the information requested by Opposer "hav[e] any tendency to make the existence of any fact *that is of consequence to the determination of the action* more probable or less probable than it would be without the evidence." Fed. R. Evid. 401 (emphasis added).

As discussed above, the Application for the Mark is based upon an intent to use the Mark in commerce. No use has yet been made. See App. Serial No. 78/195,541. The Board's determination of the distinctiveness of the Mark must therefore be based solely on the goods and services as listed in the Application. No other information is, or can be, relevant to that determination. Applicant's rights in the Mark, once registered, will be limited by the goods and services described in the Application. Accordingly, the only relevant evidence is that

contained in the Application file and in the Examining Attorney's records. All of this information has been provided to Opposer.

**C. There Are No Genuine Issues of Material Fact**

Where, as here, there are no genuine issues of material fact, summary judgment is appropriate. Fed. R. Civ. Proc. 56. Applicant has filed an Application based upon intent to use the Mark in commerce, and no use has yet been made of the Mark. *See* App. Serial No. 78/195,541. Accordingly, a determination of the Mark's distinctiveness must be made solely in relation to the goods and services listed in the Application. The Application file and the Examining Attorney's findings, as well as any arguments made to the Examiner, are a matter of record in this proceeding. *See* 37 C.F.R. § 2.122(b).

In its papers, Opposer recites a variety of facts relied on by Applicant in its summary judgment motion. Opposition at 8-10. Opposer then argues that it needs discovery regarding such facts. This argument is without merit. The facts Opposer cites are primarily logical conclusions drawn by Applicant, such as the multi-stage reasoning process necessary to connect the term TRADING SPOUSES to one of Applicant's proposed uses (*i.e.*, a broadcast program in which individuals interact with families other than their own), or Applicant's conclusion that the phrase does not directly or indirectly invoke shirts or video recordings. No discovery is needed to shed additional light on such facts.

Opposer also purports to challenge facts that are expressly supported by the only relevant evidence in this case – the Application file and Examining Attorney's findings. These material facts include, among others, the temporary nature of the placement in different households of the spouses on the proposed program, which is expressly stated in the description included in the Application file.

Despite its recitation of a variety of facts, however, Opposer makes no effort to dispute any of these "material facts," nor does Opposer present any alternative set of facts in order to demonstrate the existence of any genuine dispute. Opposer has failed to meet its burden to "set forth specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e). Accordingly, there is no genuine issue of material fact, and Applicant is entitled to summary judgment as a matter of law.

**III.**  
**APPLICANT IS ENTITLED TO SUMMARY JUDGMENT**

A mark should be considered descriptive only if it directly and clearly conveys information about the ingredients, qualities or characteristics of the product or service. *See, e.g., In re MBNA America Bank, N.A.*, 340 F.3d 1328, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003). If "mature thought" or "a multi-stage reasoning process" is necessary to determine attributes of the product or service, the term is not descriptive. *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496 (T.T.A.B. 1978).

The term TRADING SPOUSES does not directly or indirectly convey the majority of the goods and services for which Applicant seeks registration. The term TRADING SPOUSES does not describe audio and video recordings, printed material, clothing or broadcasting services. The exchange of spouses is not a characteristics of these goods and services, and consumers would be required to use a great deal of imagination and thought to connect the goods and service in these classes to the Mark. Accordingly, the Mark is entirely arbitrary when applied to the goods and services in Classes 009, 016, 025 and 038 and, as detailed in Applicant's Motion for Summary Judgment, was recognized by the Examiner as such. *See Non-Final Office Action*, dated Jan. 30, 2004.



Applicant's Mark is also more than merely descriptive of the goods and services listed in Class 041. As Applicant argued in the Office Action and in its Motion for Summary Judgment, the inquiry should focus on the goods and services themselves, not the subject addressed by the goods and services. *See* Response to Office Action, dated July 30, 2004. TRADING SPOUSES is not descriptive of broadcast entertainment services, as it does not describe a quality, characteristic or ingredient of such services. *See, e.g., Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70 (2d Cir. 1988) (GUNG-HO is a suggestive mark for toy action figures that "may describe the elements of the personality attributed to the toy. . . without describing the particular toy itself or its differentiating qualities").

As Applicant has argued, before the Examining Attorney and in its Motion for Summary Judgment, the usual and ordinary meaning of the term "trading" indicates a permanent exchange. Webster's Dictionary defines "trading" as: 1) to have dealings: negotiate; 2) to engage in the exchange, purchase or sale of goods; 3) to give one thing in exchange for another; and 4) sell. *See* WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 1250 (1991). None of these definitions is directly applicable to the proposed broadcast program described in the Application. No sale of spouses will occur, nor negotiations for such a sale. No sale or exchange of goods is involved in the proposed program. And no one involved in the program will be giving up their spouse in exchange for another. Rather, the spouses involved will temporarily reside with a different family and will return to their own family after a short time.

The word "temporarily" in the identification of services in the Application and the lack of any indication that money or property is exchanged, or that the exchange is not consensual, bring the proposed services outside the descriptive range of the word "trading." *See* Response to Office Action, dated July 30, 2004. Applicant certainly does not contemplate

slavery or human trafficking, but it is those implications in the term TRADING SPOUSES from which the whimsical nature derives. Viewers will be aware that the phrase suggests these things, but by following a logical reasoning process will recognize that a permanent exchange is not involved may be amused by the play on words. As Applicant has noted in the Office Action, TRADING SPOUSES is intended to be entertaining precisely because viewers will understand that no actual exchange is occurring. *Id.*

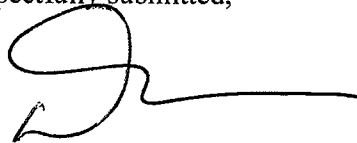
As the Examiner recognized in the Office Action, TRADING SPOUSES is not descriptive of the goods and services listed in the Application, and no showing of secondary meaning is required to support registration of the Mark. Accordingly, Applicant is entitled to summary judgment and dismissal of this Opposition.

#### **IV.** **CONCLUSION**

For all the foregoing reasons, Applicant respectfully requests that Opposer's Motions be denied and Applicant's Motion for Summary Judgment be granted and this Opposition dismissed.

Date: June 28, 2006

Respectfully submitted,



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CERTIFICATE OF SERVICE

It is hereby certified that on June 28, 2006, a copy of the foregoing APPLICANT'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT; APPLICANT'S OPPOSITION TO OPPOSER'S RULE 56(F) MOTION FOR DISCOVERY; APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL; APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR EXTENSION OF TIME TO RESPOND TO SUMMARY JUDGMENT PENDING RULING ON 56(f) MOTION; and APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR SANCTIONS has been sent by first class mail, postage prepared to the attorney of record for Opposer:

Howard S. Michael  
BRINKS HOFER GILSON & LIONE  
P.O. Box 10395  
Chicago, IL 60610

Dated: June 28, 2006


A handwritten signature in cursive script that reads "Dianne Nicholson". The signature is written in black ink and is positioned above a horizontal line.

Dianne Nicholson

CERTIFICATE OF FILING

I hereby certify that this document is being electronically filed with the United States Patent and Trademark office:

Dated: June 28, 2006

  
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Zoey Kohn